SUPREME COURT, U. S.

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Supreme Court of the United States

October Term, 1968.

No. 1355

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioners, Blumcraft of Pittsburgh, a Partnership consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum, pray that a Writ of Certiorari be issued to review the Decision and Order of the Court of Appeals for the Fourth Circuit entered on February 19, 1969 and that this case be listed for argument to follow *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, cert. granted March 24, 1969, No. 1014, October Term, 1968.

I.

ORDERS, OPINIONS AND JUDGMENTS BELOW.

(a) Decision and Order of the Court of Appeals for the Fourth Circuit, Appeal No. 12719, February 19, 1969, not officially reported, unofficially reported at 160 U. S. P. Q. 642.

(b) Opinion and Order of the District Court for the District of South Carolina, May 29, 1968, 286 F. Supp. 448, 158 U. S. P. Q. 642 (1968).

(c) The patents here in suit are also before the United States District Court for the District of Kansas in the following case, as yet untried:

Blumcraft of Pittsburgh v. Architectural Art Mfg., Inc., No. W-4037, filed August 7, 1968.

(d) The design patent here in suit has also been adjudicated in the United States Court of Claims in

Blumcraft of Pittsburgh v. The United States, 178 Ct. Cl. 798, 372 F. 2d 1014 (1967).

II.

STATEMENT OF THE GROUND ON WHICH JURISDICTION OF THIS COURT IS INVOKED.

(a) This is a suit arising under the patent laws of the United States, Title 28 § 1338, of the United States Code.

(b) The jurisdiction of this Court is invoked under Title 28 § 1254 of the United States Code.

(c) The date of the Decree which the Petitioners seek to have reviewed herein is February 19, 1969. No petition for a rehearing was filed.

III.

QUESTIONS PRESENTED FOR REVIEW.

In 1954, the U. S. Patent Office issued a design patent to Petitioner for a unique ornamental railing design compatible with contemporary rather than traditional architectural styles. Also, in 1959, the U. S. Patent Office issued to Petitioner a patent on a unique mechanism for connecting a handrail in spaced relation to a post particularly adapted to the needs of modern architecture. The U. S. Government sought to use one of these patents without compensation to Petitioner. Upon suit in the Court of Claims the design patent was held valid and infringed and the Government did not seek review therefrom. This decision was cited with approval by another panel of the Court of Appeals for the Fourth Circuit. Respondents have used the same patents without compensation.

On essentially the same record and the same evidence as was before the Court of Claims the District Court independently held the design patent valid and infringed after finding as a fact that the design was novel and non-obvious. The District Court likewise held the mechanical patent valid and infringed. The Court of Appeals for the Fourth Circuit, however, without giving any weight whatsoever to

the Court of Claims decision, without resort to any evidence other than that in the earlier case and that presented at the contest in the Patent Office, reversed the District Court decision and held that both patents were invalid. The sole basis for its decision was that, even though the prior art did not reveal the novel subject matter of the patents, highly skilled persons could have redesigned the prior art to achieve the structures and designs set forth in the patents at issue. Therefore, the questions presented for review are:

(a) Did the Court of Appeals err in declaring the design patent invalid when it (a) basically accepted the District Courts' finding that the design was not obvious because unusual and contrary to any normal expectation, requiring considerable thought and substantial redesign of the prior art but, (b) went on, on a basis unsupported by the record, to conclude that persons highly skilled in the art could have redesigned the prior art to achieve the design?

(b) Did the Court of Appeals err by applying standards of patentability which conflict with § 103 of the Patent Act of 1952 and prior decisions of this Court?

(c) Did the Court of Appeals err by giving no consideration or weight whatsoever to the final adjudication of validity of the same patent by the U. S. Court of Claims, thus denying comity to a final decision of a coequal federal court?

(d) Should the doctrine of comity among federal courts be developed by this Court so as to limit the endless relitigation of the validity of a single U. S. patent in each of the Circuits producing contrary results on the same record?

IV.

STATEMENT OF THE CASE.

A. The History of the Case.

The present law suit began on September 27, 1962 as the result of controversy between Blumcraft of Pittsburgh, owner of the patents in suit, and Architectural Art Mfg., Inc., involving the infringement of Blumcraft's patents by ornamental railings advertised by Architectural Art. The suit was brought against the defendants, customers of Architectural Art, as statutory infringers, when the specific railings in suit were discovered, upon Architectural Art's refusal to admit the manufacture and sale of the railings it advertised.

Plaintiff attempted to have Architectural Art made a party defendant on the basis of Architectural Art's complete control of the defense and counterclaim in this case. After initially granting plaintiff's motion, the District Court reversed itself on the authority of *Schnell v. Peter Eckrich & Sons, Inc.*, 365 U. S. 260 (1961). *Blumcraft of Pittsburgh v. Citizens and Southern National Bank*, 255 F. Supp. 441 (D. S. C. 1966).[1]

The trial of the case began on May 17, 1967 and the District Court rendered its decision on May 29, 1968, holding both Blum patents valid and infringed. Upon defendants' appeal to the Court of Appeals, the case was argued on December 2, 1968 and on February 19, 1969 the Court of Appeals for the Fourth Circuit rendered its decision reversing the District Court on the issue of validity of each of the patents. The District Court's findings of infringement were not touched upon by the Court of Appeals. The Mandate of the Court of Appeals was stayed on March 19, 1969 to permit this petition to be filed.

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1. The matter is somewhat confused by the Court of Appeals' treatment of Architectural Art as a party actually before the court (Appendix p. 47a, third paragraph).

B. Louis Blum's Inventions.

About sixty years ago, Hyman Blum, an ornamental iron worker who had served his apprenticeship as a boy in Russia, established his business in Pittsburgh, Pennsylvania. He made out of wrought iron the articles created by architects for use in monumental buildings. His three sons joined their father in his work. For more than forty years, Louis Blum has been personally responsible for the manufacture and even the design of many beautiful ornamental metal structures such as railings, grille work, communion rails and lighting fixtures. In the railing field his work initially followed the traditional patterns of ornamental railing design.

In 1952, Louis Blum was determined to develop a new and original railing which would be compatible in design with the growing number of monumental buildings being designed by architects using contemporary rather than traditional techniques. He created a railing design in which a plurality of rectangular vertical posts formed one plane and a plurality of flat horizontal rails formed a separate plane, parallel to the first plane, connected in a way to produce a visual floating effect. After twenty-five years of creative endeavor this was the first design for which he filed a patent application. He obtained his patent in 1954.

When the Blumcraft firm began marketing the new railing design it met with an immediate, astounding success. The business of the firm jumped 1700% within a period of five years. In the same period its payroll grew from eight or ten employees to between ninety and one hundred. These results were directly attributable to the ornamental and esthetic effect of Louis Blum's new railing design, especially upon architects who seized upon the design as one adapted for use with a myriad of contemporary buildings. As the Blumcraft design became successful, other manufac-

turers began copying it, including Architectural Art Mfg., Inc., an early customer of Blumcraft.

In 1956, Louis Blum perfected a unique mechanism for attaching a handrail in spaced relation to a post particularly adapted to the needs of modern architecture in that the connecting function was substantially minimized. This was accomplished by utilizing a dovetail-shaped base portion of the handrail in cooperation with a pair of V-shaped clamps which served to connect the rail to the posts, spacing the rails from the post and at the same time producing the rigidity and strength required in railing structures. In this mechanism, Louis Blum presented for the first time in the art a bracket in which the clamping function was integrated in the spacing connector element. This invention was also exceptionally well-received in the art and achieved considerable success and was also copied by Architectural Art.

C. Decisions of the Courts Below.

All of the expert witnesses who have testified either for or against Louis Blum's design patent and all of the courts that have judged it have agreed on one point: that Louis Blum did create an original railing design which had never been seen before and this design was ornamental and entirely compatible with modern architecture. Except for the Court of Appeals below, the design has been consistently found (by the seven judges of the Court of Claims and the trial judge in this case) to be characterized by the following distinctive features:

1. A plurality of spaced parallel posts generally rectangular in cross section and arranged so as to present a series of spaced parallel vertical surfaces;

2. A plurality of spaced parallel handrails generally flat or rectangular in cross section and arranged in the same vertical plane so as to present a series of parallel horizontal surfaces;

3. Connecting brackets attaching the underside of each handrail to the adjacent edge of each post, each bracket comprising a rod-like member extending at right angles to the post and a substantially flat triangular member extending upward from the rod-like member to the center of the underside of each rail leaving the rail unobstructed throughout the hand-gripping portion thereof;

4. The aforesaid elements so designed and arranged as to cause the handrails to appear to float in space away from the posts.

At the trial, the evidence developed Louis Blum's efforts to produce the design and its immediate impact upon the art. It was established through plaintiff's expert witness, Dean Henry L. Kamphoefner, architect and Dean of the School of Design at North Carolina State University that, beginning after the turn of this century, a modern school of architecture developed and grew in this country in which design was characterized by the elimination of rococo features and by the utilization of broad, straight lines and shaped surfaces and by the separation of planes and surfaces to produce dramatic visual effects entirely consistent with the functions of the articles themselves.

To satisfy the need for a railing in a building designed in accordance with modern principles, an architect was compelled to resort to commercial railings incompatible with modern architecture or to provide an individual railing on a job-by-job basis for each particular building design. There was no railing compatible with the requirements of contemporary design. The testimony established the significance of each of the distinctive features of the design in producing the overall visual effect and that the market impact of the railing design was based upon its esthetic appearance. Catalogs published by numerous competitive

manufacturers after the Blum design achieved its success showed the widespread adoption of all of the aforementioned distinctive esthetic features of the Blum design. No evidence was offered to show the imitation or adoption of a single one of the prior art railing designs.

Against Louis Blum's design patent the defendants amassed, in their own words, "a labyrinth of prior art" which was pieced together at the trial by their expert witness Clarence T. Fishleigh with the aid of charts and diagrams he had prepared. Plaintiff challenged both the testimony of Fishleigh and his exhibits. He was entirely lacking in any qualifications in the ornamental railing art and had nothing to do with the selection of the prior art and had no knowledge of it other than as it was presented to him by defendants' attorneys. The charts and diagrams were elaborate mosaics created by Fishleigh from separate pieces of prior art according to his own definition of Louis Blum's design. The prior art showed numerous manufactured railings with the rails intersecting the posts in the traditional manner. Presented as the closest prior art was the principal reference cited against the Blum application in the Patent Office which showed a plurality of parallel handrails intersecting round posts. The remaining prior art showed individual railings designed by architects for particular buildings in which a single rail was spaced apart from a supporting structure in the way that wall rails had been mounted for ages.

No prior art showed the design of the particular connecting brackets of the Blum railing nor did any prior art show a plurality of handrails spaced apart from a plurality of posts forming separate planes, presenting the opposed vertical and horizontal surfaces characteristic of Louis Blum's design. In contrast to the experience with the Blum railing design no prior art design was shown to have been used more than once, if at all, or by any person other than the one who made it.

The District Court found the design novel and non-obvious on the basis of 35 *U. S. C.* § 103. It also found that the testimony of the defendants' own expert strongly supported the conclusion of non-obviousness (Appendix p. 13a). The decision of the United States Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra,* holding the Blum design patent valid, was found to be persuasive but the Court arrived at its own independent decision (Appendix p. 14a).

The Court of Appeals agreed that the Blum design was novel but reversed the District Court's finding of validity upon its own assumption that the differences between the design and the prior art were "minor" and that the substantial redesigning of the prior art the District Court found would be necessary to produce the Blum design could have been accomplished by the highly skilled architects and manufacturers engaged in ornamental railing design. The Court of Appeals further contended that the success of Louis Blum's railing and its impact upon the art were based solely upon the fact that it was a "prefabricated" railing system (Appendix p. 51a).

The novelty of the Blum mechanical patent was also established in the District Court and accepted by the Court of Appeals. The defendants challenged the validity of the two claims of the mechanical patent in suit on the basis of two ornamental railing references applied against one claim and a railroad track anti-creeping device applied against the other. Defendants' witness Fishleigh produced in court a model representing a combination of the prior art presented against Claim 1 of the patent but the District Court found in this hybrid structure strong and persuasive evidence that it would *not* have been obvious to one skilled in the art to make the suggested combination, considering that it required the creation of an entirely new element, found neither in the prior art nor even in the Blum patent.

The District Court found the railroad track anti-creeping device patent to be far removed from the ornamental railing art of the invention and not reasonably available as a source of inspiration or information to one skilled in that art (Appendix p. 25a).

The Court of Appeals did not comment on the evidence which the District Court had found persuasive but concluded that the prior art was sufficient to establish the obviousness of the Blum mechanical patent. The Court of Appeals, to support its conclusion, further resorted to the railroad track anti-creeping device patent as prior art most pertinent to the design of ornamental railings (Appendix p. 54a).

V.

REASONS FOR GRANTING THE WRIT OF CERTIORARI.

A. Direct Conflict Between Decisions of the Court of Appeals for the Fourth Circuit and the Court of Claims.

Louis Blum's design patent was held valid and infringed by the United States Court of Claims on a record substantially the same as the record in this case, *Blumcraft of Pittsburgh v. The United States, supra.* That case was tried before Commissioner Donald E. Lane of the Court of Claims during the week of September 9, 1965. In an opinion filed September 22, 1966 the Commissioner found Louis Blum's patent to be valid and infringed (Appendix p. 57a). The parties agreed upon a procedure for accounting and the Government filed no exceptions to the Commissioner's report. Upon review, the Court of Claims agreed with the Commissioner's findings, opinion and recommendations for conclusions of law and therefore did not require oral argument but rendered its per curiam opinion holding the patent valid and infringed February

17, 1967. The entire record of the Court of Claims trial was introduced in evidence in this case.

In the words of defendants' attorney, there was "direct collaboration" between him and the Government attorney in the Court of Claims case, however artfully concealed. As a result of such collaboration, all of the prior art used by the defendants in this case was given by their attorney to the Government in the Court of Claims case. Some of the defendants' deposition testimony in this case was introduced directly into evidence in the Court of Claims. The attack upon the validity of the design patent made by the defendants in this case, as might be expected, is the same attack that was made by the Government in the Court of Claims.

It is manifest from the opinion of the Court of Appeals and the District Court below that there is no significant difference between the record in the Court of Claims case and the record in this case. There is therefore an irreconcilable conflict between the Court of Claims and the Court of Appeals as to the validity of Design Patent No. D-171,963 that can only be resolved by the Supreme Court.[2]

B. Failure of the Court of Appeals for the Fourth Circuit to Meet the Minimal Demands of Comity Among Federal Courts: Conflict With Mast, Foos and Co. v. Stover Mfg. Co., 177 U. S. 485 (1900).

The Courts of Appeals have for some time been grappling with the problem of repetitious litigation of a single patent through several courts. The problem has been considered by the Presidential Commission on Patent Reform and has been the subject of proposed legislation

2. In a press release emanating from Architectural Art Mfg., Inc. published February 26, 1969 the decision of the Court of Appeals for the Fourth Circuit was characterized as "contrary" to the previous decision of the Court of Claims.

in Congress: Patent Reform Act of 1967, February 21, 1967; Senate Bill S-52597, October 30, 1967; House of Representatives Bill HR-13951, November 9, 1967.

A recent case and the proposed legislation involved attempts to limit patent litigation by precluding the patentee from relitigating a patent once held invalid. The Court of Appeals for the Third Circuit in *Nickerson v. Kutschera*, 390 F. 2d 812 (1968), suggested that the Supreme Court's ruling in *Triplett v. Lowell*, 297 U. S. 638 (1936), permitting unlimited relitigation of the validity of the patent, "was either wrongly decided or should no longer be given its customary close reading" but declined to apply a new and different doctrine in view of the pending legislation in Congress. More than one year has passed since that time and no further action has been taken by Congress. This approach has met resistance in Congress and elsewhere, *Blaustein, The Presidential Commission and the return to the Patent Act of 1753*, 53 A.B.A.J. 911 (1967), *Technograph Printed Circuits, Ltd. v. Methode Electronics Corp.*, 285 F. Supp. 714 (N. D. Ill. 1968), *Technograph Printed Circuits, Ltd. v. Packard Bell Electronics Corp.*, 290 F. Supp. 308 (C. D. Cal. 1968).

Completely apart from the *res judicata* or estoppel questions raised in *Triplett v. Lowell, supra*, and *Nickerson v. Kutschera, supra*, some inhibition upon the proliferation of patent litigation can be achieved by the application of a proper rule of comity among Federal Courts. In *Mast, Foos and Co. v. Stover Mfg. Co., supra*, the Court summarized the rule of comity:

> "It demands of no one that he shall abdicate his individual judgment, but only that deference shall be paid to the judgments of other coordinate tribunals. Clearly it applies only to questions which have been actually decided, and which arose under the same facts."

Comity has been applied to hold patents valid or invalid in numerous cases in which the courts have stated their responsibility consistent with the *Mast, Foos* decision:

> "'There can be no doubt that the doctrine of comity not only, but the orderly administration of justice, requires that the Circuit Court should adopt and and follow the decisions of the Circuit Courts of Appeals in other circuits than their own, rendered upon facts substantially identical. Any other rule would lead to confusion and injustice. Of course in such circumstances the defendant in patent causes may introduce new evidence of anticipation and may show that the facts on which infringement is based are essentially different from those in the adjudicated case. Such proof must carry conviction with it.'
>
> "Appellant's brief bitterly attacks this statement, but we understand it to be an accurate presentation of the law and find nothing in *Mast, Foos & Co. v. Stover Mfg.*, 177 U. S. 488, 20 Sup. Ct. 708, 44 L. Ed. 856, which calls for any different conclusion." *Warren Bros. Co. v. City of New York*, 2d Cir., 187 Fed. 831, 835 (1911).
>
> "We could not acquit this defendant of infringement without finding both of these courts to be in error; but while we doubtless have that power, under Mast v. Stover, 177 U. S. 488, 20 Sup. Ct. 708, 44 L. Ed. 856, yet its exercise could be justified only by that degree of certainty which amounts to a demonstration. We think it is our duty here to adopt the principle declared by Judge Lurton, speaking for this court in Penfield v. Potts, 126 Fed. 475, 478, 61 C. C. A. 371, when he said that 'a decent respect for the stability of judicial decisions and the proper regard for the security of property in patents' requires that prior decisions be fol-

lowed, 'unless convinced of a very palpable error in law or fact'." *Cincinnati Butchers' Supply Co. v. Walker Bin Co.*, 6 Cir., 230 Fed. 453, 454 (1916).

". . . the importance of securing uniformity in the law as administered in the several circuits in patent causes is so great that a decision of a court of coordinate jurisdiction should be followed by this court in every case where the questions presented can fairly be regarded as doubtful. Pratt v. Wright (C. C.) 65 Fed. 99; Enterprise Mfg. Co. v. Deisler, (C. C.) 46 Fed. 855." *Gormley & Jeffrey Tire Co. v. United States Agency et al.*, 2d Cir., 177 Fed. 691, 692 (1910).

"The decision of the Fifth Circuit . . . upon facts substantially identical . . . while not binding upon this court is strongly persuasive under the doctrine of comity." *Williams v. Hughes Tool Co.*, 186 F. 2d 278, 281 (1950), cert. den'd. 341 U. S. 903, pet. for reh. den'd. 341 U. S. 934, 2d pet. reh. den'd. 341 U. S. 956.

See also *American Air Filter Co. v. Continental Air Filters, Inc.*, 6 Cir., 347 F. 2d 931 (1965), cert. den'd. 383 U. S. 934; *Hunt et al. v. Armour & Co.*, 7 Cir., 185 F. 2d 722 (1950); *Robertson Rock Bit Co., Inc. et al. v. Hughes Tool Co.*, 5 Cir., 176 F. 2d 783, cert. den'd. 338 U. S. 938 (1949), pet. for reh. den'd. 340 U. S. 923 (1951), 2d pet. for reh. den'd. 340 U. S. 939 (1951). *Novadel-Agene Corporation v. Penn et al.*, 119 F. 2d 764, cert. den'd. 314 U. S. 645 (1941); *Stoody Co. v. Osage Metal Co., Inc.*, 10 Cir., 95 F. 2d 592 (1938); *Parsons Non-Skid Co. et al. v. E. J. Williams Co.*, 190 Fed. 333 (1911); *La Maur, Inc. v. DeMert & Dougherty, Inc.*, 265 F. Supp. 961 (1965); *General Motors Corp. v. Leishman*, 85 F. Supp. 187 (1949). *Textile Mach. Works v. Louis Hirsch Textile Machine, Inc.*, 13 F. Supp. 476 (1936).

In the present case the Court of Appeals for the Fourth Circuit failed to meet even the minimal demands of the rule of comity among Federal Courts. It paid no deference whatever to the judgment of the Court of Claims. It made no effort to distinguish the facts in the case, although the full record of the Court of Claims was in evidence and it made no suggestion that the Court of Claims had failed to apply the proper statutory provisions or appropriate rulings of the Supreme Court. The Court of Appeals merely reached a contrary conclusion without finding fault with the *ratio decidendi* of the Court of Claims. Contrast this with the treatment by the Court of Appeals for the Eighth Circuit in *John Deere Co. of Kansas City, et al. v. Graham, et al.*, 333 F. 2d 529, aff'd. 383 U. S. 1 (1965), of the prior decisions by the Court of Appeals for the Fifth Circuit in *Jeoffroy Mfg., Inc. v. Graham*, 219 F. 2d 511 (1955) and *Graham v. Cockshutt Farm Equipment, Inc.*, 256 F. 2d 358 (1958). In its opinion the Court of Appeals for the Eighth Circuit gave the precise reason for its inability to follow the prior ruling of the Fifth Circuit.

In the *Mast, Foos* decision, *supra*, at page 489, the Court states:

> "It is scarcely necessary to say, however, that when the case reaches this court we should not reverse the action of the court below if we thought it correct upon the merits, though we were of the opinion that it had not given *sufficient weight* to the doctrine of comity." (Emphasis ours.)

This statement implies that the action of a lower court *should* be reviewed to determine its correctness upon the merits where, on its face, it has given insufficient weight to the doctrine of comity. In this case, the Court of Appeals having given no weight to the doctrine of comity, under the

Mast, Foos ruling, certiorari should be granted to determine whether its decision on the merits was correct.

It is manifest that a stricter application of the doctrine of comity among Federal Courts in patent cases would serve to limit repetitious litigation of a single patent in several courts whether it is held valid or invalid.

C. Direct Conflict Between Decisions Rendered by Different Panels of the Court of Appeals for the Fourth Circuit.

On November 6, 1968 the Court of Appeals for the Fourth Circuit, reversing the judgment of the District Court for the Southern District of West Virginia, held United States Patent No. 3,055,280 valid. *Pavement Salvage Co., Inc. v. Anderson's-Black Rock, Inc.*, 4 Cir., 404 F. 2d 450, certiorari granted March 24, 1969, No. 1014, October Term, 1968. In reversing the District Court, the Court of Appeals emphasized the desirability of avoiding subjective hindsight evaluations of the prior art colored by the knowledge of the disclosure of the patent before the Court and indicated the usefulness of objective criteria of obviousness. In support of its position, the Court of Appeals cited with approval, *inter alia, Blumcraft of Pittsburgh v. The United States, supra.* In the present case a different panel of the Court of Appeals for the Fourth Circuit reversed the District Court's finding of validity of the very patent held valid by the Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra.* There is thus presented a conflict within the Court of Appeals for the Fourth Circuit regarding the soundness of the decision of the Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra.*

The Court of Appeals decision in *Pavement Salvage Co., Inc. v. Anderson's-Black Rock, Inc., supra,* was not

published prior to argument of the present case in the Court of Appeals. However, the decision was rendered several months prior to the decision in the present case with at least one Circuit Judge (Honorable Simon E. Sobeloff) sitting on both panels. Nonetheless, in reversing the District Court in the present case, no reference was made by the Court of Appeals to its prior decision in the *Pavement Salvage Co.* case, nor did it acknowledge the conflicting treatment of the Court of Claims decision in *Blumcraft of Pittsburgh v. The United States, supra.* There is thus presented a direct conflict between the two Court of Appeals decisions with respect to the manner in which the question of obviousness under § 103 of the Patent Act is to be determined and specifically with respect to the decision of the Court of Claims in *Blumcraft of Pittsburgh v. The United States, supra.*[3]

D. Important Question as to the Construction of § 103 of the Patent Act.

By granting the writ of certiorari in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., supra,* this Court acknowledged both the importance and the timeliness of the questions presented. The same basic questions and the same special and important reasons for hearing them at this time are presented in this case.

The District Court in the present case followed all of the directions of the Supreme Court in *Graham v. John Deere Co., supra,* and at the same time applied the high standard of patentability established by prior decisions of the Supreme Court (Appendix p. 26a):

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3. This is parallel to the situation in which the Court granted certiorari in *Graham v. John Deere Co., supra,* one panel of the Court of Appeals for the Eighth Circuit holding a patent valid in *Calmar, Inc. v. Cook Chemical Co.,* 336 Fed. 110 (1964) and a different panel holding a different patent invalid in *John Deere Co. v. Graham, supra.*

> "Had the Court concluded that the combination of elements was obvious to one having ordinary skill in the art, it would not hesitate to hold the patent invalid in view of *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950) . . ."
>
> * * *
>
> "The Court should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. For patents are to 'promote the progress of science and useful arts', Article I, § 8 of the Constitution. Their function is not to bestow monopoly."

The District Court thus made clear that it was applying the same strict test of patentability reflecting the prior decisions of this Court. The District Court found Louis Blum's design patent non-obvious on the basis of the prior art and upon the testimony of defendants' own expert witness Fishleigh attesting the unlikelihood of the Blum design in view of the normal requirements of the ornamental railing art. The validity of the mechanical patent was evidenced by the remoteness of the prior art and the demonstrated unlikelihood that anyone would combine the prior art, as suggested by the defendants, to produce the claimed invention.

The Court of Appeals, in reversing the District Court, was unable to find the inventions in the prior art. Without supporting evidence, the Court did not undertake to demonstrate that the invention was "obvious" as required by § 103 of the Patent Act but only that, because of their high skill, those who had produced the prior art could have redesigned it to achieve Louis Blum's inventions. The Court of Appeals thus ignored the warning of the Supreme Court in *Graham v. John Deere Co., supra,* at page 36, to "guard

against slipping into hindsight . . . and to resist the temptation to read into the prior art the teachings of the invention in issue".

E. Important Question as to the Application of the Patent Act of 1952 to the Design Patent.

The Court has not adjudicated the validity of a design patent in more than seventy-five years. *Gorham Manufacturing Co. v. White*, 81 U. S. (14 Wall.) 511, 524 (1871), *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 677 (1892). The statute governing design patentability has been substantially changed twice during that time: May 9, 1902, Chapter 783, 32 Stat. 193; 1952, 35 *U. S. C.* § 171. While the courts have consistently held that design patents must meet a test of patentability the same as mechanical patents, they have also acknowledged that the application of the statutory tests to the ornamental features of a design requires consideration of factors peculiar to that subject matter. *Glen Raven Knitting Mills v. Sanson Hosiery Mills*, 189 F. 2d 845 (4th Cir. 1951). In *Smith v. Whitman Saddle Co., supra*, this Court rendered its most recent pronouncement:

> "The shape produced must be the result of industry, effort, genius or expense, and new and original as applied to articles of manufacture. *Foster v. Crossin*, 44 Fed. Rep. 62. . The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take a patent for the mere use of a machine. *If, however, the selection and adaptation of an existing form is more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable.*" (Emphasis added.)

It is eminently clear that the "considerable thought and . . . substantial redesign" found by the District Court in this case to be required to produce the Blum design from the elements of the prior art more than satisfies this test (Appendix p. 12a). Even in the opinion of the Court of Appeals below it is not denied that Louis Blum's design is "more than the exercise of the imitative faculty and the result is in effect a new creation".

On the basis of the Court's long-standing decisions in design cases Louis Blum's design is patentable. The Court has held that it was not the intent of Congress by the Patent Act of 1952 to change the standard of invention. *Graham v. John Deere Co., supra.* However, the *Graham* case included no reference to any design patent or design patent case. It would accordingly be entirely appropriate for the Court to accept the present case for review to settle the application of the Patent Act of 1952 to design patents in the light of the Court's prior design patent decisions.

VI.

CONCLUSION.

The present case is submitted to the Court as a proper case for the issuance of the writ of certiorari which, it is recognized, is not a matter of right and only to be used where there are special and important reasons therefor. The several reasons set forth above in the aggregate present two compelling general reasons for this case being considered by the Supreme Court:

1. There are direct conflicts among the Courts on the question of patent validity specifically based upon disagreement as to the application of § 103 of the Patent Act and the Court's decision in *Graham v. John Deere*

Co., supra, to mechanical and design patents. Having granted certiorari in the *Anderson's-Black Rock, Inc.* case, the Court will be able to dispose of directly related important questions in this case.

2. This case affords a proper occasion for the Court to consider the vexing problem of multiple relitigation of a single patent and the limitation of such relitigation through the application of the Federal doctrine of comity.

Petitioners respectfully request that this petition for certiorari be granted and that this case be listed for argument to follow *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., supra.*

Respectfully submitted,

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JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1968.

No. 1355

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

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APPENDIX.

UNITED STATES DISTRICT COURT
D. South Carolina,
Greenville Division.

Civ. A. No. 4168.

May 23, 1968.

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,

Plaintiff,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, Daniel Construction Company, Inc., and Colonial Iron Works, Inc.,

Defendants.

Patent infringement suit. The District Court, Simons, J., held that design patent D-171,963 was valid and infringed and that patent No. 2,905,445 was valid and infringed.

Order in accordance with opinion.

Ralph Bailey, Jr., Greenville, S. C., James C. McConnon, and Henry N. Paul, Jr., Philadelphia, Pa. for plaintiff.

Donald L. Ferguson and W. Francis Marion, Greenville, S. C., and Warren N. Williams and Gordon D. Schmidt, Kansas City, Mo., for defendants.

ORDER.

SIMONS, District Judge.

Plaintiff, Blumcraft of Pittsburgh, a partnership, manufactures architectural metal products such as railing components. This action was brought against defendants under the patent laws of the United States for alleged infringement of U. S. Patents No. D-171,963[1] dated April 20, 1954, and No. 2,905,445[2] dated September 22, 1959, both relating to a railing structure, although to two different railings. Defendants denied infringement and counterclaimed for a judgment that both patents are invalid and not infringed.

Defendant Citizens and Southern National Bank of South Carolina, (C & S), is a corporation doing banking business in South Carolina and has a branch in Greenville. Defendant Daniel Construction Company (Daniel), a corporation having a place of business in Greenville, is a large general contractor. Defendant Colonial Iron Works, Inc., (Colonial), is a corporation having its principal place of business in Columbia where it does subcontracting and fabricating in the miscellaneous iron field.

The railing structure alleged to infringe the two patents in suit was fabricated by Colonial and erected by Daniel in the bank building of C & S in Greenville. The railing components identified as "Clean Line" rail parts were manufactured by and purchased from Architectural Art Mfg., Inc., of Wichita, Kansas. Architectural Arts has controlled and conducted the defense of this suit, but is not a party to

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1. See copy of plaintiff's Ex. 18 appended hereto and marked "Schedule A".

2. See copy of plaintiff's Ex. 101 appended hereto and marked "Schedule B".

this action for the reasons stated in this court's previous order.[3]

Plaintiff's complaint alleges that the defendant, C & S, has been and still is infringing these patents by using ornamental rails embodying each of the patented inventions and that the defendant, Daniel, has infringed these patents by making, selling and using the ornamental rails embodying the patented inventions, and further alleges that the defendants jointly infringed these patents by making, selling and/or using ornamental rails embodying the patented inventions.

Plaintiff further alleges that the aforesaid infringement was done wilfully and deliberately with the intention to deprive the plaintiff of its rights with respect to the patented inventions. Plaintiff was by order filed June 21, 1966, allowed to amend its complaint so as to add Colonial as a party-defendant.

Defendants' answer in substance denies that the plaintiff's patents are valid, and further denies any infringement. Defendants further ask by way of counterclaim for a declaratory judgment that both the design and mechanical patents be declared invalid and void, and that the defendants do not and have not infringed or threatened to infringe any of the claims of the patents in suit.

By reply plaintiff alleges that the patents are valid and that the counterclaim fails to state a claim upon which relief can be granted, and further that the counterclaim states no issue other than those dealt with in the complaint and answer.

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3. Blumcraft of Pittsburgh v. Citizens & Southern National Bank of S. C., 255 F. Supp. 441 (D. S. C. 1966). However, during oral argument after trial, Warren Williams, counsel for defendants and Architectural Art Mfg. Co., Inc., advised the court that his client, Architectural Arts, would indemnify and save harmless the defendants herein from any losses sustained by them as a result of this litigation, even though there was no formal indemnity agreement before trial.

This suit is brought under the provisions of 35 U. S. C. A. § 271 et seq.,[4] alleging infringement by the defendants of the invention of a design patent and a mechanical patent.

The defendants' contention that the patent is invalid is based on 35 U. S. C. A. § 102[5] and 35 U. S. C. A.

4. 35 U. S. C. A. § 271, provides as follows:

"(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

"(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

"(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

"(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement."

5. 35 U. S. C. A. § 102, provides as follows:

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

"(c) he has abandoned the invention, or

"(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for pat-

§ 103.[6] Plaintiff's complaint was filed September 27, 1962, and the case was heard without a jury at Greenville, South Carolina on May 17, 1967. There are essentially four issues: (1) The validity of U. S. Patent No. D-171,963; (2) the validity of U. S. Patent No. 2,905,445; (3) the infringement by defendants of U. S. Patent No. D-171,963; and (4) the infringement of U. S. Patent No. 2,905,445.

Plaintiff has submitted photographs and drawings of railings installed by the defendants at the Citizens and Southern National Bank building in Greenville, South Carolina, together with various other exhibits, in support of its contentions. The defendants have likewise submitted numerous exhibits, drawings and photographs.

FINDINGS OF FACT

The plaintiff is a partnership consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum, all of

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tent in this country on an application filed more than twelve months before the filing of the application in the United States, or

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

"(f) he did not himself invent the subject matter sought to be patented, or

"(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention that shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

6. 35 U. S. C. § 103, provides as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

whom are citizens of the United States and residents of Pittsburgh, Pennsylvania. The firm has its principal place of business at 460 Melwood Street, Pittsburgh, Pennsylvania 15213.

The defendants, C & S, Daniel, and Colonial, are corporations having places of business within the District of South Carolina. The acts complained of by the plaintiff occurred within the District of South Carolina.

There is no issue as to jurisdiction since this action arises under the patent laws of the United States and jurisdiction is conferred by 35 U. S. C. A. § 281 and 28 U. S. C. A. § 1338 as to plaintiff's complaint, and 28 U. S. C. A. §§ 2201 and 2202 as to defendants' counterclaim. Venue is based upon 28 U. S. C. A. § 1400.

In 1958 Lockwood-Greene Engineers, Inc., an architectural and engineering firm having offices in Spartanburg, South Carolina, was retained by C & S to design a new bank facility for construction in Greenville, South Carolina. Lewis S. Booth who testified for the defendants in the trial was in charge of the design of the bank building. The building was constructed by Daniel during 1960 in accordance with specifications and drawings issued by Lockwood-Greene. The specifications called for Blumcraft rails to be used throughout the building with the exception of one overlook rail which was to be a welded galvanized pipe and wire mesh. With the exception of the overlook rail, the specifications of Lockwood-Greene provided that "all descriptions in this specification and details shown on the plans are based on design and catalog numbers that appear in the catalog of Blumcraft of Pittsburgh, Pennsylvania for the purpose of quality and design control. Other manufacturers' items similar in design and quality, in the opinion of the architect, will be considered for substitution in lieu of that specified in details in the drawings."

All of the rails except the one for the balcony were specified to be of the "in line" type wherein the handrails and intermediate rails were in substantially the same verti-

cal plane as the supporting posts. The balcony railing was specified to be of the "offset" type with the handrails and intermediate rails located to one side of a vertical plane composed of the supporting posts, and with the "offset" rails carried on the post by brackets secured to the post. Colonial bid on the miscellaneous iron for the bank building which included the handrails and was awarded the subcontract by Daniel. After the award of the subcontract to Colonial and during construction of the bank building, C & S, the owner, asked the contractor Daniel to take steps to reduce the overall cost of the project. Colonial was asked to reduce the miscellaneous iron cost, if possible; and the use of Architectural Art Mfg., Inc.'s "clean line" handrails was suggested in lieu of the specified rails of Blumcraft referred to in the specifications. Lockwood-Greene approved the substitution of the Archifectural Arts "clean line" handrails on the main staircase "c" of the bank building. Daniel later obtained approval of Lockwood-Greene to use Architectural Arts "clain line" handrails on the patio overlook as a substitute for the welded pipe and wire mesh railing in the original specifications. Neither Daniel nor Colonial requested any change in connection with the Blumcraft hand railing originally specified for the patio balcony railing.

Neither the handrail shown and described in Patents No. D-171,963, nor No. 2,905,445 was specified in the original specifications of the Citizens and Southern National Bank building in Greenville, and no bid based on such rail was ever made by Colonial in connection with such building. The railings were composed of parts manufactured by Architectural Arts Manufacturing Company of Wichita, Kansas. They were purchased from defendant Colonial, installed by the defendant Daniel, and have been used by the defendant C & S in its Greenville building. The patents in suit had been issued and were in effect during the period of construction, and continue to be valid unless proved invalid by the defendants in the present suit.

The defendants contend that both patents are invalid due to the state of the prior art, and that the patents were obvious, which in itself invalidate the patents.

There was a vast change in architecture to the modern or contemporary style following the turn of the century and there existed a need for railings compatible with the modern design and made up of standard component parts, which could be made available from stock and readily adapted by an architect to suit the exigencies of a particular building structure.

Many railings were designed on a job-by-job basis, and many persons attempted to produce something harmonious or compatible with the modern design of buildings. Despite much effort this need persisted and no railing manufacturers were offering for sale a commercially usable railing system in which a plurality of handrails are disposed away from the supporting post, producing a "floating" visual effect.

Louis Blum, a partner in the Blumcraft firm, in 1952 conceived the railing design in suit to be used as a stairway railing in a private residence. He spent two months working on the design, made rough sketches, had a model built, and employed a patent attorney in development and procurement of the patent; he was granted the design patent (D-171,963) April 20, 1954.

Mr. Blum testified that he wanted "to develop an original railing and something that should be novel, and I came up with something to avoid having always having a handrail directly over the post and the same with any other members below, so I arrived at this floating system in which the posts are in one plane, and the other handrail group of members would be in another plane, and give the illusion of separation between the two planes, group of handrails, and between the posts." (Tr. 13). It is apparent that he went to considerable expense in developing the design and securing the patent.

The design by Louis Blum of the design patent in suit satisfied the need which had developed in the art over the years. The design patent (No. D-171,963) depicts a number of vertically spaced, horizontal railings supported by a plurality of horizontally spaced, vertical posts. The rails appear to have a clean sweep of continuous uninterrupted lines, separate from the upright units, and so arranged in relation to such upright units as to present the effect of floating in space. More particularly it is described as follows:

a. A plurality of spaced parallel posts generally rectangular in cross section and arranged so as to present a series of spaced parallel vertical surfaces;

b. A plurality of spaced parallel hand rails generally flat or rectangular in cross section and arranged in the same vertical plane so as to present a series of parallel horizontal surfaces;

c. Connecting brackets attaching the underside of each handrail to the adjacent edge of each post, each bracket comprising a rod-like member extending at right angles to the post and a substantially flat triangular member extending upward from the rod-like member to the center of the underside of each rail leaving the rail unobstructed throughout the hand-gripping portion thereof;

d. The aforesaid elements so designed and arranged as to cause the handrails to appear to float in space away from the posts.

Prior to 1952 the Blumcraft firm did only custom built work. After the new design it relinquished custom built work and sold parts to all fabricators. The Blumcraft railing achieved remarkable success in the trade. The railing was described as having a classical lasting design.

Dr. Henry L. Kamphoefner, architect and Dean of the School of Design at North Carolina State University and expert witness for plaintiff, stated that prior to 1952 most of the railings were designed by the architects and it was not until the Blumcraft patent that a prefab railing came into existence. He also stated that Sweet's Catalog is an outstanding publication for architects, and that no design railings shown in Sweet's Catalog which were comparable to the modern design of buildings were available before the Blumcraft railings. He listed the features of the design patent No. D-171,963 as: (1) A series of parallel surfaces; (2) parallel horizontal surfaces contrasted by a series of vertical posts; (3) mechanical features or fasteners that connect rails to posts; (4) the visual impression created, which is comparable to modern design, and which gives a "floating in space" effect to the horizontal railings which are offset from the vertical posts and have small connections that are unobvious and not easily seen. The prior art at the time of the design patent was limited to railings directly mounted on the supporting posts or single handrails mounted offset from the supporting posts or a wall.

The design patent in suit, No. D-171,963, was previously involved in litigation in the Court of Claims.[7] In that case the patent was found valid and infringed. The accused railing in the Court of Claims case was a different railing from the accused railings here, but nevertheless was quite similar as is shown by Plaintiff's Exhibits 15, PX-39 and PX-112.

Following the development of his railing design, Louis Blum developed in 1955 a mechanism for mounting an ornamental handrail in spaced relation to an ornamental post, at the same time providing ornamentation and structural rigidity. This mechanism was developed commercially by

7. Blumcraft of Pittsburgh v. United States, 372 F. 2d 1014, 178 Ct. Cl. 798 (1967).

plaintiff and put on sale in 1956. This mechanical patent, No. 2,905,445, was granted to him September 22, 1959. Architectural Arts purchased prior to 1959 some $15,000 worth of tube line railing from plaintiff. Total purchases for all railings were in excess of $30,000. Plaintiff in the summer of 1959 saw the catalog of Architectural Arts and learned of the accused railings and also saw in The South Carolina Magazine of Architecture a picture of the accused railing in the Citizens and Southern Bank building at Greenville.

DISCUSSION OF ISSUE NO. I—VALIDITY OF DESIGN PATENT NO. D-171,963

A patent is presumed to be valid and the burden of proof is upon the one attempting to establish its invalidity. 35 U.S.C.A. § 282.

The defendants in attacking the validity of the design patent in suit rely on numerous publications showing various railings and railing components as follows:

(1) Arch. Record, April 1933, pp. 235, 267, 269 (DX-94a, b, c)

(2) Arch. Record, July 1934, Title Page, pp. 5, 19 (DX-95a, b, c)

(3) Arch. Forum, March 1937, Title Page, pp. 219, 222 (DX-96a, b, c)

(4) Arch. Record, Oct. 1938, pp. 5, 39, 46 (DX-97a, b, c)

(5) Arch. Record, March 1940, pp. 5, 143 (DX-98a, b)

(6) Arch. Record, August 1940, pp. 5, 65, 68 (DX-99a, b, c)

(7) Arch. Record, Sept. 1941, Title Page, pp. 41, 45 (DX-100a, b, c)

(8) Arch. Forum, Oct. 1942, Title Page, pp. 35, 43 (DX-101a, b, c)

(9) Arch. Record, Nov. 1945, pp. 5, 60 (DX-102a, b)

(10) Sweet's catalog Service 1950, Sec. $\frac{6e}{5}$, p. 3 (DX-103d)

(11) Arch. Forum, July 1950, Title Page, p. 75 (DX-104a, b)

(12) Sweet's Catalog Service 1952, Sec. $\frac{6c}{RE}$, p. 14 (DX-105d)

(13) Arch. Record, July 1952, Cover Page, Title Page pp. 149, 163 (DX-106a, b, c, d)

(14) Arch. Detailing 1952, p. 166 (DX-113a, b)

(15) Sweet's Arch. 1952, Sec. $\frac{6e}{HA}$, p. 7 (DX-116a)

(16) Sweet's Arch. 1952, Sec. $\frac{6e}{BL}$, p. 3 (DX-116b)

Public Use, Hollander Mfg. Co. (DX-21 through DX-80)

In addition to the publications set forth above, defendants rely upon an alleged prior use, the subject matter being a railing forming part of the main stairway of the Home Federal Savings and Loan Building on State Street in Chicago, Illinois. Defendants also allege that the design was obvious. If there were either a prior use, or the design were obvious, the patent in question would be invalid.

It is true that rails have been offset from supporting members or posts in prior use, and that some railings have had multiple parallel rails. However, there was nothing in the art at that time which gave the effect of the plurality of spaced parallel handrails and a plurality of vertical planes, as does plaintiff's rail. None of the exhibits relied on by the defendants as prior art have the distinctive features of the Blum design. In fact considerable thought and a substantial redesign of the cited exhibits by the defend-

ants would be necessary in order to achieve the design having the distinctive features of the Blum design.

Obviousness, as stated earlier, would also invalidate the patent. But only through hindsight does the design appear obvious, which of course is not the test. In applying the test of invention over prior art, we must bear in mind that hindsight is more revealing than foresight. Preformed Line Products Co. v. Fanner Mfg. Co., 328 F. 2d 265, 271 (6th Cir. 1964), cert. den'd. 379 U. S. 846, 85 S. Ct. 56, 13 L. Ed. 2d 51. There being no reason for the lower railings to be offset the design becomes more unobvious. Defendants' expert witness, Mr. Fishleigh, testified that plaintiff's design was contrary to the normal design in railings. He said "it is contrary to what I would want any way. In other words, if I want a railing, I don't want one which is floating loose, kicking around; I want one which in my instance would give some degree of or indication of rigidity, that if I thought I got ahold of it, it would hold me." The plaintiff's design is even more unusual in view of the normal expectation that a rail would and should appear very stable. Plaintiff's design is quite contrary to this in that it produces a floating effect, as opposed to an appearance giving stability.

Mr. Fishleigh further testified that no one example of the prior art "anticipated" the design patent, but that it was necessary to combine earlier references to anticipate the design patent. But separate presence in the prior art of each element of combination will not prevent a finding of invention. Wham-O-Mfg. Co. v. Paradise Mfg. Co., 327 F. 2d 748 (9th Cir. 1964).

As stated by the court in Try-Me Beverage and Compound Co. v. Metropole, 25 F. 2d 138 at 139 (E. D. S. C. 1928):

> "It is not necessary for a design patent that all the elements of the design be new; it is essential that

the elements, whether new or old, be grouped or combind in such a manner as to produce a pleasing appearance, different from what has preceded it. The fact that the elements of a design patent were old does not establish want of invention in assembling them. The decisive question is whether or not the design imparts a pleasing impression to the eye of ordinary observers." (Citations omitted.)

Recognizing that it was not new to provide an offsetting handrail from the supporting structures, nevertheless, it was new to offset all the rails in this particular manner so as to minimize the connection between the railings and the posts, thus giving the floating effect.

The entire record in the Court of Claims case was offered in evidence by the planitiff in this case [8] and plaintiff contends that such decision is *res judicata* as to the validity of the design patent.

The court, however, need not decide whether the Court of Claims case is *res judicata* as to the validity although such decision was persuasive, for this court has reached its own independent determination that the plaintiff's design patent is valid.

The presumption of validity,[9] the prior judicial deter-

8. Note 7, supra.

9. 35 U. S. C. A. § 282 provides as follows:

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

"The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

"(1) Noninfringement, absence of liability for infringement or unforceability,

"(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

"(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of sections 112 or 251 of this title,

"(4) Any other fact or act made a defense by this title.

mination [10] and the commercial success [11] achieved by the plaintiff overcome any doubt as to the validity of the design patent. Robertson Rock Bit Co. v. Hughes Tool Co., 176 F. 2d 783 (5th Cir. 1949), cert. den'd, 338 U. S. 948, 70 S. Ct. 487, 94 L. Ed. 585. Inasmuch as defendants have failed to sustain their burden of proving that the design would have been obvious at the time it was made to one having ordinary skill in the art, or that there was a prior use, the court finds the design patent valid.

DISCUSSION OF ISSUE NO. II—INFRINGEMENT OF DESIGN PATENT D-171,963

Having found the design patent valid the next question is whether the defendants have infringed it. In determining whether an accused structure infringes a patent, the rule of reason must prevail and the real test is whether in substance the defendant has used the inventor's idea as embodied in the inventor's structure. Trenton Industries v. A. E. Peterson Mfg. Co., 165 F. Supp. 523 (S. D. Cal. 1958). The test of infringement in design patent cases may be stated as follows: If, in the eye of an ordinary observer giving such attention as a purchaser usually gives, the two

9. (continued)

"In actions involving the validity or infringement of a patent the party asserting invalidity or noninfringement shall give notice in the pleadings or otherwise in writing to the adverse party at least thirty days before the trial, of the country, number, date, and name of the patentee of any patent, the title, date, and page numbers of any publication to be relied upon as anticipation of the patent in suit, or except in actions in the United States Court of Claims, as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or having previously used or offered for sale the invention of the patent in suit. In the absence of such notice proof of the said matters may not be made at the trial except on such terms as the court requires."

10. Note 7, supra.

11. Glen Raven Knitting Mills v. Sanson Hosiery Mills, 189 F. 2d 845 (4th Cir. 1951).

designs are substantially the same and the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the patented design is infringed by the other; Gorham Co. v. White, 81 U. S. 511, 20 L. Ed. 731 (1871); R. M. Palmer Co. v. Luden's, Inc., 128 F. Supp. 672, 236 F. 2d 496 (3rd Cir. 1956); Sanson Hosiery Mills v. Warren Knitting Mills, 202 F. 2d 395 (3rd Cir. 1953).

Defendants claim those who purchase railing systems for buildings or designate the ones to be purchased, such as architects, give considerable study to the photographic representations, elevational views of the overall railing and parts thereof, and sectional views available in the manufacturers' and suppliers' catalogs and brochures before selecting any particular railing system, and give particular attention to the design details since these contribute to and distinctly affect the overall appearance of the railing. While this is true architects are not the only ordinary purchasers of railings. In fact an ordinary man on the street may choose which railing or design he might prefer in his building or home. Aside from this, the fact that defendants' own witness was unable to tell whether the illustration in the C & S Bank drawings was a Blumcraft or Architectural Art railing is certainly evidence that even one skilled in the art may be confused between the two.

Defendants' witness Louis P. Booth, in explaining why the Blumcraft railing was not installed and why the accused railing was substituted therefor, stated that the contractor of the building asked that another company's handrail be considered for several reasons, including availability, cost and design. The proposed rails had five parallel rails and the substitute had three rails. Other testimony also reveals that one of the reasons given for the substitution was that of economy, i.e. the substituted rails were less expensive. Among others, this of course is one of the basic

reasons for our patent laws. When an individual expends time, money, and patience in the development of a new invention, he has gone to considerable expense. It is only fair that he be granted a patent so that he may recoup some or all of his expense, and enjoy the benefits that he may derive from his invention. Otherwise, an infringer could merely copy an article without expending time, research or resources to develop an invention, and still reap the same benefits.

The fact that Blumcraft of Pittsburgh railings were specified in the plans is of no particular significance since in this case and in most cases it is usually stated that the products of other manufacturers may be used in lieu of those specified which are similar in quality and design in the opinion of the architect.

The defendants' witness Booth enumerated some of the differences in the two railings as follows:

> "A. The first thing that strikes my attention is that in the cross-section shape of the vertical supports, the patent drawing is definitely rectangular in shape, whereas the photograph is square. The vertical shape of the drawing in patent is much more stressed than in the photograph because of the interruption of the photograph of the brackets, which hold the hand rails. The shape of the hand rail is considerably different. That in the photograph being a much stronger, architecturally, than the soft oval form of the drawing. The termination of the flared rails of the three members in the photograph is entirely different from the drawing which has termination of the top rail in a vertical extension to the floor, and the horizontal rails are cut directly. The shape of the brackets is different in that the photograph has a conical-horizontal member, whereas the drawing appears to be cylindrical in shape.

> The attachment to the stair in the photograph is an exposed bracket, and in the drawing it would be a concealed insert into the side of the stair. The top of the posts in the photograph is a truncated pyramid, and is higher in relation to your top rail, whereas in the drawing it is curved and ends directly at the top bracket attachment. I believe that. * * *"

He stated that in his opinion the accused railing could be distinguished from the patented railing. The court agrees with him. They can be distingushed upon examination by attempting to so distinguish them; however, changes in detail so as to distinguish them will not prevent an infringement.

The defendants in distinguishing the accused structure from the design patent listed numerous other differences, none of which were substantial. After the defendant in Try-Me Beverage & Compound Co. v. Metropole, supra, pointed out numerous differences in the design on that case, the court said:

> "It is not necessary to decide whether or not the above dissimilarities may on close inspection be found in the two designs. The test of infringement is not whether dissimilarities between two designs may or not be found. The courts hold, on the question of infringement, that if, in the eye of an ordinary observer, two designs are substantially similar, and if the resemblance is such as to deceive an observer, the first design patented may be held to be infringed by the other."

The essence of a design patent resides in the appearance of the design as a whole, not in the elements individually or in their method of arrangement. 69 C. J. S. Patents § 71. The United States Supreme Court in Graver Tank &

Mfg. Co. v. Lande Air Products Co., 339 U. S. 605, at page 607, 70 S. Ct. 854, at page 856, 94 L. Ed. 1097 (1950) stated:

> "[T]o permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to make the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system."

It is the overall impression to the ordinary observer giving such attention as a purchaser usually gives that is important. Gorham v. White, 81 U. S. 511, 20 L. Ed. 731 (1871); Nebel Knitting Co. v. Sanson Hosiery Mills, 214 F. 2d 781, 783 (4th Cir. 1954).

Defendants' witness Booth testified in a deposition in 1963 that the railing in the balcony before the window overlooking the patio and the railing around the patio overlook should be "uniform" in appearance. At the trial he said they should be "compatible", but would not object to the word "uniform" as he had used in his deposition. His use of the word "uniform" indicates that he himself considers that there is no substantial distinction or difference between the two railings.

It appears from the evidence that defendants purchased the patented rails and made certain changes but essentially have manufactured the same railing.

No evidence was offered by the defendants to show any independent origin of the accused railing system produced by Architectural Art Manufacturing Company after the plaintiff in its presentation had shown opportunity and inclination of the defendants to copy the patented railings in question. Here access and similarity is strong evidence of copying the same as access and similarity is strong evidence of copying in a copyright case. Bradbury v. Columbia Broadcasting System, Inc., 287 F. 2d 478 (9th Cir. 1961).

As stated earlier, the entire record in the Court of Claims case was offered in evidence by the plaintiff in this case.[12] The accused railings in the present case are substantially the same in design as the accused railings in the Court of Claims case (PX-15, PX-39, PX-112). The accused railings in the present case embody each of the distinctive features held by the Court of Claims to characterize the Blum design patent in the Court of Claims case.

The distinctive features of both the plaintiff's and defendants' railings produce the same overall effect, producing a clean uninterrupted sweep of parallel rail surfaces giving the impression that the surfaces float away in space from the posts to which they are connected by the minimization of the connecting factors. Upon detailed inspection of each in a side-by-side comparison differences are apparent, but mere differences in detail have not changed the overall effect so as to amount to a different design from the patent in suit.

The court finds the accused railing substantially similar to plaintiff's design patent, and accordingly finds the design patent infringed.

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12. Note 8, supra.

DISCUSSION OF ISSUE NO. III—VALIDITY OF MECHANICAL PATENT NO. 2,905,445

The mechanical patent in suit (No. 2,905,445) is characterized by a clamping connector for connecting an ornamental handrail in spaced relation to an ornamental post, comprising separate v-shaped clamping means which receive and clamp the dovetail-shaped base portion of the handrail. More particularly the distinctive features of the Blum mechanical patent in suit, as set forth in Claims 1 and 3 of the patent, are as follows:

> "1. In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape based portion and an upper hand-gripping portion, separate V-shape clamping means in juxtaposition forming a dovetail shape recess receiving and clamping the dovetail shape base portion of said rail means and exposing the upper portion of said rail means for hand-gripping, connecting means rigidly connecting said clamping means and said rail means in spaced relation to said post means and threaded bolt means passing through said clamping means forcing and retaining said clamping means together.
>
> "3. In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, means connecting said rail means in spaced angular relation to said post means comprising a pair of separate clamping members, the first of said clamping members being rigidly affixed to said post means and extending outwardly therefrom, the second of said clamping members being connected to said first clamping member by threaded bolt means, said clamping members having complementary V-shape portions

forming a dovetail recess receiving the dovetail shape portion of said rail means and exposing the upper portion of said rail means for hand-gripping."

On the issue of the validity of the mechanical patent in suit, defendants rely upon 22 different patents and publications showing various structures as follows:

(1) Pat. No. D-173,299 (DX-83)—(Blum)

(2) Pat. No. 1,864,160 (DX-84)—(Williams)

(3) " " 163,996 (DX-85)—(Hardy)

(4) " " 837,769 (DX-86)—(Allen)

(5) " " 1,165,193 (DX-87)—(McNeil)—Sometimes referred to as 1,165,195.

(6) Pat. No. 1,569,060 (DX-88)—(Wright)

(7) " " Re 17,629 (DX-89)—(Wehr)

(8) " " 2,056,842 (DX-90)—(Edgecomb)

(9) " " 2,427,723 (DX-91)—(Hawkins)

(10) " " 2,654,579 (DX-92)—(Cremens)

(11) " " D- 171,963 (DX-93)—(Blum)

(12) Arch. Record, July 1934, Title Page, pp. 5, 19 (DX-95a, b, c)

(13) Arch. Forum, March 1937, Title Page, pp. 219, 222 (DX-96a, b, c)

(14) Arch. Record, March 1940, pp. 5, 143 (DX-98a, b)

(15) Arch. Record, Sept. 1941, Title Page, pp. 41, 45 (DX-100a, b, c)

(16) Arch. Forum, Oct. 1942, Title Page, pp. 35, 43 (DX-101a, b, c)

(17) Arch. Record, Nov. 1945, pp. 5, 60 (DX-102a, b)

(18) Sweet's Catalog Service 1950, Sec. $\frac{6e}{5}$, p. 3 (DX-103d)

(19) Sweet's Catalog Service 1953, Sec. $\frac{5e}{BL}$, pp. 2, 3 (DX-107d, e)

(20) Sweet's Catalog Service 1954, Sec. $\frac{5e}{BLU}$, pp. 2, 3 (DX-108b, c)

(21) Home Fed. Sav. & Loan—Photo No. 4 (DX-109c)

(22) Home Fed. Sav. & Loan—Photo No. 9 (DX-109d)

They rely particularly on the Hardy, Allen, McNeil, Wright, Edgecomb and Wehr patents; also upon the prior use as follows: Arch. Record, July 1934, p. 19, Hawkins, Cremens, Home Federal Savings & Loan, Chicago. Arch. Record, November 1945 at p. 60; Arch. Forum March 1937, p. 222. They also rely upon the plaintiff's other patent in suit, the Blum Design Patent No. 171,963.

The principal art relied upon by the defendants to invalidate Claim 1 of the mechanical patent is the Hardy Patent No. 163,996 and the 1954 Blumcraft Catalog reference. Defendants' witness Fishleigh through the use of these two references attempted to create a structure as defined by the plaintiff's claim. He testified (pp. 401, 403, 404 of Tr.) as follows:

> "In other words, I have previously pointed out that this Hardy patent shows what has been referred to here as in-line rail, where the rail was right in line with the post. Then I go on to say it would have been an obvious mechanical expedient, if desired, to have used

an intermediate laterally extending member 'D', rigidly connected to the post, such as illustrated in the 1954 Blumcraft of Pittsburgh Catalog, and to have fastened the clamping means and the rail to the end thereof in laterally spaced relation to the post. And what I am saying is that in effect that if one wanted to take and use this hand rail in offset relationship, that you could use the post and the horizontal part D of the clamping means with rather minor modifications, adjusted so that you could then clamp the rail to that horizontal portion and have a structure filly [sic] respondent. * * *

"In order to show how simple such an aggregation would be, I have prepared what I would call an adapter member. * * * Now, the upper part of that member conforms in cross-section substantially to the cross-section of the upper part of the post in the Hardy patent. The lower part of that member conforms substantially to the lower, to the shape and configuration of the vertical so-called triangular clamping member, or connecting member, in the Sweet's file, or the Blumcraft, the structure of the Blumcraft 1954 catalog of which this DX-102A to D inclusive is the model. Now, all that is necessary is to remove the post from Hardy, put in the adapter member, take off the rail from the Blumcraft device, and we have the Hardy rail, mounted in an offset position with respect to the post instead of being in-line as they were in the Hardy structure itself."

On cross-examination concerning his adapter member Fishleigh stated that it was new, and that the Hardy and the 1954 Blumcraft reference had not been combined together before:

"Q. But there is no other part that is the same as this (the adapter) that you know of?
A. In toto?
Q. Yes.
A. No." (p. 522)

He developed an entirely new member to combine them, and then it was apparently through hindsight. His attempt to produce the structure vividly demonstrates the unlikelihood that anyone skilled in the ornamental railing art would attempt to do so.

As to the McNeil Patent No. 1,165,193, heavily relied on by defendants, it cannot be used to invalidate plaintiff's patent. Although certain elements are the same McNeil was used as anti-creeping device for railroad tracks, something far removed from the art in which the present invention resides.

In speaking on the issue of obviousness Judge Learned Hand in Reiner v. I. Leon Co., 285 F. 2d 501, 503, 504 (2nd Cir. 1960) said:

> "The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e. g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how im-

mediately was the invention recognized as an answer by those who used the new variant?"

In Entron of Maryland, Inc. v. Jerrold Electronics Corp., 295 F. 2d 670, 675 (4th Cir. 1961), the Fourth Circuit Court of Appeals said that these general principles have guided their decisions for many years.

These factors were considered as to both the mechanical and design patents, and are set out in the foregoing discussion. For this reason the court will not linger on these points.

The test of invention where old elements are used in the alleged invention is whether those elements are used in a manner different from the previously known use in such a way that the alleged invention would not have been obvious to one skilled in the art. Preformed Line Products Co. v. Fanner Mfg. Co., supra, 328 F. 2d at 272; Maytag Co. v. Murray Corporation of America, 318 F. 2d 79, 81 (6th Cir. 1963). It is significant that the spacing connector in the Blum patent also serves as the clamping means, and this was a new function. The fact that numerous elements singly have been known for years to those skilled in the art does not necessarily invalidate a patent, for the patent may rest in the novel functions of these elements in combination. A combination of old elements may be patentable if they "perform, or produce a new, different or additional function or operation in the combination than that theretofore performed and produced by them." Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162 (1950); Entron of Maryland, Inc. v. Jerrold Electronics Corp., supra.

Had the court concluded that the combination of known elements was obvious to one having ordinary skill in the art it would not hesitate to hold the patent invalid in view

of Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp. (1950), 340 U. S. 147 where at page 152, 71 S. Ct. 127 at page 130, the Court said:

> "The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, * * * their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, * * * obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men."

The court should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. For patents are to "promote the Progress of Science and useful Arts." Article I, Sec. 8 of the Constitution. Their function is not to bestow a monopoly.

A significant asset of Blum's mechanical patent was the flexibility allowed in combination with rigidity as is required in rails. This is shown by the following testimony of Louis Blum (Tr. p. 39):

> "Q. What is the significance of this adjustability you referred to, why is that important?
> A. Well, in the building construction there is nothing perfect, and without going to extensive measurements, and handfitting bevels and pitches, which we call them in stairway. For example, even though an architect's drawing may indicate certain measurements on a flight of stairs going up, a good example is the concrete, and they pour the concrete and the tolerance is so great that the holes that were drilled in there for let's say for fastening the post to the stairway, would create

imperfect, not perfect as far as dimension is concerned, but say with the bevels. Well, this eliminates all these problems by having it adjustable.

Q. What would you do if it weren't adjustable?

A. Well, they would have to be carefully measured, careful layouts made of the plans, and each member hand fitted."

Although it was not new in the art to have a rail offset from the post, it was novel to have the Blum type of connector for attaching the rail so as to give adjustability to the particular need and rigidity as is required for railings.

One of the most important features of the mechanical patent is the flexibility allowed in combination with rigidity. The rail portion can be adjusted when the clamping members are loose and may be moved, whereas when tightened they are completely rigid. Although the defendants attack the validity of the patent with numerous exhibits, particularly the Hardy and McNeil Patents, the court finds that none of the prior art shows this type of mechanical arrangement:

This court does not find that Blum developed the mechanical patent from Hardy, the earlier Blum patent, or from McNeil. Even if such a conclusion were reached, the court would nevertheless conclude that Blum's acts "in combining the pertinent elements of the prior art * * * achieved a result not obvious to mere mechanical skill." Preformed Line Products Co. v. Fanner Mfg. Co., 328 F. 2d 265, 273 (6th Cir. 1964), cert. den'd 379 U. S. 846, 85 S. Ct. 56, 13 L. Ed. 2d 51. Both mechanical and design patents of plaintiff represent more than a " 'mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, * * *.' Great Atlantic & Pacific Tea Co. v.

Supermarket Equipment Corp., 340 U. S. 147, 151, 71 S. Ct. 127, 130, 95 L. Ed. 162," for here was a method by which to offset the railings with a minimization of the connecting factors, plus allowing adjustability to the particular need.

The mechanical patent was new and filled a need in the art which now enables the production of prefabricated railings of modern design producing a floating effect through the minimal connection between posts and rails. Accordingly this court finds patent No. 2,905,445 valid.

DISCUSSION OF ISSUE NO. IV—INFRINGEMENT OF MECHANICAL PATENT NO. 2,905,445

As earlier quoted from Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U. S. 605, at page 607, 70 S. Ct. 854, at page 855:

> "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.
>
> "But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and

forthright duplication is a dull and very rare type of infringement."

As stated in Marston v. J. C. Penney Co., 353 F. 2d 976, 985 (4th Cir. 1965), cert. den'd 385 U. S. 974, 87 S. Ct. 515, 17 L. Ed. 2d 437, patent infringement is first determined by looking to the words of the claims of the patent:

> "To determine whether the accused article infringes * * * we must look to the words of the claims. If every essential element of the described combination, or its equivalent, is embodied [in the accused article, the plaintiff] is entitled to prevail."

The Claims

The duplication of each of the elements of the Claims of the Blum patent by the accused Architectural Art structure is sufficiently demonstrated in Exhibits PX-103 and PX-107. They show the corresponding parts of the respective railings colored the same. (Blum, Tr. 34-41).

1. With respect to *Claim 1*, the Claim requires:

> "In an ornamental rail structure, ornamental post means"

Both structures are ornamental railings and in each case there is an ornamental post, colored blue. The Claim next provides:

> "Ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion"

In each case there is an ornamental rail having a dovetail-shaped base portion, colored yellow, and an upper hand-gripping portion, colored brown. The Claim continues:

> "separate V-shape clamping means in juxtaposition forming a dovetail shape recess receiving and clamping the dovetail shape base portion of said rail means and exposing the upper portion of said rail means for hand-gripping"

In both the patented and accused structures, the yellow dovetail-shaped base portion of the ornamental rail is gripped by a pair of V-shaped clamping means, colored pink, in juxtaposition forming a dovetail-shaped recess. The Claim then requires:

> "connecting means rigidly connecting said clamping means and said rail means in spaced relation to said post means"

The means for connecting the pink clamping means and the yellow and brown ornamental rail in spaced relation to the blue post are colored red in each exhibit. Finally, the Claim provides for:

> "threaded bolt means passing through said clamping means forcing and retaining said clamping means together."

In each case there is a threaded bolt, colored gold, which is threaded into the threaded bore, colored green, within the pink clamping means of each railing assembly.

The duplication of the elements defined by Claim 1 of the Blum patent in the defendants' structure is evident. It is further apparent that the defendants have duplicated the unique feature of the Blum railing mechanism by which the clamping means and the connecting means are partly included within the same member, namely, the member extending horizontally from the post.

As demonstrated, there is no difference between the defendants' structure and that claimed in Claim 1 of the

Blum patent. In attempting to avoid infringement, the defendants contend:

> (1) that the yellow colored element is not really a "base portion" in the defendants' structure and that therefore the V-shaped pink elements do not grip a base portion, despite the fact that it is the lowest portion upon which the railing is based;
>
> (2) that in defendants' structure "there is no means for connecting one clamp member separately to to the post or bolting one clamp member to the other clamp member," despite the fact that there is no such requirement in the claim;
>
> (3) that there is nothing in the defendants' structure which corresponds to the threaded bolt 16 of the Blum patent, despite the fact that the defendants' structure uses a threaded bolt to perform precisely the same function in the same way in the defendants' structure to force the clamping means together.

The defendants' structure falls clearly within Claim 1 of the Blum patent. The only differences between the defendants' structure and the embodiment illustrated in the Blum patent are visual, and these visual differences in no way relate to the true invention or the Claims.

> "'* * * If the patentee's ideas are found in the construction and arrangement of the subsequent device, no matter what may be its form, shape, or appearance, the parties making or using it are deemed appropriators of the patented invention, and are infringers.'" Fauber v. United States, 37 F. Supp. 415, 443, 93 Ct. Cl. 11 (1941).

2. With respect to *Claim 3* of the Blum patent, it calls for:

"In an ornamental rail structure, ornamental post means"

In both cases, as shown in the Exhibits PX-103 and PX-107, there are ornamental rail structures for an ornamental post, colored blue. Claim 3 next requires:

"ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion"

In each case there is an ornamental rail having the upper hand-gripping portion, and a dovetail-shaped base portion, colored yellow. The Claim next provides for:

"means connecting said rail means in spaced angular relation to said post means comprising a pair of separate clamping members, the first of said clamping members being rigidly affixed to said post means and extending outwardly therefrom, the second of said clamping members being connected to said first clamping member by threaded bolt means, said clamping members having complementary V-shape portions forming a dovetail recess receiving the dovetail shape portion of said rail means and exposing the upper portion of said rail means for hand-gripping."

In each case there is means connecting the rail to the post in spaced angular relation. In each case the connecting means comprises a pair of members having complementary V-shaped portions forming a dovetail recess receiving the dovetail-shaped portion of the rail. In each case the first of said clamping members is rigidly affixed to the post. In the case of the plaintiff's structure, the first clamping member is a single piece. In the defendants' accused structure, the first clamping member is made up of two pieces which are joined together in the assembled railing. In the case of each of the railings, the second clamping member is con-

nected to the first clamping member by a threaded bolt. In each case the ornamental rail is so gripped by its base portion that the upper portion is exposed for hand-gripping.

In the case of the infringement of Claim 3 by the defendants' structure every element of the Claim finds correspondence in the accused railing assembly. The only difference other than visual between the accused structure and the embodiment of the patented structure illustrated in the patent is that the first clamping member in the patent is a single piece, while in the defendants' structure the first clamping member, performing the identical function, is made up of two pieces joined together in the assembled railing. It is well settled that the mere separation of a single member into two parts performing the same function does not avoid infringement. Abbott v. Barrentine Manufacturing Company, 255 F. Supp. 890, 899 (N. D. Miss. 1966); No-Joint Concrete Pipe Co. v. Hanson, 344 F. 2d 13 (9th Cir. 1965), cert. den'd 382 U. S. 843, 86 S. Ct. 79, 15 L. Ed. 2d 83; Specialty Equipment & Mach. Corp. v. Zell Motor Car Co., 193 F. 2d 515, 518 (4th Cir. 1952). In the latter case it was said that where a valuable contribution is made to the art, the patent is entitled to liberal treatment.

In attempting to avoid infringement of Claim 3 of the Blum patent, the defendants argue:

> (1) that the first clamping member of the accused structure is not "separately rigidly affixed directly" to the post and the second clamping member is not "bolted directly and solely to the first clamping member," despite the fact that there are no such limitations in the claim, which merely requires a pair of "separate clamping members" connected by a threaded bolt;
>
> (2) that the accused structure has no element corresponding to the threaded bolt 16 of the Blum patent,

despite the fact that the defendants' structure employs a threaded bolt to perform the same function in the same way to connect the clamping members together;

(3) that, as argued in connection with Claim 1, the dovetail portion of the ornamental rail is not a "base portion" and therefore the clamping members do not receive a base portion of the rail, despite the fact that the yellow-colored dovetail element in the defendants' structure is the lowest portion of the ornamental rail upon which it is based.

The accused ornamental railing structures respond fully to the mechanical invention as set forth in Claims 1 and 3 of the Blum mechanical patent. Claim 1 is infringed literally; the same is true of Claim 3, save that the "first clamping member" recited in the Claim finds response in two elements which are joined together to perform the same function in the accused structure. The accused structures are mechanically the same as the one embodiment in the invention described in the specification of the patent. The accused railings however differ in their visual appearance from the embodiment shown in the mechanical patent by virtue of the upward extension of the clamping members. The accused railing structures serve the purpose of the mechanical patent in suit by performing the same function in substantially the same way by virtue of producing a rigid clamping connection for connecting an ornamental railing in spaced relation to an ornamental post by means of separate v-shaped clamping means which receive and clamp the dovetail shaped base of the railing. Although the accused railing structure does not have a first clamping member which is separately, rigidly affixed directly to the post as in the patent, it appears evident that the accused telescoping connector which is attached directly to the post is used as an

expedient to avoid reading directly on the plaintiff's patent. However, the second clamping member is bolted to the first clamping member pulling them together. Without this, of course, there could be no tightening or loosening of the clamping members so as to engage the doveshaped base portion of the rail.

There was much argument as to the base portion of the defendants' structure. This court concludes that merely because the sides of the base portion are lower, this does not prevent one from seeing the base portion as it should be seen. Infringement should not be that easily avoided.

Alterations in form, visually or with mechanical equivalents, do not avoid infringement. Here the two structures do the same work in substantially the same way and accomplish the same result, therefore, the two are the same. Entron of Maryland, Inc. v. Jerrold Electronics Corp., supra.

Accordingly, it is concluded that Patent No. 2,905,445 is infringed by the defendants.

CONCLUSIONS OF LAW

(1) The court has jurisdiction of the parties and the subject matter involved.

(2) The Blum design patent No. D-171,963 is valid.

(3) The defendants have jointly and severally infringed the Blum Design Patent No. D-171,963 by making, using and selling railings installed at the C & S National Bank, Greenville, S. C.

(4) The Blum Mechanical Patent No. 2,905,445 is valid.

(5) The defendants have jointly and severally infringed Patent No. 2, 905,445 by making, using and selling

the ornamental railings installed at the Citizens and Southern National Bank, Greenville, S. C.

Plaintiff is entitled to judgment enjoining defendants, its officers, servants, agents, and those in privity with it from any further infringement of the patents at suit, and to an accounting to determine the amount of damages to which the plaintiff is entitled as a result of the infringements.

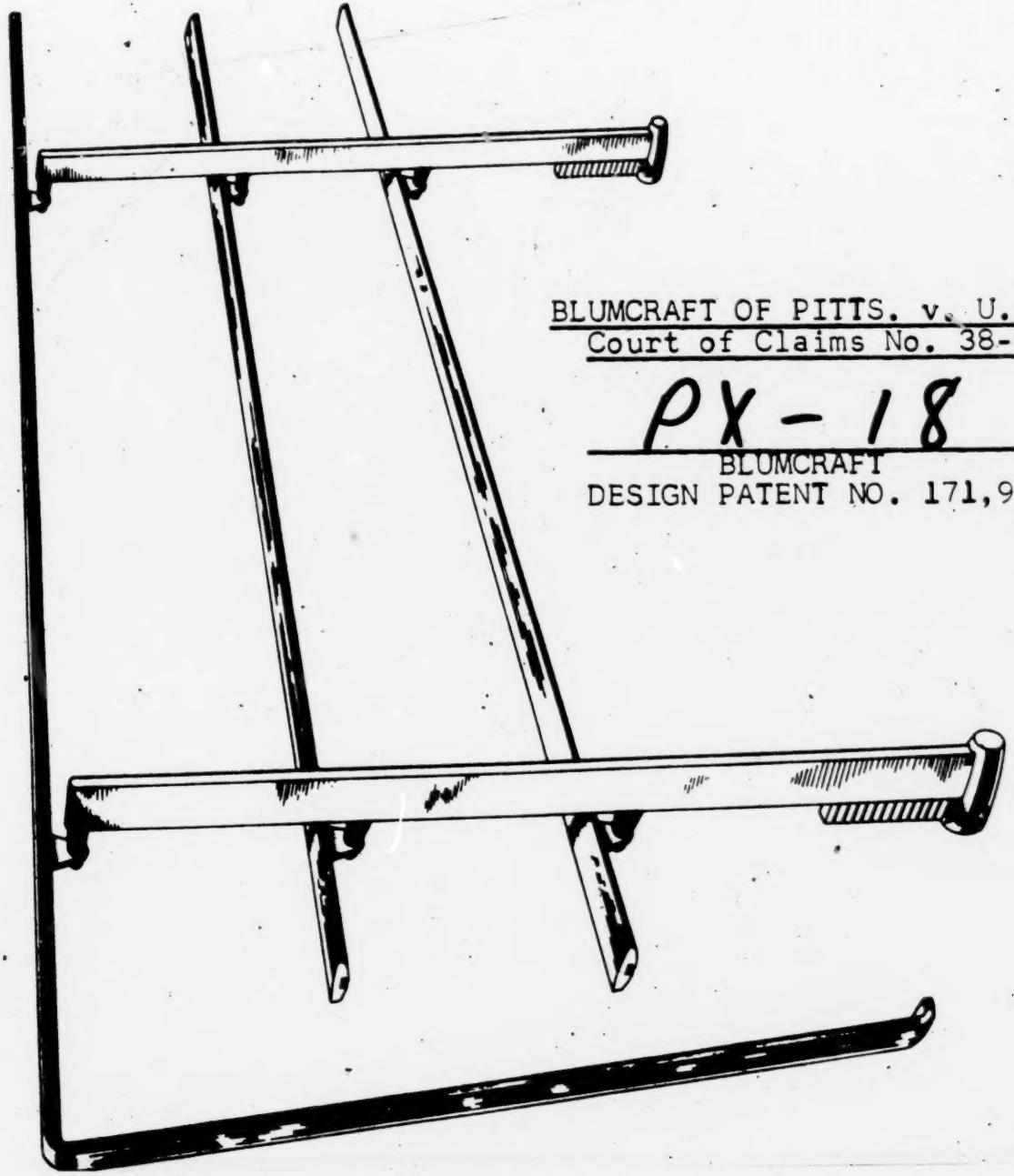
And it is so ordered.

SCHEDULE "A"

April 20, 1954 L. BLUM Des. 171,963

RAIL

Filed April 24, 1953



BLUMCRAFT OF PITTS. v. U. S.
Court of Claims No. 38-63

PX - 18

BLUMCRAFT
DESIGN PATENT NO. 171,963

Patented Apr. 20, 1954 Des. 171,963

UNITED STATES PATENT OFFICE

171,963

RAIL

Louis Blum, Pittsburgh, Pa.

Application April 24, 1953, Serial No. 24,670

Term of patent 14 years

(Cl. D28—1)

To all whom it may concern:

Be it known that I, Louis Blum, a citizen of the United States, residing at Pittsburgh, county of Allegheny and State of Pennsylvania, have invented a new, original, and ornamental Design for Rails, of which the following is a specification, reference being had to the accompanying drawing, forming a part hereof, in which:

The single figure is a view in perspective of a rail, showing my new design.

I claim:

The ornamental design for a rail, as shown.

References Cited in the file of this patent

Sweet's File, Architectural, 1952, section 6e, sub-section RE, page 14; section 6e, sub-section HA, page 7, and section 6e, sub-section BL, page 3, top left and right items.

SCHEDULE "B"

Sept. 22, 1959 L. BLUM 2,905,445

ORNAMENTAL RAIL STRUCTURES

Filed June 16, 1955

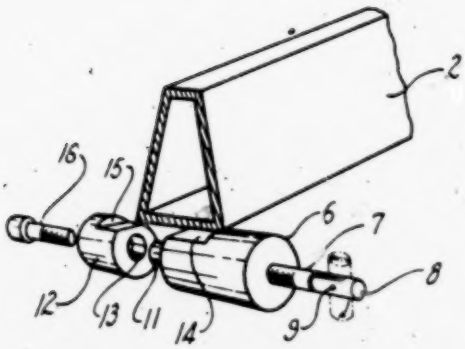


Fig. 2

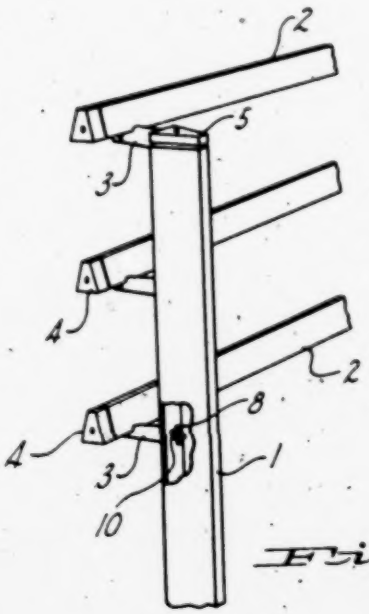
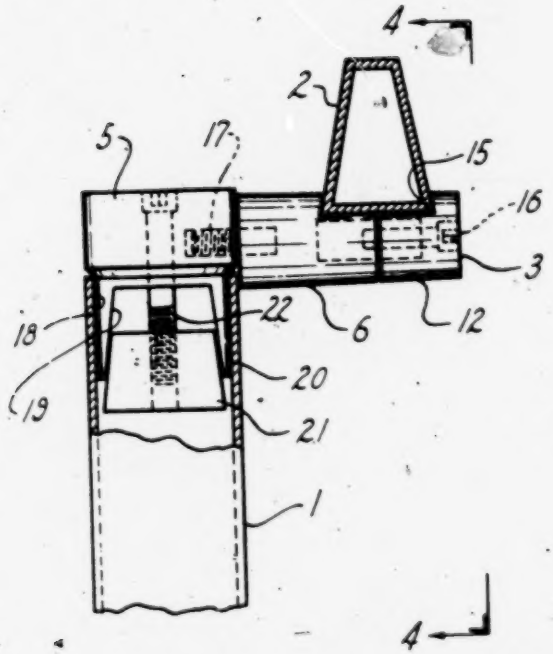


Fig. 1



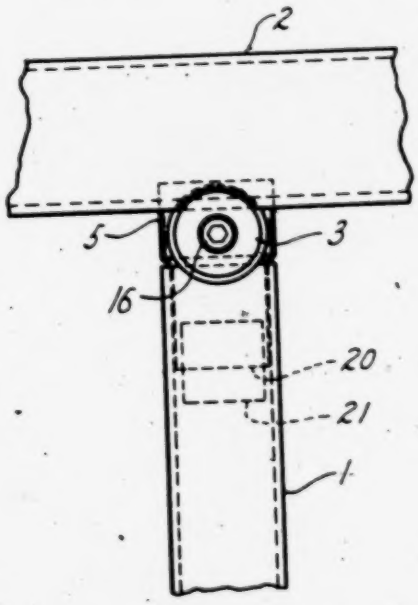


Fig. 4

UNITED STATES PATENT OFFICE

CERTIFICATE OF CORRECTION

Patent No. 2,905,445 September 22, 1959

Louis Blum

It is hereby certified that error appears in the above numbered patent requiring correction and that the said Letters Patent should read as corrected below.

Column 2, line 64, strike out "and", first occurrence; column 3, line 27, for "second" read -- first --; line 28, for "first" read -- second --; column 4, line 37, for "Hauhenstein" read -- Hauenstein --.

Signed and sealed this 3rd day of April 1962.

(SEAL)
Attest:

ERNEST W. SWIDER
Attesting Officer

DAVID L. LADD
Commissioner of Patents

United States Patent Office 2,905,445
Patented Sept. 22, 1959

2,905,445

ORNAMENTAL RAIL STRUCTURES

Louis Blum, Pittsburgh, Pa., assignor to Blumcraft of Pittsburgh, Pittsburgh, Pa., a firm

Application June 16, 1955, Serial No. 515,902

6 Claims. (Cl. 256—65)

This invention relates to new and useful improvements in ornamental rail structures, more particularly to means for mounting and fastening ornamental rails to wall brackets or supporting posts, and it is among the objects thereof to provide special clamping means for securing ornamental shaped rails at the under face thereof without engaging or obstructing the top and side faces of the rail to interfere with the gripping thereof.

It is a further object of the invention to provide special means for anchoring the rail clamping members to a hollow rail support.

It is still a further object of the invention to provide end caps for the ends of the rails and the top of the posts, which shall be secured therein by a wedging member, and which shall also be serviceable as a clamp anchoring means. These and other objects of the invention will become more apparent from a consideration of the accompanying drawing constituting a part hereof, in which like reference characters designate like parts and in which:

Fig. 1 is an isometric view in elevation, partially in section, of a fragmentary portion of ornamental hand rails and supporting posts;

Fig. 2, an exploded view of a portion of an ornamental rail and clamp therefor;

Fig. 3, an end elevational view, partially in cross-section, of an ornamental rail clamp post and clamp supporting bracket; and,

Fig. 4 is a side elevational view taken along the line 4—4 of Fig. 3.

In the drawing, the numeral 1 designates a dovetail shape rail supporting posts of hollow construction extruded of aluminum or the like; the numeral 2, an ornamental rail of similar shape supported on the post 1 by clamps 3. The rails 2 are of hollow construction and are provided with end caps 4, which are secured inside of the rail 2 by a wedging action, as will be hereinafter explained. The rail supporting post 1 is also provided with an end cap 5 of similar construction as the end caps 4, to which the clamping element 3 of the upper rail is secured, as shown in Fig. 3. With reference to Fig. 2 of the drawing, the dovetail shape hollow rails 2 are engaged by clamps generally designated by the numeral 3, which consists of a cylindrical member 6 having a threaded interior for receiving a stud 7 having a swivel end 8 pivotally mounted at 9, so that when inserted in an opening 10 of the rail supporting post 1, the swivel member 8 will assume the upright position, as shown in Fig. 1, and as shown in dotted lines in Fig. 2. By turning the barrel, or cylindrical member 6, on the threaded portion of the stud 7, it can be drawn up tight to cause the swivel end 8 of the stud 7 to abut the wall of the rail supporting post 1 to securely hold the barrel 6 thereon. The member 6 is provided with a reduced portion 11, which acts as a pilot or guide for a clamping cylinder 12, that has a cylindrical recess 13 for sliding engagement with the pilot element 11. Both the members 6 and 12 are provided with flat seating surfaces 14, with V-shaped notches 15, as is more clearly shown in Fig. 3 of the

drawing, so that when assembled, as shown in Fig. 3, they constitute a dovetail recess for receiving the base of the ornamental rail 2. A screw 16 passes through the end of the member 12 and into a threaded portion of the reduced pilot 11 of cylinder 6, and when the screw 16 is drawn up, it will force the cylindrical clamping element 12 to slide on the pilot element 11 to effect clamping engagement with the notched portion of cylinder 6 to firmly engage the rail element 2 and secure it in place.

The type of mounting and clamping element of Fig. 2 is utilized on the bottom and intermediate rails of Fig. 1 and the top rail, while it employs the clamping element of Fig. 2, utilizes a stud bolt 17 for mounting the cylindrical member 6 on the end closure 5 of the supporting post 1. This end closure 5, as shown in Fig. 1, is of dovetail shape and has a reduced portion 18 that fits in the inner wall of the supporting post 1 having sliding engagement therewith. The member 5 is recessed at 19 to form prongs 20, and a plunger of dovetail shape 21 is disposed in the recess 19 where it may be drawn upward by means of a bolt 22. As the bolt is turned, the plunger 21, which is also of dovetail shape, will be drawn upward and spread the prongs 20 to effect clamping engagement with the rail post 1 that is serving the two-fold purpose of a clamp support for the clamp 6 and a closure for the top of the post 1.

The end closures 4 with the hollow rails 2, are of the same construction as the closure 5 on the post 1, to effect clamping engagement with the inner wall of the rails 2 to firmly secure the end closures in place.

It is evident from the foregoing description of this invention that ornamental rail clamps and closures made in accordance therewith, provide a simple expedient assembly and efficient support without interference with the free use of the railing and greatly enhance the ornamental effect where dovetail shape designs and extrusions are employed. It is evident that such railings may be assembled at the place of use with no tools required except a drill for drilling the openings 10 in the post for receiving the studs 7.

Although one embodiment of the invention has been herein illustrated and described, it will be evident to those skilled in the art that various modifications may be made in the details of construction without departing from the principles herein set forth.

I claim:

1. In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, separate V-shape clamping means in juxtaposition forming a dovetail shape recess receiving and clamping the dovetail shape base portion of said rail means and exposing the upper portion of said rail means for hand-gripping, connecting means rigidly connecting said clamping means and said rail means in spaced relation to said post means and threaded bolt means passing through said clamping means forcing and retaining said clamping means together.

2. In an ornamental rail structure, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, clamping means supporting said rail means comprising a pair of separate clamping members having substantially V-shape portions joined to form a complementary dovetail shape and recess receiving and clamping the said dovetail shape base portion of said rail means with the upper portion of the rail means exposed for hand-gripping and holding means holding said separate clamping members together and rigidly clamping said rail means comprising internally threaded means on one side of said clamping means and a threaded bolt disposed within said clamping means and in threaded engagement with said internally threaded means.

3. In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, means connecting said rail means in spaced angular relation to said post means comprising a pair of separate clamping members, the first of said clamping members being rigidly affixed to said post means and extending outwardly therefrom, the second of said clamping members being connected to said first clamping member by threaded bolt means, said clamping members having complementary V-shape portions forming a dovetail recess receiving the dovetail shape portion of said rail means and exposing the upper portion of said rail means for hand-gripping.

4. In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, means for supporting said rail means on said post means comprising a pair of separate clamping members having notches joined to form a dovetail shape recess for receiving the dovetail shape base portion of said rail means with the upper portion thereof exposed for hand-gripping, the first of said clamping members having a recess, the second of said clamping members having means for attachment with said post means and having an interiorly threaded extension for sliding movement in the recess in the first said clamping member, and a bolt extending through said second clamping member into the interiorly threaded extension of said first clamping member for drawing said clamping members into clamping engagement with said rail.

5. In an ornamental rail structure, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, clamping means supporting said rail means comprising a pair of separate clamping members, each of said clamping members comprising V-shaped notch means and having an internal bore for receiving a threaded bolt, said V-shape notch means forming a dovetail shape recess receiving the dovetail shape

base portion of said rail means and exposing the upper portion of said rail means for hand-gripping, the internal bore of one of said clamping members being threaded for threaded engagement with a bolt and bolt means disposed within said internal bores and threadably engaging the threaded internal bore of one of said clamping members.

6. In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, means supporting said rail means on said post means comprising a pair of separate clamping members joined to form a dovetail shape recess receiving said dovetail shape base portion with the upper portion of said rail means exposed for hand-gripping, a first bolt with a swivel at one end and threaded at the other end, the first of said clamping members having a threaded end receiving the threaded end of said first bolt, said post means having an opening for receiving the swivel end of said first bolt, the said swivel constituting an abutment within said post for retaining said first clamping member in rigid engagement with said post means, said first clamping member having an interiorly threaded extension at the end thereof opposite said threaded end, the second of said clamping members having a recess for receiving said extension and a second bolt extending through said second clamping member into the threaded extension of said first clamping member for drawing said members into clamping engagement with said rail means.

References Cited in the file of this patent

UNITED STATES PATENTS

450,127	Wrigley	April 7, 1891
876,059	Irons	Jan. 7, 1908
1,631,831	Jones	June 7, 1927
1,795,857	Hauhenstein	March 10, 1931
2,229,194	Sklarek	Jan. 21, 1941

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF SOUTH CAROLINA.
CIVIL ACTION FILE NO. 4168.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP, CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

Plaintiff,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC., AND COLONIAL IRON WORKS, INC.,

Defendants.

JUDGMENT.

This action came on for trial before the Court, Honorable Charles E. Simons, Jr., United States District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered,

It is Ordered and Adjudged that Blum design patent No. D-171,963 and Blum Mechanical Patent No. 2,905,445 are valid and have been infringed by the defendants. Judgment is entered for the plaintiff, Blumcraft of Pittsburgh, a Partnership consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum, enjoining defendants from any further infringement of the patents at suit, and to an accounting to determine the amount of damages to which the plaintiff is entitled as a result of the infringements.

Dated at Columbia, S. C., this 3rd day of June, 1968.

Form approved.
Enter judgment forthwith:
CHARLES E. SIMONS, JR.,
U. S. District Judge.

MILLER C. FOSTER, JR.,
Clerk of Court.
BY FRANCIS METTS,
Deputy Clerk.

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 12719

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM, AND HARRY P. BLUM,

Appellee,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC., AND COLONIAL IRON WORKS, INC.,

Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF SOUTH CAROLINA, AT GREENVILLE. CHARLES E. SIMONS, JR., DISTRICT JUDGE.

(Argued December 2, 1968 Decided February 19, 1969).

Before SOBELOFF, WINTER, and BUTZNER, *Circuit Judges.*

WARREN N. WILLIAMS (GORDON D. SCHMIDT and DONALD L. FERGUSON on brief) for Appellants; and JAMES C. MCCONNON (HENRY N. PAUL, JR., and PAUL & PAUL; RALPH BAILEY, JR., and BAILEY & DORITY on brief) for Appellee.

BUTZNER, *Circuit Judge:*

This appeal is taken from the district court's ruling that two patents, D-171,963 for design and 2,905,445 for a mechanical device, owned by Blumcraft of Pittsburgh were valid and infringed by railings produced by Architectural Art Manufacturing Co.[1] We hold that both patents are invalid under 35 U. S. C. § 103.

I.

Blumcraft's design patent, D-171,963, was granted April 20, 1954 to Louis Blum for a railing styled for use in buildings of contemporary architecture. His application contained a single claim for the design "as shown" in a drawing. The railing consists of multiple parallel rails offset from vertical posts. The handrails are generally flat with slightly curved gripping surfaces. The posts are rectangular. Inconspicuous L-shaped brackets attach the undersides of the rails to the posts, leaving the gripping surfaces of the rails unobstructed. The multiple, offset, and parallel handrails set up a horizontal plane in opposition to the vertical plane formed by the parallel posts. The result, with the connections between the two planes minimized, is the visual illusion that the handrails are floating free.

The law authorizes the grant of a patent to "[w]hoever invents any new, original and ornamental design for an article of manufacture . . . ." 35 U. S. C. § 171. Architectural Art urges that the design patent is invalid under 35 U. S. C. §§ 102 and 103 because it was anticipated by the prior art and its subject matter was obvious to a person having ordinary skill in the art of creating ornamental rail-

1. *Blumcraft v. Citizens & So. Nat'l Bank*, 286 F. Supp. 448 (D. S. C. 1968). The patents are reproduced in the appendix. *Blumcraft v. Citizens & So. Nat'l Bank*, 255 F. Supp. 441 (D. S. C. 1966) (ruling on venue).

ing. The Court of Claims recently found Blum's design patent valid. *Blumcraft v. United States,* 372 F. 2d 1014 (Ct. Cl. 1967). We agree with it and with the district court that Blum's design was novel because the prior art did not disclose multiple rails offset from posts by inconspicuous connectors presenting the illusion of the rails floating in space. But a design must be more than novel. As Judge Soper wrote in *Glen Raven Knitting Mills v. Sanson Hosiery Mills,* 189 F. 2d 845, 851 (4th Cir. 1951):

> "[T]here must be an exercise of the inventive faculty, and if the design lacks this quality, it will not suffice to say that it is new, original and ornamental, and has received wide public acceptance."

Title 35 U. S. C. § 103[2] denies patentability to a novel design if the differences between the design and the prior art are such that the design would have been obvious to a person skilled in the art of designing ornamental railings. The test for obviousness, which must be applied as critically to designs as to other inventions, is: "the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *Graham v. John Deere Co.,* 383 U. S. 1, 17 (1966).

Multiple parallel rails offset from their supporting posts were known to the prior art. Two examples are Hollaender's stair rail, 1949, and Wallach's Jamaica store,

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2. Title 35 U. S. C. § 103 provides:
"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ."

1950. However, neither of these designs, nor the many examples of multiple rails that intersect their posts, gave the floating effect which the district court found in Blum's patent. Prior art also discloses that architects who custom designed railings, not Blum, first appreciated and met the requirements of contemporary architecture for modern railing design. In a church built in the early 1940's, Eliel and Eero Saarinen achieved a floating effect with a single rail offset from balusters by inconspicuous brackets. The rail follows the stairwell from flight to flight with unbroken lines. A similar illusion was obtained in a sanatorium built in the mid-1930's. Photographs of the Kansas City Auditorium, published in 1937, and of a W. T. Grant store, published in 1940, disclose relatively flat, single handrails offset from posts and walls by subdued brackets. A Chicago savings and loan office contains a railing installed in 1952 that follows and reinforces the lines of a curved staircase. The architect accentuated the separation between the horizontal and vertical lines of the railing by offsetting the top rail with brackets.

The differences between the prior art and Blum's design are minor. His predecessors offset multiple rails with prominent connectors and single rails by inconspicuous connectors. Blum merely offset multiple rails by inconspicuous connectors to achieve with several rails the floating effect that had previously been imparted to a single rail. It is apparent from the sophistication of the prior art that designers of ornamental railings, including manufacturers and architects, were highly skilled. Therefore, the fact, which the district court emphasized, that prior art would have to be redesigned to achieve Blum's railing is not decisive. The joining of known components usually requires skill, but this does not necessarily negate obviousness. Cf. *Smith v. Whitman Saddle Co.*, 148 U. S. 674 (1893).

Graham v. John Deere Co., 383 U. S. 1, 17 (1966), also directs inquiry into secondary indicia of obviousness or nonobviousness, including commercial success and long-felt but unsolved needs. Blumcraft's commercial success lay in the fact that it was the first to offer a railing of acceptable modern design as a prefabricated product. Both Blum and an architect testifying in his behalf stressed this point, and Blumcraft's advertising emphasized the utilitarian advantages of its railing.[3] However, commercial success that results from the prefabrication of a known architectural style, and not creative artistry, fails to support patentability. Cf. *Battery Patents Corp. v. Chicago Cycle Supply Co.*, 111 F. 2d 861 (7th Cir. 1940); *R-Way Furniture Co. v. Duo-Bed Corp.*, 216 F. Supp. 862 (N. D. Ill. 1962).

To prove long-felt, unsolved need, Blumcraft says, "The need for a commercially available railing system compatible with modern architecture had existed for some time prior to the Blum invention." This observation illustrates both Blum's success and the invalidity of his patent. There was no unsolved need for attractive modern railings. Architects were capable of supplying them through custom design. There was a need, however, for a prefabricated railing system embodying modern design.

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3. In 1953 Blumcraft advertised:

"*Blumcraft* presents a new approach in railings,—interchangeable components that afford the Architect greater flexibility in design, reduce to a minimum the hazards of errors in measurements, templates and shop fabrication, and permit ease of installation in the field by ordinary mechanics without special tools. Simple field adjustment for height, pitch and spacing is provided .....and because *budget* is always a limiting factor in railing design, the reduced costs in fabricating and erection will be particularly appealing to the Architect.

* * *

"Complete railings or component parts available to metal fabricators."

Blum met this need by adapting known custom designs to a prefabricated railing system. Blum's product enabled architects to specify the number and location of posts and the number and spacing of rails to create designs compatible with the architecture of many modern buildings. Blum's contribution to the art was not his design; this was obvious. It was his railing system which was unique. But Blum's railing system is not the proper subject of a design patent. The statutory grant of a design patent is for appearance [4] and not for a method of manufacture or assemblage,[5] function, or utility.[6]

II.

Blum's mechanical patent 2,905,445, was issued September 22, 1959 upon an application filed June 16, 1955. The two claims in suit are Nos. 1 and 3.[7] The patent, as

4. 35 U. S. C. § 171; *Gorham Mfg. Co. v. White*, 81 U. S. 511, 525 (1872); *Deller's Walker on Patents*, § 158 (2d ed. 1964).

5. *Harmon Paper Co. v. Prager*, 287 F. 841, 843 (2d Cir. 1923); *Harmon Paper Co. v. Kimberly Clark Co.*, 289 F. 501, 508 (E. D. Wis. 1922).

6. *Connecticut Paper Products v. New York Paper Co.*, 127 F. 2d 423, 429 (4th Cir. 1942).

7. Claim 1: "In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, separate V-shape clamping means in juxtaposition forming a dovetail shape recess receiving and clamping the dovetail shape base portion of said rail means and exposing the upper portion of said rail means for hand-gripping, connecting means rigidly connecting said clamping means and said rail means in spaced relation to said post means and threaded bolt means passing through said clamping means forcing and retaining said clamping means together."

Claim 3: "In an ornamental rail structure, ornamental post means, ornamental rail means having a dovetail shape base portion and an upper hand-gripping portion, means connecting said rail means in space

described by the district judge, "is characterized by a clamping connector for connecting an ornamental handrail in spaced relation to an ornamental post, comprising separate v-shaped clamping means which receive and clamp the dovetail-shaped base portion of the handrail." The controversy involves the device that holds the rail offset from the posts. It is depicted in Blum's application as a cylinder attached perpendicularly to the post by a bolt. Attached to the end of that cylinder by another bolt is a second cylinder of the same diameter. Screwed together, the cylinders grip, in a mouth formed by v-shaped notches, the dovetail base of a handrail. As Blum explained, the connector gripped the handrail like a vise.

The prima-facie presumption of a patent's validity [35 U. S. C. § 282] can be given little weight. The Patent Office cited none of the ornamental railings found in the prior art. Cf. *Heyl & Patterson, Inc. v. McDowell Co.*, 317 F. 2d 719, 722 (4th Cir. 1963). It referred, instead, to a device like a toggle bolt for fastening fixtures to a wall, to a split glass or porcelain knob for stringing electrical transmission wires, to a bracket for attaching a lamp to a typewriter, to an anti-theft bracket for attaching a fog light to an automobile bumper, and, finally, to a device for clamping scaffolding which does not need an unobstructed handrail.

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7. (continued)

> angular relation to said post means comprising a pair of separate clamping members, the first of said clamping members being rigidly affixed to said post means and extending outwardly therefrom, the second of said clamping members being connected to said first clamping member by threaded bolt means, said clamping members having complementary V-shape portions forming a dovetail recess receiving the dovetail shape portion of said rail means and exposing the upper portion of said rail means for hand-gripping."

By 1954, the use of posts and handrails was ancient. And placing the rail in "spaced relation" to the post was well-known. Indeed, these elements were found in Blum's design patent, which is prior art. In addition, the unpatented device Blum originally used in railings manufactured from his design patent disclosed the flexibility plus rigidity that the district court found unique to Blum's later mechanism. Absent from Blumcraft's original device was the use of clamps with v-shaped notches to secure dovetailed rails, but a dovetail grip had been widely used. It appeared, for example, in Hardy's patent 163,996, issued in 1875. Hardy used a clamp drawn together by screws to hold a handrail above the top of a post. The clamp's grip resembled that formed by a man's thumb and index finger. It engaged the dovetail base of the rail the way Blum's does. The chief difference between the devices lies in the way the clamp is fixed to the post: Hardy's clamp gripped the top of the post as well as the rail; Blum attached one cylinder of his clamp to the side of the post by a bolt. We believe, however, contrary to the district judge, that this difference is insubstantial. It was within the skill of an ordinary mechanic to attach a vise-like clamp to a post in any number of positions by any number of means. Nor is it significant that the surface of Hardy's clamps form the lower part of his handrail. They need not function exclusively as clamps to make their dovetail grip apparent. The prior art of ornamental railings is sufficient to establish the obviousness of Blum's patent.

Moreover, devices similar to Blum's have long been used to secure railroad rails. The best example is McNeil's 1915 patent, 1,165,195, which used a two-part clamp drawn together by bolts to grip the base of the rail in a shaped recess and anchor it to straps or bars. The fact that McNeil's mechanism was designed to hold railroad rails and not handrails does not make his patent irrelevant. Both

his mechanism and Blum's perform the same function: they stabilize a rail without interfering with the use of its upper surface. Because both are simple devices employing the same universally known principles of mechanics, McNeil's patent is pertinent prior art and supports our conclusion that Blum's device was obvious. *Mast, Foos, & Co. v. Stover Mfg. Co.*, 177 U. S. 485, 493 (1900); *Knapp v. Morrss*, 150 U. S. 221, 226 (1893); *Skee-Trainer, Inc. v. Garelick Mfg. Co.*, 361 F. 2d 895, 898 (8th Cir. 1966).

The judgment of the district court is reversed, and this case is remaded for entry of final judgment in favor of the defendants.

JUDGMENT.

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT.

No. 12719.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP, CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM, *Appellee,*

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC., AND COLONIAL IRON WORKS, INC., *Appellants.*

Appeal from the United States District Court for the District of South Carolina.

This cause came on to be heard on the record from the United States District Court for the District of South Carolina, and was argued by counsel.

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court appealed from, in this cause, be, and the same is hereby, reversed with costs; that the cause is remanded South Carolina at Greenville, for entry of final judgment in favor of the defendants, consistent with the opinion of the Court filed herein.

FILED
FEB. 19, 1969
SAMUEL W. PHILLIPS
Clerk

SAMUEL W. PHILLIPS,
Clerk.

UNITED STATES COURT OF CLAIMS.

No. 38-63.

Feb. 17, 1967.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP, CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

v.

UNITED STATES COURT OF CLAIMS.

Action for patent infringement. The Court of Appeals held that design patent D-171,963 was valid and infringed.

Judgment for plaintiff.

James C. McConnon, Philadelphia, Pa., for plaintiff; Henry N. Paul, Jr., Philadelphia, Pa., Robert U. Geib, Jr., Washington, D. C., and Paul & Paul, Philadelphia, Pa., of counsel.

Michael T. Platt, Washington, D. C., with whom was Asst. Atty. Gen. Barefoot Sanders, for defendant.

Before COWEN, Chief Judge, and LARAMORE, DURFEE, DAVIS, COLLINS, SKELTON and NICHOLS, Judges.

OPINION

PER CURIAM:

This case was referred to Trial Commissioner Donald E. Lane, with directions to make findings of fact and recommendation for conclusions of law. The commissioner has done so in an opinion and report filed on September 22, 1966. The case is before the court on plaintiff's motion for judgment on the issue of liability, filed November 14, 1966, wherein plaintiff moves that the court adopt the commis-

sioner's report per curiam as the opinion and findings of the court and that judgment be entered on the issue of liability on the basis of the petition as amended,* and that the case be referred to the commissioner for an accounting to determine the amount of compensation to which plaintiff is entitled. Defendant has filed no opposition or response to plaintiff's motion for judgment on the issue of liability and the time for so filing pursuant to the rules of the court has expired. Since the court agrees with the trial commissioner's findings, opinion and recommendation for conclusions of law, as hereinafter set forth, it hereby adopts the same as the basis for its judgment in this case without oral argument. Therefore, the court concludes that design patent D-171,963 is valid and has been infringed and that plaintiff is entitled to recover on the petition as amended for the unauthorized use by defendant of the invention defined in said design patent. Plaintiff's motion for judgment on the issue of liability is allowed and judgment is entered for plaintiff with the amount of recovery to be determined pursuant to Rule 47(c) (2).

OPINION OF COMMISSIONER**

LANE, Commissioner:

This is a patent suit under Title 28 U. S. C. § 1498, in which plaintiff seeks to recover reasonable and entire compensation for the unauthorized use of a patented invention. Plaintiff, a partnership having its place of business in Pittsburgh, Pennsylvania, is the owner of United States Design Letters Patent No. D-171,963, entitled "Rail," and which was issued on April 20, 1954, for a term of 14 years.

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* Plaintiff's second amendment to the petition on which defendant had entered its consent was filed November 2, 1966.

** The opinion, findings of fact, and recommended conclusion of law are submitted under the order of reference and Rule 57(a).

The patent is hereinafter referred to as the design patent. It is found that the design patent is valid and that it has been infringed by defendant. The issues now before the court are the issues of design patent infringement and design patent validity. Defendant contends that the design patent must be limited in scope to the railing design illustrated, i.e., that no element illustrated may be eliminated, and contends that the design patent is invalid under Title 35 U. S. C. § 103 as being an *obvious* design in view of the state of the art prior to the summer of 1952. The application for the design patent was filed April 24, 1953.

The design patent claim reads: "The ornamental design for a rail, as shown." Only one claim is required in a design patent. The above claim is written as required by the United States Patent Office. In determining whether or not a design patent is infringed it is necessary to examine the illustrative drawing rather than detailed claim language. The test for design patent infringement is substantial identity of appearance. The true test of identity of design is the sameness of appearance, and the mere difference of lines in the drawing, a greater or smaller number of lines, or slight variances in configuration will not destroy substantial identity. Gorham Mfg. Company v. White, 81 U. S. (14 Wall.) 511, 526, 20 L. Ed. 731 (1871). The test of sameness of effect on the eye means the eye of an ordinary observer rather than the eye of an expert in the subject matter. If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an ordinary purchaser, inducing him to purchase one supposing it to be the other, the design patented is infringed by the other. *Gorham,* supra, 528.

The distinguishing features of the rail design shown in the design patent are set out in finding 6. Stated more

briefly, the patented rail design creates an illusion of a plurality of hand rails floating in space away from the supporting posts. The aesthetic effect is pleasing. The testimony of witnesses for both parties supports the conclusion that the overall effect of the designs of the several accused installations is like the overall effect of the design taught by the design patent. There are minor differences in some installations in the number of hand rails, the end of the rails, and the ornamentation of the supporting posts, but the overall effect is one of substantial identity. The differences are discoverable only by close scrutiny.

The observer test for determining infringement of design patents has been followed many times since its announcement years ago in the *Gorham* case. The test was applied in the case of a design for a table top in 1960. E. H. Sheldon & Co. v. Miller Office Supply Co., Inc., 188 F. Supp. 67, (DC-Ohio, 1960). The issue of infringement of a design patent presents a question of fact for the trier of the facts to determine. The evidence in this case supports a finding that defendant's hand rail installations identified in finding 9 produce the same floating in space effect away from the supporting posts as the design illustrated in plaintiff's design patent. The designs have the same pleasing aesthetic effect on a normal observer.

Defendant contends that the design patent is invalid in view of Title 35 U. S. C. § 103 which provides that a patent may not be obtained though the invention is not identically disclosed or described in a printed publication or in public use, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Defendant has relied upon 15 prior publications and 1 prior use, and urges that it would have been obvious to

select one or more features from each of several of the citations to come up with the design taught by the design patent. It is clear that many new designs might be created by this approach of picking a feature here and another feature there. However, it is equally clear that every such possible combination would not have the pleasing aesthetic effect, appeal of beauty, and compatability with modern architecture achieved by the design taught by plaintiff's design patent. Invention lies in the combination of certain features to create a desirable effect.

Defendant's witness stated that the railing shown in Architectural Record, 1940, page 68, defendant's exhibit 2, produced the *closest* visual effect of the several prior art items relied upon by defendant to anticipate the design patent. The witness stated further that to obtain the same visual effect as the patented design it would be necessary to modify the Architectural Record railing by changes in rail section, changes in the post direction, and changes in the decorative features, and that one would really have to reconstruct said prior art railing to obtain the same visual effect. The Architectural Record railing illustration shows pipe rails and pipe posts but does not clearly show how the rails are secured to the post. The overall appearance of this prior art item is not one of having a plurality of rails arranged in the same vertical plane offset from the plane of the posts to produce an illusion of a plurality of hand rails floating in space away from the supporting posts.

A design must be judged from its appearance as a whole and to be patentable must possess beauty and originality. The mere fact that all the elements of a design may be individually old does not prevent a design from being patentable. Application of Johnson, 36 CCPA 1145, 175 F. 2d 789 (1949). That there is but a simple regrouping of old elements does not negative design invention,

for simplicity may be ingenious in reaching a new and pleasing ornamental design. It is in the combination of design features in which originality and aesthetic skill may be evidenced. Such originality is shown in the design taught by plaintiff's design patent. The importance of the appearance of the whole design was noted by Chief Judge Garrett in the following language in Application of Jennings, 182 F. 2d 207, 37 CCPA 1023 (1950):

> In considering patentability of a proposed design the appearance of the design must be viewed as a whole, as shown by the drawing, or drawings, and compared with something in existence—not with something that might be brought into existence by selecting individual features from prior art and combining them, particularly where combining them would require modification of every individual feature, as would be required here.

A design patent covers a design as a whole, and not any part of it as a part. A design patent is to be tested as a whole in considering novelty and infringement. Dobson v. Dornan, 118 U. S. 10, 15, 6 S. Ct. 946, 30 L. Ed. 63 (1886).

Obviousness or nonobviousness is determined by consideration of the scope and the content of the prior art, the differences between the prior art and the design claimed, and the level of ordinary skill in the pertinent art. Secondary consideration may be given to commercial success, long felt but unsolved needs, and the failure of others to provide a satisfactory solution. Graham v. John Deer Co. of Kansas City, et al., 383 U. S. 1, 17, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966). Plaintiff's design patent possesses novelty, utility, and nonobviousness, and passes the accepted tests for patentability.

In 1949 this court considered a design patent and relied on the test of infringement laid down by the Supreme Court

in the *Gorham* case, supra. The court found that certain secretary-bureau, safe locker, and dental cabinet designs used by the Department of the Navy did not have *sufficient identity of appearance* with a design patent for a combination bookcase and desk-cabinet to constitute infringement thereof. Dickey v. United States, 114 Ct. Cl. 439, 455, 84 F. Supp. 741, (1949), cert. denied, 338 U. S. 938, 70 S. Ct. 339, 94 L. Ed. 578 (1950). In 1955 this court considered a design patent on a plastic-covered wire staple removing device. The court found that patent invalid and stated that the only substantial difference between the prior art staple remover and the patented design was one of materials of manufacture and not of design. Ace Fastener Corporation v. United States and Paragon Plastic Corporation, 149 Ct. Cl. 555, 276 F. 2d 391. In the present case it is concluded that the accused rail installations do have sufficient identity of appearance with that of the plaintiff's design patent for a rail to constitute infringement, and it is concluded further that the design patent illustrates a pleasing design not taught by or obvious from the prior art and is valid thereover.

Summarizing, it is found that plaintiff's design patent is valid and has been infringed by defendant. Plaintiff is entitled to recover reasonable and entire compensation for such unauthorized use, the value of which should be determined by further proceedings pursuant to Rule 47(c).

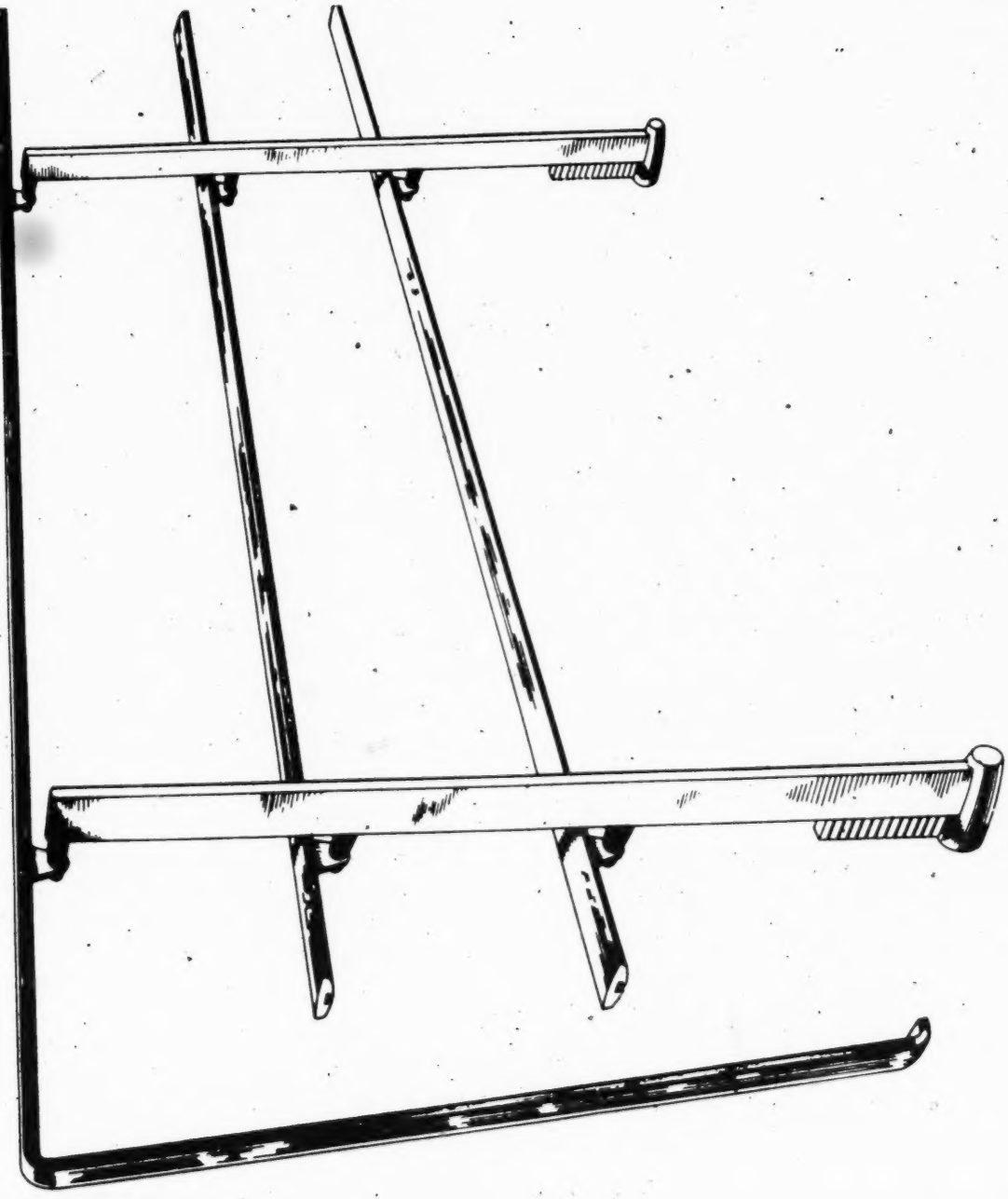
Findings of Fact

1. This is a patent suit brought under Title 28 U. S. C. § 1498 for the recovery of reasonable and entire compensation for unlicensed use or manufacture by or for the United States of the invention covered by design patent No. D-171,963 relating to an ornamental design for a railing. The petition was filed February 12, 1963, and was

amended and supplemented by a petition filed August 20, 1965.

2. The plaintiff, Blumcraft of Pittsburgh, is a partnership consisting of Hyman Blum, Max Blum, Louis Blum, and Harry P. Blum, all of whom are citizens of the United States and residents of Pittsburgh, Pennsylvania, said firm having its principal place of business at 460 Melwood Street, Pittsburgh, Pennsylvania 15213.

3. Design patent No. D-171,963 was issued to Louis Blum on April 20, 1954, for a term of 14 years, on an application filed April 24, 1953. The patentee assigned this patent to the plaintiff April 25, 1955, by an instrument recorded in the United States Patent Office. Plaintiff is the owner of the patent in suit. The patent drawing and specifications are reproduced herein. In the first action by the Patent Office Examiner, it was stated that the drawing appeared to disclose novelty. Following compliance with formal requirements, the application for patent was allowed without a rejection on prior art.



Term of patent 14 years
(Cl. D28—1)

To all whom it may concern:

Be it known that I, Louis Blum, a citizen of the United States, residing at Pittsburgh, county of Allegheny and State of Pennsylvania, have invented a new, original, and ornamental Design for Rails, of which the following is a specification, reference being had to the accompanying drawing, forming a part hereof, in which:

The single figure is a view in perspective of a rail, showing my new design.

I claim:

The ornamental design for a rail, as shown.

REFERENCES CITED IN THE FILE OF THIS PATENT

Sweet's File, Architectural, 1952, section 6*e*, sub-section RE, page 14; section 6*e*, sub-section HA, page 7, and section 6*e*, sub-section BL, page 3, top left and right items.

4. Louis Blum joined the Blumcraft firm in 1927. At that time its business was in the manufacture of ornamental and miscellaneous iron work. During the 1930's and 1940's Louis Blum was engaged in the capacity of a partner, in designing for the firm iron, bronze, and aluminum products such as railings, lanterns, lighting fixtures, and hand-forged hardware. In the summer of 1952 he conceived the railing design which is the subject of the patent in suit as a design to be used for a stairway railing in a private residence in substitution for a proposed railing that had been designed for said residence by an architect. A model embodying the Blum design was built and tested about July or August 1952. Shop drawings of the railing were made by Louis

Blum on September 18, 1952. The model was seen and approved by the residence owner in the Blumcraft offices. The aforesaid railing design created by Louis Blum came about some time after architecture in this country, especially that of monumental buildings, had changed considerably in the direction of the modern or contemporary style.

5. The modern or contemporary school of architecture began to receive recognition in the 1920's and became more substantially established in the 1930's. It has since become a mass movement throughout the world. Characteristic of the movement is the effort in the design of buildings to free certain planes and surfaces so as to give them the effect of floating in space, also the effort to achieve simplicity by the elimination of features which are irrelvant because lacking functional justification, and by the use of clean, continuous, uninterrupted lines. The design of railings was slow compared to other products in keeping up with modern design. By 1936 a definite need had arisen for a railing design both pleasing to the eye and having a simplicity compatible with the contemporary styling of buildings, particularly monumental buildings. There was also a need for a design made up of component parts which could be made available from stock and readily adapted by an architect to suit the exigencies of a particular building structure. Designers and fabricators of railings had failed to satisfy these needs, and it was therefore a common practice in 1952 for architects to make their own railing designs on a job-by-job basis. Thousands of railings were designed in an effort to produce something which was harmonious or compatible with the modern school of design for buildings.

6. The design illustrated in the patent in suit is characterized by hand rails which appear to have a clean sweep of continuous uninterrupted lines separate from the upright

supports. The hand rails are so arranged in relation to such upright supports as to present the effect of floating in space. The distinctive features of the design of the patent in suit comprise:

a. A plurality of spaced parallel posts generally rectangular in cross section and arranged so as to present a series of spaced parallel vertical surfaces;

b. A plurality of spaced parallel hand rails generally flat or rectangular in cross section and arranged in the same vertical plane so as to present a series of parallel horizontal surfaces;

c. Connecting brackets attaching the underside of each hand rail to the adjacent edge of each post, each bracket comprising a rod-like member extending at right angles to the post and a substantially flat triangular member extending upward from the rod-like member to the center of the underside of each rail leaving the rail unobstructed throughout the handgripping portion thereof;

d. The aforesaid elements so designed and arranged as to cause the hand rails to appear to float in space away from the posts.

7. Since the introduction of the railing design illustrated in the patent in suit, the business of plaintiff has increased greatly. The design has stood the test of time and continues to receive favor from architects and builders. The design has enjoyed commercial success.

8. The defendant has never had and does not now have any written authorization or license from plaintiff to use the invention of the design patent in suit.

9. Plaintiff has presented photographs of railing installations at certain of defendant's agencies as evidence of infringement of the patent in suit. These photographs are included herein by reference and comprise:

a. The railing in the entrance lobby of the 3.5 ft. hypersonic wind tunnel, National Aeronautics and Space Administration, Ames Research Center, Moffett Field, California. (Plaintiff's exhibits 39 ((b)-(1), incl.).)

b. The railing on stairway No. 1, Data Reduction Center, National Aeronautics and Space Administration, Ames Research Center, Moffett Field, California. (Plaintiff's exhibits 39 ((o)-(s), incl.).)

c. The railing on stairway No. 2, Data Reduction Center, National Aeronautics and Space Administration, Ames Research Center, Moffett Field, California. (Plaintiff's exhibits 39 ((t) and (u)).)

d. The railing of the front stairs of the new school building, Department of the Interior, Bureau of Indian Affairs, Stewart, Nevada. (Plaintiff's exhibits 39(w), (x), (y), (z), (aa).)

e. The railing on the side stairs of the new school building, Department of the Interior, Bureau of Indian Affairs, Stewart, Nevada. (Plaintiff's exhibits 39(bb) and (cc).)

f. The railings leading to the doorways of the building of the Department of the Interior, Forestry Service, at Mount Hebron, California. (Commissioner's exhibit 3.)

10. The design of the railing in the entrance lobby of defendant's NASA office building identified in item a. of

finding 9, and depicted in plaintiff's exhibits 39(b)-(l) and also shown in defendant's exhibits 25(A)-(F) and 28, *typifies* the subject matter charged to infringe plaintiff's patent here in suit. Said railing was manufactured and installed by or for the defendant at some date subsequent to December 2, 1958, and prior to the February 12, 1963, filing date of plaintiff's original petition.

11. Each of the distinctive features of plaintiff's patented design set forth in finding 6 above is present in each of the accused structures. Said accused structures produce in their overall effect upon the eye a clean, uninterrupted sweep of parallel railing surfaces giving the impression that the said surfaces float in space away from the supporting posts to which they are connected. In applying a railing of any specific design to a structure such as a stairway, platform, or balcony, it is to be expected that the railing must be adapted or conformed to meet the special conditions imposed by such structure. Necessarily the nature of the terminations, the character of the slopes and changes of direction of the hand rails, the number and spacing of the posts, and the manner of mounting the lower ends of the posts, are variable factors that are determined and controlled by the environmental conditions which are encountered. Such adaption or conformation of a railing to a particular structure need not destroy the identity or change the distinctive features of a railing design.

12. When viewed in the manner and at the distance at which railings are customarily observed, each of the several accused railing constructions is indistinguishable from the railing design disclosed in the plaintiff's patent in suit. When the railings are carefully scrutinized or placed side by side for element by element comparison, such differences as may appear reside in minute and inconsequential details

or result from the adaptation of the patented design to meet the conditions of a particular installation. No difference of substance has been shown and the overall impression upon the eye of the beholder is the same. The aesthetic effect is one of identity.

13. Defendant contends that the design patent in suit is invalid over the disclosures of the following 15 prior publications plus a railing installation in Chicago, Illinois. The defendant's exhibit number is indicated by DX.

a. Architectural Forum, March 1937, page 222, DX-1.

b. Architectural Record, August 1940, page 68, DX-2.

c. Architectural Forum, October 1942, page 43, DX-3.

d. New Pencil Points, January 1943, page 24, DX-4.

e. Architectural Forum, March 1950, page 100, DX-5.

f. Architectural Forum, July 1950, page 75, DX-6.

g. Sweet's Catalog Service of 1951, Arch. Sec. 6a/A, page 21, DX-7.

h. Progressive Architecture, November 1951, page 26, DX-8.

i. Sweet's Catalog Service of 1952, Arch. Sec. 6c, page 14, DX-9.

j. Architectural Detailing, Hornbostel & Bennett, Reinhold Publishing Co., 1952, page 165, DX-10.

k. Architectural Detailing, 1952, page 166, DX-11.

l. Architectural Detailing, 1952, page 158, DX-12.

m. Progressive Architecture, August 1950, page 97, DX-12A.

n. Architect's Working Details, Boyne, Architectural Press, Great Britain, 1953, page 60, DX-13.

o. Excerpts from Ornamental Metal Handbook,' 1945, DX-42a, 42B, and 42C.

14. Defendant contends that the design patent in suit is invalid over the design of a railing installed in April 1952 in the Home Federal Savings and Loan Building at 202 South State Street, Chicago, Illinois. This railing is shown in DX-24A-2, and comprises a single hand railing supported by heavy acute angle gooseneck-shaped brackets offsetting it from and above a series of framed and spaced glass panels. The overall appearance of the Savings and Loan railing is different from the appearance of the railing design illustrated in the patent in suit. The single Savings and Loan hand rail does not have the appearance of floating in space.

15. Defendant's expert stated that there is no railing shown in the cited prior art that would produce the same visual effect in all respects as that produced by the railing illustrated by the design patent in suit. He also testified that in his opinion the railing shown in Architectural Record, 1940, DX-2, produced the *closest* visual effect to that of the patented railing, and that to obtain the same visual effect it would be necessary to modify said prior art railing by changes in the rail section, in the post section, in the post direction, and in the decorative features, and that one would really have to reconstruct the entire prior art railing to produce the visual effect of the railing design of the patent in suit.

16. None of the other prior art railing disclosures presented by defendant produces a visual effect any closer to that of the patent in suit than DX-2 chosen by defendant's expert. DX-2 shows pipe rails and posts but the connecting means are not clearly apparent. Architectural

Forum, DX-1, shows a double railing supported by posts having relatively heavy U-shaped brackets at the post top. Architectural Forum, DX-3, shows a continuous hand rail supported by brackets from tubular posts which project above the rail. New Pencil Points, DX-4, shows a mesh screen railing supported by offset posts. Architectural Forum, DX-5, shows a stair railing having tubular rails and tubular posts in a single plane. Architectural Forum, DX-6, is similar to DX-5, but appears to include glass panels between tubular rails offset from tubular posts. Sweet's, DX-7, shows tubular hand railing supported by tubular posts in a single plane with a single stair post offset. Progressive Architecture, DX-8, shows a stair rail supported on the tops of rectangular cross section posts which also carry flat strip guard members. Sweet's, DX-9, shows a stair rail having three flat strips mounted on tubular posts without offset. Architectural Detailing, DX-10, shows a single hand rail carried by offset posts supporting glass panels. Architectural Detailing, DX-11, shows a box-like hand rail carried by offset square posts supporting frosted glass panels. Architectural Detailing, DX-12, and Progressive Architecture, DX-12A, show pipe stair rails similar to those shown in DX-2. Architect's Working Details, DX-13, shows the same pipe stair rails illustrated in DX-12. Excerpts from Ornamental Handbook, DX-42A, 42B, and 42C, show a variety of railing braces, center rails, and wall bracket fastenings, all unlike in appearance those illustrated in the design patent in suit.

17. None of the citations relied on by defendant as prior art embraces all of the distinctive features of the Blum patented invention as set forth in finding 6, nor do the prior art exhibits, including those pertaining to the railing installed in the Chicago building, whether considered individually or collectively, contain any teaching

or disclosure suggesting a design containing all of said distinctive features. A designer with skill in the railing art having before him the prior art citations relied on by defendant and the photographs of the prior use, would have to engage in substantial redesigning of the elements shown therein in order to achieve a design like that shown in the patent in suit in which the rails appear to float away from the vertical posts. None of the citations relied on by defendant as prior art, including the exhibits illustrating the prior use, produces the overall aesthetic effect upon the eye which is produced by the design illustrated in the patent in suit. None discloses rails having a clean sweep of uninterrupted lines separate from the upright posts, presenting the illusion of floating in space.

18. At the trial, the trial commissioner ordered that only the issues of patent infringement and patent validity would be considered and that any accounting issues should be deferred until entry of an order by the court on liability, and that in the event of an accounting both parties should have the right to present evidence upon patent marking and upon the right of plaintiff to recover compensation from the defendant by reason of the manufacture and use by or for the defendant of railings produced by Kawneer Corporation and/or Railcraft Corporation.

Conclusion of Law

Upon the foregonig findings of fact, which are made a part of the judgment herein, the court concludes as a matter of law that design patent D-171,963 is valid and has been infringed and that plaintiff is entitled to recover for the unauthorized use by defendant of the invention defined in said design patent. Judgment is entered to that effect. The amount of recovery will be determined pursuant to Rule 47(c)(2).

SUPREME COURT, U. S.

FILED

JUN 6 1969

JOHN F. DAVIS, CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1968.

No. 1355

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

vs.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

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Layne & Bowler Corporation v. *Western Well Works, Inc., et al.*, 261 U.S. 387 (1923) 13, 14

Lincoln Engineering Co. v. *Stewart-Warner Corp.*, 303 U.S. 545 (1937) 17

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N.L.R.B. v. *Pittsburgh S.C. Co.*, 340 U.S. 499 (1951) 14

Pavement Salvage Co., Inc. v. *Anderson's-Black Rock, Inc.*, 404 F.2d 450 (4th Cir. 1968) 17, 18

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CONSTITUTIONAL PROVISIONS AND STATUTES

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1968.

No. 1355

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

vs.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

I

OPINIONS BELOW

The opinion of the Court of Appeals for the Fourth Circuit, of which review is sought (now officially reported at 407 F.2d 557 (1969)) and the judgment of that Court is reprinted in the Appendix to the Petition.

The opinion of the United States Court of Claims (372 F.2d 1014 (1967)) relating to but one of the patents here in issue is also included in Petitioner's Appendix.

II

JURISDICTION

The jurisdictional requisites are adequately stated in the Petition.

III

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

This case involves Article I, Section 8, Clause 8, of the Constitution, and Sections 103 and 171 of the Patent Code, 35 U.S.C. §§103 and 171.

CONSTITUTION

Section 8. The Congress shall have Power * * *

8. To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries;

PATENT CODE

§103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§171. PATENTS FOR DESIGNS

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided. (Emphasis added).

IV

ISSUES PRESENTED BY PETITION

Both of the patents in suit, one a design patent (which expired April 20, 1968) and the other a mechanical patent, relate to handrails although to different handrails. A single type of handrail used by defendants (Respondents herein) and unlike either of those shown in the patents was accused to infringe both.

It is of course recognized that the origin of handrails is so far removed in history that it is beyond exact documentation. Balconies and stairways have long been provided with handrails for protective purposes.

Handrails, even from the earliest times have been provided with certain conventional and necessary parts including spaced, upright posts supporting one or more railings by suitable fasteners. These handrails assemblies were necessarily fashioned to conform to the contour of the balcony or stairway on which they were mounted. Walls adjacent the steps of a stairway have similarly long been provided with handrails mounted on brackets attached to the wall surface.

Notwithstanding the crowded state of the railing art, actually going back as far as memory serves, Louis Blum, the patentee of both of the patents in suit, as late as 1953 declared himself to be the inventor of a railing design, and in 1955 the inventor of a mechanical gadget in another type of railing for attaching the handrail to the posts.

As became apparent from the institution and unfolding of this litigation, Blum considered himself to be the "in-

ventor" of far more than the specific structure shown and described in his patents.

The real questions for consideration therefore are:

a) Did the Court of Appeals commit gross and manifest error in holding the patents in suit invalid under 35 U.S.C. §103 as heretofore interpreted by this Court after careful application of each and every one of the tests for obviousness or non-obviousness of the alleged inventions as it was obliged to do in accordance with the precepts of this Court in *Graham* v. *John Deere Co., et al.*, 383 U.S. 1 (1966).

b) Was the Court of Appeals clearly wrong in reaching its own independent judgment on the validity of the design patent under the mandates of this Court as it was obliged to do notwithstanding the fact that the patent had been held valid in a previous decision of the Court of Claims, where not all of the pertinent prior art was before the Court of Claims and where after trial of the action before the Trial Commissioner, the government, in consideration for a favorable limitation of its potential liability, agreed not to take exception to the Trial Commissioner's findings of validity, thus leaving the government unrepresented before the full Court of Claims and paving the way for the Judges of the Court to grant plaintiff's Motion for Judgment on the record?

c) Did the Court of Appeals use unsound judgment in holding both patents in suit invalid as not meeting the exacting standard of invention that is required by this Court in order to justify the imposition of a patent monopoly on the public, where

1) The design patent, merely showing a railing made up of spaced posts supporting a plurality

of handrails through use of L-shaped brackets, was held invalid because it would have been completely obvious to skilled railing designers in view of similar showings in the prior art to simply support the rails from posts by somewhat inconspicuous brackets; and

2) The mechanical patent relating simply to a railing made up of an ordinary post, a dovetail handrail, and a two-piece clamp supporting the handrail from the post and gripping the base of the handrail was held invalid, not only because the assembly is nothing more than a conventional vise, but also because the prior art showed handrails offset from posts, as well as two-piece V-shaped clamps connected to a post and gripping the dovetail base of a rail?

V

COUNTER STATEMENT OF THE CASE

Blumcraft of Pittsburgh brought this action for patent infringement on September 27, 1962, in South Carolina against defendants located and doing business in that area, well knowing that they were simply customers of Architectural Art Mfg., Inc. of Wichita, Kansas, the manufacturer of the accused railing structure.

Defendant Citizens and Southern National Bank of South Carolina is the owner of the bank building in Greenville in which the accused railing was installed; defendant Daniel Construction Co., Inc. was the general contractor for the bank building; and defendant Colonial Iron Works, Inc. fabricated and installed the components purchased from Architectural Art, under subcontract from Daniel.

Architectural Art has controlled and conducted the defense of this suit but has never been a party.

After bringing this action, Blumcraft brought suit against the United States in the Court of Claims on February 12, 1963, for infringement of the design patent *only*. The government was alleged to have infringed the patent by its purchase and use of certain handrails made by Railcraft Corporation of San Francisco, California. There was not then and has never been any connection between Railcraft and Architectural Art. The Railcraft railing accused in the Court of Claims suit was completely different from the Architectural Art Clean Line railing involved in this suit.

The Justice Department, defending the Court of Claims suit on behalf of the government, assigned the case to a junior attorney in the Patent Section. In preparation for trial, he asked the defendants in South Carolina for an identification of the prior art developed in connection with their defense. In answer to the specific request of the Justice Department, Respondents identified the prior art located up to that time, as they felt they were bound to do so.

This was the full extent of the so-called "direct collaboration" between Respondents and the government in the Court of Claims suit which Petitioner relies upon as being so important in confirming that there is a controlling relationship between the Court of Claims action and this suit.

When it became apparent to Blumcraft that trial of the Court of Claims action could be commenced before trial in South Carolina, notwithstanding earlier filing of the District Court case, Blumcraft made every effort from that point on to delay trial of the case in South Carolina until after the decision of the Court of Claims. In fact, Blumcraft filed a motion which was granted by the District Judge to hold up the South Carolina trial until after de-

cision by the Court of Claims, even though there was no relationship whatsoever between the actions, and the South Carolina case at that time had been on file for well over three years.

The Trial Commissioner of the Court of Claims issued an opinion on September 22, 1966 recommending that the design patent in suit be held valid and infringed. Blumcraft then offered to limit the recovery sought from the government if the Department of Justice would agree not to take exception to the Commissioner's recommendations or present any argument to the full Court of Claims in disagreement with the findings of the Trial Commissioner. The government accepted Blumcraft's offer and presented no argument or opposition to the ruling by the Commissioner. As a consequence, the Court of Claims issued its per curiam opinion on February 17, 1967, adopting the Commissioner's recommended findings and conclusions with the notation that the government had not opposed or taken exception thereto. (Opinion, Pet. A. p. 57a).

The South Carolina case finally went to trial on May 17, 1967, and the District Judge held both patents in suit valid and infringed in an opinion dated May 23, 1968, noting that the prior opinion of the Court of Claims had been persuasive (Opinion, Pet. A. p. 14a) in concluding that the design patent in suit was valid over the prior art.

Defendants actively prosecuted an appeal of the District Court's decision to the Fourth Circuit Court of Appeals, and the lower court's decision holding the patents in suit valid was unanimously overruled. (Pet. A. p. 47a).

The Mechanical Patent (No. 2,905,445)

The extremely simple rail structure of the mechanical patent in suit may be fully understood from the showing in Figures 1 and 3 of the patent reproduced below:

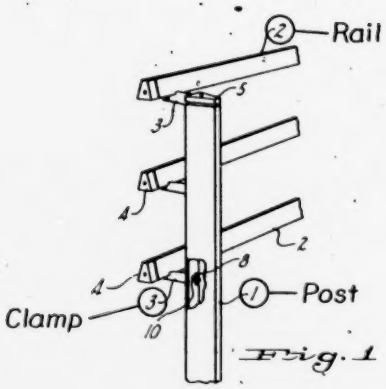


Fig. 1

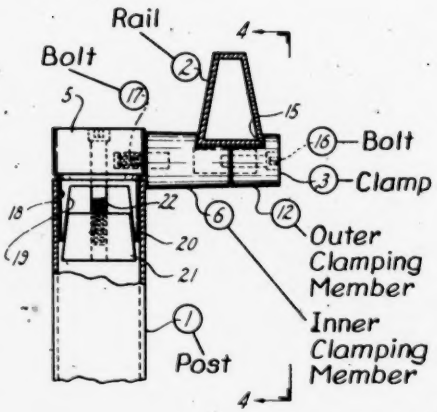


Fig. 3

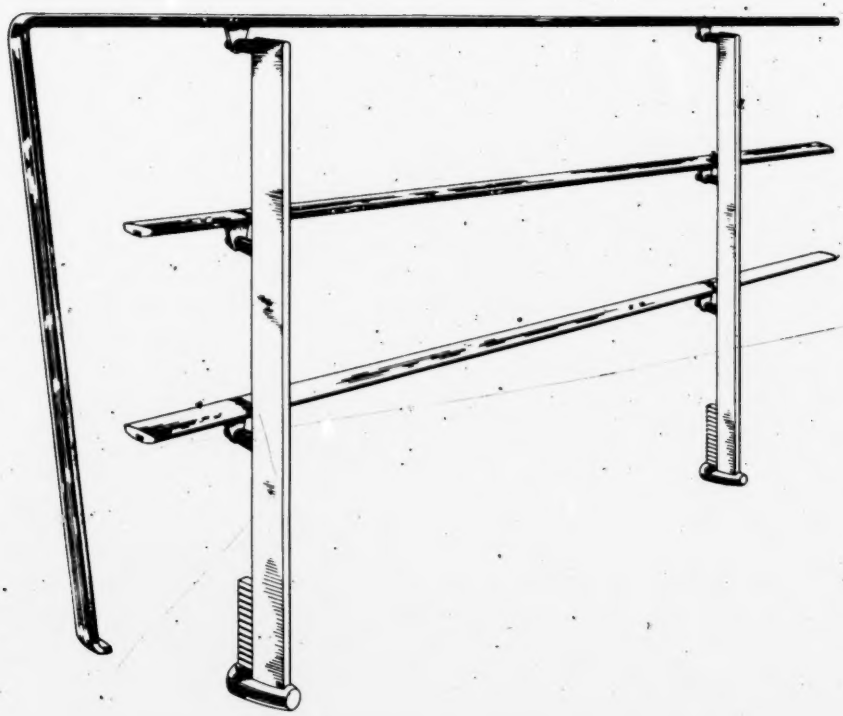
The trapezoidal rails 2 are held offset from the post 1 by simple brackets or clamps 3 (Fig. 1).

As shown in Fig. 3, each clamp 3 is made up of inner and outer clamping members 6 and 12 which quite naturally have V-notches shaped to receive the dovetail base of rail 2.

The inner clamping member 6 is attached to the post 1 by an ordinary bolt 17, and another conventional bolt 16 passing through the outer clamping member 12 and threaded into inner clamping member 6, merely causes the members 6 and 12 to grip the rail 2 as in a common vise.

The Design Patent

The single figure of the design patent in suit is reproduced below:



Basic to railing structures generally in the above assembly is a number of rails extending from one post to another. The rails are supported alongside the posts by L-shaped brackets, and the top rail has a downwardly and inwardly inclined end extension.

The posts are merely rectangular bars modified only by bullet shaped feet and by ribbed shanks on their inner edges adjacent the feet.

The rails consist simply of long, generally flat bars with slightly curved gripping surfaces. The brackets include nothing more than outwardly projecting rods carrying rail supporting triangular plates.

The single claim of the patent is for a rail "as shown".

In an effort to support its contention of infringement, and faced with a marked difference in appearance between the accused railing and that shown in the design patent, Blumcraft took the position in this litigation that many of the components shown in the patent drawing should actually be ignored as not being a part of the design.

These include the downturned extension of the upper rail, the bullet shaped feet on the posts and the serrated shanks above the feet. The specific shapes of the rails and posts as illustrated were also argued to be unimportant.

VI

ARGUMENT

The Court of Appeals Fully Met Its Duty of Ruling on the Validity of the Design Patent in Suit under the Strict Mandates of This Court, Rather Than Simply Resorting to "Comity" As a Basis for Holding It Valid As a Matter of Expediency

Faced with the obligation of either following the rules and principles laid down with repetitious uniformity in the judicial pronouncements of this Court, or to courteously recognize and follow the findings of the Court of Claims on the basis of comity as a matter of expediency, the Court of Appeals below on its own determination held the design patent in suit invalid as obvious under 35 U.S.C. §103 and under the high standard of invention required by this Court as a condition to patentability.

Pages 11 to 16 of the Petition contain a long and belabored treatise as to why the Court of Appeals should have followed the decision of the Court of Claims on the basis of "comity". Respondents of course recognize that comity has a place in the law to avoid repeated litigation

of a single matter and to obtain uniformity of decision. However, comity is not a matter of common law or statute but simply deference by one court to the opinion of another out of respect. It can never be applied in opposition to the dictates of this Court.

The doctrine of judicial "comity", particularly in the case of patents where the rights of the entire public are involved, cannot and must not be permitted to serve as a substitute for the absolute and unavoidable obligation on each lower court considering the validity of a patent, to make unquestionably certain in each instance that the subject matter of the patent does in fact meet the high standard of invention uniformly required by the decisions of this Court under the Statutes and the Constitution.

Blumcraft, citing *Mast, Foos & Company* v. *Stover Manufacturing Company,* 177 U.S. 485 (1900), contends that under the doctrine of judicial comity, it was error for the Court of Appeals to reach an independent conclusion on the validity of the design patent, since the Court of Claims had previously held the patent valid.

Not only is Blumcraft's contention contrary to the public interest, particularly where the first court did not have before it all of the prior art made available to the second court as is the case in this suit, but *Mast, Foos* simply does not support Petitioner's argument.

In that case, precisely as here, the Eighth Circuit had previously held the patent in suit valid, while the Seventh Circuit reached an independent subsequent conclusion that the patent was invalid, reversing the trial court which had relied on the Eighth Circuit decision case.

This Court endorsed the independent action of the Seventh Circuit Court of Appeals and made it clear that ". . . the primary duty of every court is to dispose of cases

according to the law and the facts; in a word, to decide them right. In doing so, the Judge is *bound* to determine them according to his own convictions." (loc. cit. p. 488, emphasis added).

Nothing can be gained by Certiorari in the instant case merely to reiterate the law of comity as set down by this Court in *Mast, Foos & Company* v. *Stover Manufacturing Company*, supra.

Patents, as creatures of statute only, as opposed to matters of natural right, must be treated as requiring a very high level of innovation and invention for support, since they inherently impose a limitation not only on the parties involved in a particular suit, but the public right as well, all to the benefit of the patentee alone.

This Court just recently acted on the standard of invention required to justify a patent monopoly in *Graham* v. *John Deere Co., et al.*, supra, 383 U.S. 1 (1966), holding that Section 103 of the Patent Act does accurately reflect a controlling precept of patentability under the Constitution. Mr. Justice Clark, in his historical review of the strictures which have been placed on patent monopolies by this Court under the Constitution and Statutes from the very beginning of the patent system in this country, makes it abundantly clear that a precise demarcation must be drawn between "the things which are worth to the public the embarrassment of an exclusive patent, and those which are not." (loc. cit. p. 9). The courts below were admonished that they should beam attention with greater intensity on the requirements of Section 103 of the Patent Act and that the Statute did not in any way change the "general strictness with which the overall test is to be applied". (loc. cit. p. 19).

The tests for determining obviousness or non-obviousness of an invention were set down with clarity and

precision in the *Graham* decision, leaving no room for doubt or argument as to their import or meaning.

The primary tests were listed as: what was the state of the prior art; what were the differences between the alleged invention and the art; and what was the level of skill in that field. This Court said that secondary considerations such as long felt need and commercial success could be looked to for enlightment on the origin of the development, but could not be used to tip the scales of patentability, regardless of their nature, where there was no invention under the primary guidelines.

In this case, the Court of Appeals scrupulously adhered to the requirements of *Graham*, making conclusive determinations on each of the primary tests and giving full consideration to the secondary factors raised by the plaintiff. With these conclusions before them the Court was forced to find the design patent invalid.

Thus, the Court of Appeals cannot be criticized for failing to follow the legal obligations imposed upon it by this Court under the Patent Statute and the Constitution, but may be brought to task, if at all, only by a showing of clear and manifest error in holding the design patent invalid under Section 103 and the decisions of this Court.

This Court has repeatedly held that certiorari is not appropriate for use by a defeated litigant merely to obtain a second appellate review of his case. See, as one example among a multitude, *Magnum Import Co.* v. *Coty*, 262 U.S. 159, 163 (1923). Certiorari is granted only when principles of public importance require resolution rather than the mere interests of the litigants. *Forsythe* v. *Hammond*, 166 U.S. 506, 514 (1896); *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U.S. 387, 393 (1923); and *Rice* v. *Sioux City Memorial Park Cemetery*, 349 U.S. 70, 74 (1955).

Furthermore, and contrary to Petitioner's position, since the scope, meaning and applicability of Section 103 of the Patent Statute were all firmly resolved in the *Graham* case, these questions do not need reexamination here. No one can seriously question the applicability of Section 103 to design patents, *as specifically provided by 35 U.S.C. §171,* since all patents, mechanical and design alike, are granted under the same constitutional authority.

The Decision of the Court of Appeals Is Not in Such "Conflict with the Decision of the Court of Claims As to Justify Review under Rule 19

Manifestly, Petitioner is unable to justify review of the Court of Appeals decision on the basis of conflict of decisions as to the mechanical patent in suit because it was not involved in Blumcraft's suit against the government. The validity of the mechanical patent was tested for the first and only time in the present case.

As to the design patent, in view of the actual circumstances which occurred in connection with such patent being held valid in the Court of Claims, it is submitted that the ruling of the Court of Claims should not and cannot, under any standard of measurement, be considered as equal to that of the Court of Appeals in this suit.

Respondents do not argue that decisions of the Court of Claims are not normally on much the same judicial level as those of the Courts of Appeal, but insist that in this particular circumstance, the ruling by the Court of Claims on the design patent cannot be considered to have been reached on a basis equivalent to that of the Court of Appeals below. There is in fact no "real and embarrassing conflict of opinion and authority between Courts of Appeal". *N.L.R.B.* v. *Pittsburgh S.C. Co.*, 340 U.S. 499, 502 (1951), citing *Layne & Bowler Corp.* v. *Western Well Works*, 261 U.S. 387, 393 (1923).

Two important and controlling considerations apply: First, there was no appeal involved in the Court of Claims suit. Secondly, the Trial Commissioner in the Court of Claims did not have before him much of the prior art on which the Court of Appeals concluded that the design patent was not patentable.

Where the Trial Commissioner, based only upon the evidence before him, recommended that the design patent be held valid and infringed, and Petitioner then offered to limit the liability of the government under the patent if it would refrain from taking exception to the Trial Commissioner's report, and not oppose Petitioner's motion for judgment on the record, no direct conflict can be found.

In vivid contrast, Respondents submitted all pertinent evidence in the proceedings below and demonstrated conclusively to the Fourth Circuit Court of Appeals that the design patent should be held invalid.

An important reason why the Court of Appeals reached a conclusion on the validity of the design patent different from that of the Trial Commissioner of the Court of Claims was the fact that less than half of the prior art cited by Respondents in this case against the design patent was brought to the attention of the Trial Commissioner. In fact, of the seven specific prior art references referred to in the opinion of the Court of Appeals as being important to show invalidity of the design patent (Opinion, Pet. A, pp. 48a, 49a), only four were of record as prior art in the Court of Claims action. These significant omissions included the Hollaender stair rail which shows it to be old to provide multiple, parallel rails offset from supporting post structure through use of L-shaped brackets. The Court of Appeals also specifically cited a prior disclosure of flat handrails carried by inconspicuous L-shaped brackets in a W. T. Grant store, and prior art showing rails floating away

from their supports in a sanatorium. These were highly important to Respondents' defense and were not before the Trial Commissioner.

The lack of a "real and embarrassing" conflict between the decisions is patently clear; and there is absolutely no justification for a review of the decision below on the grounds of "comity" advanced by Petitioner.

This case is a prime example of precisely why there is no statute on comity, particularly in patent cases. Where would the public be if a patentee could bring a suit in a first court, then before going to trial file suit under the same patent in a second court, take steps to quickly try the case in the second court so that the second defendant would not have time to fully develop its defenses, obtain a favorable decision on validity in the second court, and then in consideration for limiting the recovery, obtain the second defendant's agreement not to appeal so that the decision of validity would be binding on the first defendant under a doctrine of federal "comity"? The question answers itself. But this is exactly the possible result of Petitioner's proposition on comity—as demonstrated by the circumstances of the present case.

"Obviousness" Is the Only Issue Involved in This Case Whereas Unpatentable Aggregation Is the Sole Question Presented in the Pending Anderson's-Black Rock, Inc. v. Pavement Salvage Company, Inc. Case

Petitioner advanced no basis or reason for its request that this case be set for hearing following *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Company, Inc.*, certiorari granted March 24, 1969, Case No. 1014. Other than the fact that both cases involve patents, there is no relationship whatsoever between them. The subject matter, issues presented, and parties are completely different.

The only real question for consideration in this case is whether or not the Court of Appeals faithfully followed the mandate of this Court in *Graham* v. *John Deere Co., et al.*, supra, 383 U.S. 1 (1966), in determining that the subject matter of the patents is obvious in view of the prior art. The issue of obviousness is entirely unrelated legally and factually to the "aggregation" question raised in the *Pavement* case. In that suit the Petitioner alleged that the lower court failed to give proper consideration and weight to the matter of unpatentable aggregation under the authority of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U.S. 545 (1937). No question of aggregation in the sense of the *Lincoln Engineering* case or otherwise has been placed in issue in this suit, and the Court of Appeals made no reference to this question in its opinion below because it was not in issue.

Petitioner herein also contends that there is a conflict between panels of the Court of Appeals for the Fourth Circuit as to the soundness of the decision of the Court of Claims in *Blumcraft of Pittsburgh* v. *The United States*, 372 F.2d 1014 (1967), simply because the latter was referred to in the decision of the *Pavement* case by one panel of the Court of Appeals.

However novel this theory may be, it has no bearing on the question of whether or not certiorari should be granted in this case, or on the necessity of joining it with the *Pavement* case for hearing and consideration before this Court. In *Pavement Salvage Co., Inc.* v. *Anderson's-Black Rock, Inc.*, 404 F.2d 450 (4th Cir. 1968), the Fourth Circuit Court of Appeals referred to secondary considerations such as commercial success and long felt need as being helpful in shedding light on the origin of an invention. These sub-tests were noted as being useful in conjunction with the major guidelines of *Graham* for determining obviousness or non-obviousness of an invention. *Blumcraft of*

Pittsburgh v. *The United States*, supra, 372 F.2d 1014 (1967), was simply cited by the Court of Appeals as being one case among many which had previously made reference to the value of sub-tests for resolving validity of a patent where patentability was in doubt.

The Court of Appeals, in its decision in this suit below pursued the *Graham* guidelines virtually ad verbum, including those relating to secondary considerations such as commercial success and long felt need. However, after giving these secondary matters all the weight to which they were entitled in light of the evidence, the Court concluded that secondary factors simply could not breathe life into what were clearly dead patents.

Comparison of the decisions of the Fourth Circuit in the *Pavement* case and in this case clearly shows that the *Graham* guidelines in their entireties were applied by both panels in reaching the final conclusions expressed. The only question here presented is whether the right decision was reached under the evidence presented by Respondents.

Opinion of the Court of Appeals

Although the considerations discussed above are dispositive of the real issues presented by this Petition, the generalized attack by Petitioner on the soundness of the decision by the Court of Appeals requires factual response.

The structure of the mechanical patent is nothing more than a simple, two jaw device clamped to the rail by a bolt (as in a common vise bolted to a post) for supporting the rail offset from the post. Everything about this structure is completely obvious.

Blum himself described his two piece clamp as gripping the handrail in the manner of a vise. And a vise it is. There is no need to go further than a common ordinary vise found on the work benches of every machine or

basement workshop to find the basic concept of the Blum structure. In a vise, one of the clamping elements is secured to the bench while the other clamp element is joined to the first by a threaded bolt member. A work piece can thus be clamped between the jaw elements and held spaced from the support for the jaws.

Posts and handrails were ancient when Blum filed his patent application on the handrail assembly of his mechanical patent. Offsetting of the handrail from the post was not new. This is particularly confirmed by the fact that the Blum design patent is prior art to the Blum mechanical patent. While the design patent did not use a two piece clamp with notches for gripping the dovetail of the handrail, that specific concept had been available to the art since at least 1875 as shown in the Hardy patent No. 163,996. A two piece clamp with V-notches complementally gripping the dovetail base of a rail was also clearly shown in the 1915 McNeil patent No. 1,165,195.

Following the *Graham* guidelines, the Court of Appeals recorded in its opinion the differences which existed between the prior art and the assembly of the mechanical patent. These primarily included Hardy's mounting of the handrail directly above the post rather than to one side, and McNeil's use of the same old clamping principle for railroad rails. The court correctly held that because the Blum structure and that of McNeil are both "simple devices employing the same universally known principles of mechanics, McNeil's patent is pertinent prior art and supports our conclusion that Blum's device was obvious. *Mast Foos & Co.* v. *Stover Mfg. Co.*, 177 U.S. 485, 493 (1900); *Knapp* v. *Morss*, 150 U.S. 221, 226 (1893); *Skee-Trainer, Inc.* v. *Garelick Mfg. Co.*, 361 F.2d 895, 898 (8th Cir. 1966)." (Pet. A. p. 54a).

Noting that the highly developed state of the prior art confirmed that designers in the field were highly skilled, the Court of Appeals properly concluded that the differences between such prior art and the structure of the mechanical patent in suit were not sufficient to establish non-obviousness. The Court had no alternative other than to hold that in view of the common place ideas of supporting handrails offset from posts and providing vise type clamps for the rails "It was within the skill of an ordinary mechanic to attach a vise-like clamp to a post in any number of positions by any number of means." (Pet. A. p. 53a).

Blumcraft found it necessary to resort to an argument that such secondary factors as flexibility and rigidity so that the railing could be assembled at the job site to meet existing conditions supported patentability. But even these features were old in the prior art, as found for example in the commercial structure of the design patent which was prior art to the mechanical patent.

The Court of Appeals treated invalidity of the design patent with equal precision. Acknowledging that the prior art did not disclose a handrail of the exact form detailed in the patent drawing, the Court said that in order to be patentable, the "design must be more than novel". The applicability of this principle to design patents has long been understood and accepted. Cf. *Smith* v. *Whitman Saddle Co.*, 148 U.S. 674 (1893).

With the background of Blumcraft's insistence that the downturned upper rail, bullet feet, serrated shanks and specific shapes of the posts and handrails were to be ignored in considering its design patent, the invention, if any, of the design patent, *as asserted by Blumcraft,* became limited to the provision of a plurality of handrails supported away from the posts through use of L-shaped, relatively inconspicuous brackets. Under such definition

by Blumcraft of the nature and scope of its alleged invention, the Court necessarily found the patent invalid as clearly lacking invention over the prior art relied upon by Respondents.

Since, at the time Blum did the work which led to filing of his application for design patent, the railing art was highly developed, Petitioner's persistent plea that Blum was the first to provide a handrail compatible with modern architecture (Pet. p. 7) is utter nonsense. Architects had been designing handrails compatible with modern architecture for years before Blum's railing. Many had handrails offset from the posts.

In its review of the prior art, the Court below noted that multiple parallel rails offset from their supporting posts was old.[1] L-shaped brackets for supporting handrails were also well known, including their use as means for mounting a plurality of rails away from the posts therefore.[2] Even the specific shapes of the handrails and posts were shown to be old.

The crux of the differences between the railing of the design patent and those of the prior art was summarized by the Court of Appeals as being:

> "His predecessors offset multiple rails with prominent connectors and single rails by inconspicuous connectors. Blum merely offset multiple rails by inconspicuous connectors to achieve with several rails the floating effect that had previously been imparted to a single rail." (Pet. A. p. 49a).

Since these minor differences were well within the skill of designers in this art, the Court held that the design was obvious.

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1. Def. Chart #D-2, DX 142.
2. Def. Chart #3, DX 122; Chart #D-2, DX 142.

Blumcraft attempted to negate the effect of the prior art by arguing commercial success and long felt need. Although *Graham* makes it clear that these sub-tests are not conclusive as to patentability, the more important consideration is the fact that Petitioner failed to really show commercial success or satisfaction of a long felt need.

Commercial success, if any, was primarily predicated on Blumcraft's sale of the railing components in pre-fabricated form so that they could be assembled in the field. But a design patent must concern itself with creative artistry and not mechanical features of the component parts or marketing concepts by the manufacturer.

The problem with the Petitioner's argument is well summed up by the Court of Appeals in this language:

> "To prove long-felt, unsolved need, Blumcraft says 'The need for a commercially available railing system compatible with modern architecture had existed for some time prior to the Blum invention.' This observation illustrates both Blum's success and the invalidity of his patent. There was no unsolved need for attractive modern railings. Architects were capable of supplying them through custom design. There was a need, however, for a prefabricated railing system embodying modern design. Blum met this need by adapting known custom designs to a prefabricated railing system. Blum's product enabled architects to specify the number and spacing of rails to create designs compatible with the architecture of many modern buildings. Blum's contribution to the art was not his design; this was obvious. It was his railing system which was unique. But *Blum's railing system is not the proper subject of a design patent. The statutory grant of a design patent is for appearance and not for a method of manufacture or assemblage, function or utility.*" (Citing cases and authorities) (Pet. A. p. 50a and 51a) (Emphasis added).

CONCLUSION

Petitioner's arguments merely evidence its desire to have one last review of the case on the merits, but this is clearly not a valid ground or sufficient justification for Writ of Certiorari.

The only basis in the Petition for requesting review of the mechanical patent is the allegation that the Lower Court failed to give sufficient consideration to commercial success and long-felt need. This Court has repeatedly ruled that such factors cannot breathe life into a clearly obvious, and therefore, invalid patent.

With respect to the design patent, the Lower Court properly rejected comity because of being bound to follow *Graham* v. *Deere*, supra, 383 U.S. 1 (1966). Moreover, since 35 U.S.C. 171 incorporates 35 U.S.C. 103, there is no need for this Court to again rule on the matter of obviousness as it relates to patentability.

Accordingly, Petitioner's prayer for a Writ of Certiorari to be issued to the Court of Appeals for the Fourth Circuit from its decision holding the patents invalid should be denied.

Respectfully submitted,

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SUPREME COURT, U. S.

FILED
JUN 10 1969
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1968.

No. 1355.

BLUMCRAFT OF PITTSBURGH,
a Partnership Consisting of
Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioners,

v.

CITIZENS AND SOUTHERN NATIONAL BANK
OF SOUTH CAROLINA,
DANIEL CONSTRUCTION COMPANY, INC.
and COLONIAL IRON WORKS, INC.,
Respondents.

REPLY BRIEF AND APPENDIX FOR PETITIONERS IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT.

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Introduction.

In their brief in opposition to the petition for writ of certiorari, Respondents first recite a series of supposed "real questions for consideration" and then elsewhere (p. 18) dismiss them with the pronouncement that "the only real question here presented is whether the right decision was reached under the evidence presented by Respondents". The candid observation at page 18 should be corrected to state that "the only question here presented is *which court* reached the right decision under the evidence presented by Respondents."

Respondents' attack on the petition devolves into the following contentions:

(a) The Court of Claims' decision, not being an "appeal" and based upon a different record, is not in conflict with the present case.

(b) The doctrine of comity does not oblige the Court of Appeals to follow blindly the decision of a coordinate court.

(c) There is no relation between the *Pavement Salvage* case and the present case.

(d) It was proper for the Court of Appeals to decide the case *de novo* despite the findings of the District Court.

(e) Petitioners merely seek redress for the errors of the Court of Appeals and there is no significance beyond this case.

Of these points:

(a) is incorrect and based on false premises,

(b) is true but irrelevant to this case,

(c) is incorrect,

(d) is in direct conflict with the most recent decision of the Supreme Court in a patent case, *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 161 U. S. P. Q. No. 7 Supp. pp. 1-15 (May 19, 1969) and

(e) is incorrect—the conflict will extend to other cases in other courts involving the same patents unless decided by the Supreme Court.

There Is a "Real and Embarrassing Conflict of Opinion and Authority" Between the Court of Appeals for the Fourth Circuit and the Court of Claims.

(a) The Record Based on the Prior Art Is the Same in Both Cases—Respondents Are in Error.

Respondents, in conceding that certiorari should be granted in a case involving a direct conflict between a decision of the Court of Claims and the Court of Appeals pursuant to Rule 19 of the Supreme Court Rules, argue that there is no real conflict here because "less than half of the prior art cited by Respondents in this case against the design patent was brought to the attention of the Trial Commissioner" and "of the seven specific prior art references referred to in the opinion of the Court of Appeals as being important . . . only four were of record as prior art in the Court of Claims action". They specifically assert that the Hollaender stair rail, the W. T. Grant store rail (Architectural Record, July, 1934) and the Sanitorium rail (Architectural Record, March, 1940), were not brought to the attention of the Commissioner in the Court of Claims and this was "an important reason why the Court of Appeals reached a conclusion on the validity of the design patent different from that . . . of the Court of Claims". (Brief for Respondents, p. 15).

Respondents are completely wrong on the facts. First, all of the prior art patents and published architectural ref-

erences in the present case and the Hollaender and Home Federal Savings and Loan Building railings were brought to the attention of the Trial Commissioner in the Court of Claims. The notices of prior art in both cases establishing this fact are presented in the Appendixx, pages 75a-87a. It will be noted that the Trial Commissioner was informed in each instance. Second, each of the specific items of prior art—Hollaender, W. T. Grant and the Sanitorium railing—was paired by the Court of Appeals for the Fourth Circuit in its own opinion with a second reference as showing the identical subject matter (Appendix, 43a-49a). In each case the second reference was not only brought to the attention of the Trial Commissioner in the Court of Claims case but was actually referred to in the Court of Claims opinion (Appendix, 70a):

Prior Art Specified by Respondents	*Second Identical Reference*	*Court of Claims Exhibit Number*
Hollaender	Wallach's Jamaica Store	Defendant's Exhibit 6
W. T. Grant	Kansas City Auditorium	Defendant's Exhibit 1
Sanitorium	Saarinen Church	Defendant's Exhibit 3

It is clear that Respondents are wrong in their contention that there was any difference in the prior art before the Court of Appeals for the Fourth Circuit and that cited in the Court of Claims.

(b) The Decision of the Court of Claims Was the Final Adjudication of That Court.

Respondents' second reason for urging the Court to disregard the confiict between the Court of Appeals for

the Fourth Circuit and the Court of Claims is that "there is no appeal involved in the Court of Claims suit" (Brief for Respondents, p. 15). The Respondents appear to misunderstand the procedure of the Court of Claims. There is *never* an appeal in such cases within the Court of Claims.

Stern and Grossman, Supreme Court Practice, Section 4-7 (3rd ed.):

> "Where there is a direct conflict between a decision of a Federal Court of Appeals and that of the United States Court of Claims, there is ground for Supreme Court review of either decision by way of certiorari. While the Court of Claims is a court of first instance, its decisions are final within the realm of its jurisdiction, subject only to review by the Supreme Court. In this respect, therefore, the decisions of the Court of Claims are like those of Courts of Appeals. Since conflicts between them can be resolved only by the Supreme Court, certiorari is granted in such cases."

The *Blumcraft* case was adjudicated entirely in accordance with the procedures set forth in the pertinent Court of Claims Rules. The case was referred to the Commissioner under Rule 43. He acted as the "trial judge" of the Court of Claims pursuant to Rule 52, heard evidence presented during one week of trial and submitted his report to the Court one year later in accordance with Rules 54-57.[1] The Court then proceeded in accordance with Rules 62 and 65 relating to the submission of cases without exception by

1. Notwithstanding Respondents remark that the Justice Department assigned the case to a "junior attorney", every defense in the present case was presented by the Justice Department in the Court of Claims with the full cooperation and assistance of Respondents' attorney who attended the entire trial at the expense of Architectural Art but ostensibly not on their "behalf" (Appendix, 87a).

either party to find the facts, state the conclusions of law and direct the entry of judgment in accordance with Rule 66. The case had been fully briefed by the parties and recommended findings of fact and conclusions of law and objections were submitted in accordance with Rule 57 and are included in the record of the Court. As set forth in the petition for certiorari, an agreement was reached with respect to the accounting in which the Government specified that the agreement related to the accounting procedure only and did not represent final disposition of the case at that time. The accounting is still in process and includes, among others, the products of Architectural Art.[2] The Trial Commissioner in the Blumcraft case was Commissioner Donald E. Lane who was the Trial Commissioner in *United States v. Adams,* 383 U. S. 1 (1966) in which case, as in the present case, his report was adopted by the full Court of Claims, and was affirmed by the Supreme Court on certiorari.

In holding Louis Blum's patent invalid the Court of Appeals for the Fourth Circuit itself acknowledged that its ruling was in direct conflict with the Court of Claims (Appendix, 48a): "The Court of Claims recently found Blum's design patent valid."

The Rules of the Supreme Court provide, and Respondents do not argue to the contrary, that conflict between the Court of Claims and the Court of Appeals calls for the exercise of the review power of the Supreme Court. The conflict in this case is "real and embarrassing" and can only

2. The actions of Architectuarl Art continue to belie the arguments now presented to the Court. While arguing here that there is no relation between the Court of Claims case and the present case, Architectural Art, through its President, has argued to the Court of Claims in the accounting procedure in a motion dated February 27, 1969 that it should not be compelled to respond to a subpoena duces tecum "in view of the decision of the U. S. Court of Appeals for the Fourth Circuit on February 19, 1969, holding design patent D-171,963 invalid and unenforceable against Architectural Art Mfg., Inc.". (Appendix, 95a-98a).

be resolved in this Court. *N. L. R. B. v. Pittsburgh S. C. Co.*, 340 U. S. 499, 502 (1951).

Respondents Misstate the Doctrine of Comity as Presented by Petitioner.

In their Brief, Respondents misstate the doctrine of comity as presented by Petitioners:

> "Blumcraft, citing *Mast, Foos & Company v. Stover Manufacturing Company*, 177 U. S. 485 (1900), contends that under the doctrine of judicial comity, it was error for the Court of Appeals to reach an independent conclusion on the validity of the design patent, since the Court of Claims had previously held the patent valid." (Brief for Respondents, p. 11)

This, of course, is not Petitioner's contention at all. Petitioners rely only upon the rule of comity applied in the dozen or more cases cited in the petition and as succinctly stated by the Supreme Court in the *Mast, Foos* case, p. 489:

> "It demands . . . that deference shall be paid to the judgments of other coordinate tribunals".

The error of the Court of Appeals for the Fourth Circuit was not in reaching an independent conclusion but in failing to give that deference to the prior decision of the Court of Claims which even the Respondents concede is required by the *Mast, Foos* decision. Since the Court of Appeals failed to pay any attention whatever to the decision of the Court of Claims, the Supreme Court must determine itself whether the decision of the Court of Appeals for the Fourth Circuit was indeed "correct upon the merits" as provided in the *Mast, Foos* decision, *supra* at page 489 and this can only be done by granting the writ of certiorari.

Respondents insist that nothing can be gained "merely to reiterate the law of comity as set down by this Court in *Mast, Foos & Company v. Stover Manufacturing Company, supra.*" They overlook the current burden of litigation upon the Federal Courts and the need for a more uniform administration of justice in the field of patents evidenced by the many recent decisions cited in the petition.

This is a proper time for the Court to develop the doctrine of comity so as to limit the endless relitigation of the validity of a single patent in each of the Courts, producing contrary results on the same record.

The Conflict With *Pavement Salvage Co. v. Anderson's-Black Rock, Inc.* Presents a Separate Basis for Granting Certiorari.

Respondents challenge Petitioner's reliance upon the conflict between different panels of the Court of Appeals for the Fourth Circuit as a "novel . . . theory". This is not so. Conflict within a single Circuit is, in itself, an accepted basis for the grant of the writ of certiorari, *John Hancock Mutual Life Insurance Co. v. Bartels,* 308 U. S. 180 (1939), *Dickinson v. Petroleum Conversion Corp.,* 338 U. S. 507 (1950), *Maggio v. Zeitz, Trustee in Bankruptcy,* 333 U. S. 56 (1948).

Respondents cannot be serious in their further contention that "there is no relationship whatsoever" between this case and *Pavement Salvage Co. v. Anderson's-Black Rock, Inc.,* 404 F. 2d 450 (1968), "other than the fact that both cases involve patents". They concede that the present case presents a question of "obviousness" under § 103 of the Patent Act in the light of the decision of the Court in *Graham v. John Deere Co.,* 383 U. S. 1 (1966). In the *Pavement Salvage* case, the Court of Appeals stated precisely the same question (at p. 452):

> "The question, then, is whether the solution 'would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *' within the meaning of 35 U. S. C. A. § 103, as interpreted in Graham v. John Deere Co., 383 U. S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545."

The Court then cited *Blumcraft of Pittsburgh v. United States,* 372 F. 2d 178 (1967) 1014 Ct. Cl. 798, among others, as authority for its construction of § 103 of the Patent Act. The petition for writ of certiorari in the *Pavement Salvage* case specifically refers to § 103 of the Patent Act as the pertinent statutory provision. Throughout both the petition and the Respondents' brief it is insisted that the question before the Court is the application of § 103 by the Court of Appeals in light of the Supreme Court's decision in *Graham v. John Deere Co., supra.* Of course the specific facts and the patents in this case are different from those in *Pavement Salvage.* Both cases, however, involve the application of § 103 of the Patent Act and the determination of "obviousness."

Certainly the relationship between the present case and the *Pavement Salvage* case is far closer than the relationship between *Graham v. John Deere Co., Calmar, Inc. v. Cooke Chemical, Inc.* and *United States v. Adams,* 383 U. S. 1 (1966), all heard together and decided together by the Court. In those cases the only common element was the construction of § 103. In the present case we also have the demonstrated conflict within the Court of Appeals for the Fourth Circuit as to the decision by the Court of Claims in *Blumcraft of Pittsburgh v. United States, supra.*

Respondents seem to invite certiorari in this case by flatly asserting that "the Graham guidelines in their entireties were applied by *both* panels in reaching the final

conclusions'' (emphasis added). If in both cases the Court of Appeals undertook to apply the principles enunciated by the Supreme Court in *Graham v. John Deere Co.* but arrived at opposite results and the Court has granted certiorari in the *Pavement Salvage* case, then it would seem that the Court should grant certiorari *per force* in the present case.

New and Separate Reason for Granting the Writ of Certiorari: The Decision of the Court of Appeals for the Fourth Circuit Is in Conflict With the Decision of the Court in *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 161 U. S. P. Q. No. 7, Supp. pp. 1-15 (May 19, 1969).

Beyond acknowledging the decision of the District Court at page 7 of their brief, Respondents make no reference whatever to the opinion of the District Court in this case or its findings of fact. Respondents refer solely to the findings and conclusions of the Court of Appeals, treating the hearing in that Court as a trial *de novo*. Respondents in their brief state that the Court of Appeals made its own determination on the evidence:

> ''the Court of Appeals below on its own determination held the design patent in suit invalid . . .'' (Page 10)
>
> ''the Court of Appeals . . . [made] conclusive determinations on each of the primary tests . . .'' (Page 13)
>
> ''Respondents submitted all pertinent evidence in the proceedings below and demonstrated conclusively to the Fourth Circuit Court of Appeals that the design patent should be held invalid.'' (Page 15)
>
> ''the Court of Appeals reached a conclusion on the validity of the design patent different from that of the

> Trial Commissioner of the Court of Claims . . ." (Page 15)
>
> "However, after giving these secondary matters all the weight to which they were entitled in light of the evidence, the Court [of Appeals] concluded . . ." (Page 18)

The candid remarks in Respondents' brief affirm what is evident from the opinion of the Court of Appeals: virtually no consideration was given to the testimony of the witnesses at the trial, the entire body of prior art presented at the trial or the findings of fact of the District Court. The Court of Appeals "on its own determination" held the design patent in suit invalid on the basis of a selected few of the prior art references and its own opinion.

As in the case of the doctrine of comity, the Court of Appeals is not bound to accept any other Court's determination but also as in the case of the doctrine of comity, the Court of Appeals is bound to pay deference to the findings of fact of the District Court.

This is not a case where the Court of Appeals examined the findings of the District Court in light of the evidence and found them erroneous. Many key Findings of Fact were not even mentioned by the Court of Appeals as is demonstrated in the chart set forth in the Appendix, 89a-94a. The Court of Appeals simply ignored the extensive findings of fact and, indeed, from its opinion it hardly appears that there was a trial of the case or the presentation of any testimony but only the patents in suit and the prior art references selected for argument by Respondents. This sterile analysis exemplifies the type of paper examination normally employed in *ex parte* proceedings in the Patent Office. When evidence presented at the trial and the findings of fact are ignored, it is as easy to decide a case one way as another and to hold a patent valid as invalid.

In *Zenith Radio Corp. v. Hazeltine Research, Inc.*, *supra* (decided after the filing of the Petition herein), the Court reversed the decision of the Court of Appeals, which in turn had reversed the District Court, for the reason that the Court of Appeals had arrived at its own conclusion on the evidence but had failed to give the deference to the findings of the trial court required by Rule 52(a) of the Federal Rules of Civil Procedure. At pages 7-8 the Court said:

> "In applying the clearly erroneous standard to the findings of a district court sitting without a jury, appellate courts must constantly have in mind that their function is not to decide factual issues *de novo*. The authority of an appellate court, when reviewing the findings of a judge as well as those of a jury, is circumscribed by the deference it must give to decisions of the trier of the fact, who is usually in a superior position to appraise and weigh the evidence. The question for the appellate court under Rule 52(a) is not whether it would have made the findings the trial court did, but whether 'on the entire evidence [it] is left with the definite and firm conviction that a mistake has been committed.' *United States v. United States Gypsum Co.*, 333 U. S. 364, 395 (1948). See also *United States v. National Assn. of Real Estate Boards*, 339 U. S. 485, 495-496 (1950), *Commissioner v. Duberstein*, 363 U. S. 278, 289-291 (1960)."

In the present case the Court of Appeals did not expressly reverse a single one of the District Court's findings of fact as clearly erroneous but simply dismissed them or ignored them altogether and made its own determination that Louis Blum's design patent was invalid. The failure of the Court of Appeals to give any deference to the findings of fact of the District Court and the arrogation to itself of the fact finding power conflicts with the established judi-

cial decision-making process and with the decisions of the Supreme Court, particularly *Zenith v. Hazeltine, supra,* and is thus a proper case for review by the Court.

Certiorari Should Be Granted to Prevent Further Judicial Confusion.

Respondents suggest that certiorari is sought by Petitioners merely to obtain further review of the errors of the Court of Appeals in this case. Granted, the District Court opinion graphically portrays the injustice of the deliberate piracy of Louis Blum's inventions permitted by the decision appealed from. But the validity of the patent has already been affirmed by one court—the United States Court of Claims. There can be no question that some injustice has been done—both Courts cannot be right.

The question is what will be the result when the patents are litigated in other courts. The patents are in issue presently in the District of Kansas and it is expected that the Court will follow the result in this case. The design patent expired in 1968 so that litigation involving that patent is possible during the next five years. The mechanical patent does not expire until 1975. The record in this case established that several manufacturers sought to copy Louis Blum's design. Infringements of both patents are presently being investigated and the prospect of further litigation is real.

Unless the validity of the patents is settled by the Supreme Court any lower court will be free to hold them valid or invalid. The precedent for such further conflicting results is established by the decision of the Court of Appeals for the Fourth Circuit in this case. The result, inevitably, will be more "real and embarrassing" conflicts of authority. The present circumstances call for the grant of certiorari to end the confusion produced by the present conflict of authority.

Conclusion.

Architectural Art Mfg., Inc.—the hidden defendant in both the Court of Claims and Fourth Circuit cases—seeks the unlimited right to relitigate the validity of Louis Blum's patent until it is held invalid.

Architectural Art is quick to deny its direct involvement in either the Court of Claims case or the present case (Brief for Respondents, page 5) but is equally quick to claim the benefits of whatever transpires in either action. In fact, Architectural Art has lurked in the background of both of these cases without ever being caught as a party. While Louis Blum's design patent was being litigated in the Court of Claims, Architectural Art's attorney, deliberately concealing his activities, was in direct collaboration with the Justice Department in the presentation of the attack on the patent.[3] When that attack failed, both before the Commissioner and the full Court of Claims, Architectural Art presented the same attack against the design patent, based upon the same prior art, in the District Court for the District of South Carolina. Failing there, Architectural Art finally obtained a ruling reversing the District Court and sustaining its attack on the patent from one panel of the Court of Appeals for the Fourth Circuit. It is difficult to imagine a case demonstrating more vividly the value of the doctrine of comity

3. Respondents seriously understate their involvement with the Government in the Court of Claims case. Far from merely identifying prior art on request, Architectural Art's attorney, over a period of more than a year involving numerous letters, telephone conversations and meetings, solicited and received the help of the Justice Department in this case and secretly supplied the Justice Department with depositions from this case for use in the Court of Claims. He urged secrecy on the Justice Department attorney to "avoid any necessity of your referring to direct collaboration with us in this suit which we prefer". (Letter from Warren N. Williams, Esquire to Department of Justice, August 13, 1964, Appendix, 99a).

to reduce needless multiple litigation of a patent's validity in several courts.

This case presents a direct conflict among and between Federal Courts and important questions of judicial administration in the field of patents which require decision by this Court. The years which have passed since the decision in *Graham v. John Deere Co.,* the more than seventy-five years which have passed since the Court has considered a design patent and the conflicts which are presented in this case, warrant the attention of the Court at this time.

Respectfully submitted,

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IN THE

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF SOUTH CAROLINA.

CIVIL ACTION NO. 4168.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

Plaintiff,

v.

CITIZENS & SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, AND DANIEL CONSTRUCTION COMPANY, INC.,

Defendants.

NOTICE UNDER TITLE 35, UNITED STATES CODE, SECTION 282.

NOW COME THE DEFENDANTS, and in accordance with the provisions of Title 35, United States Code, Section 282, give notice that, at the trial of this action, the following patents, publications and prior use and knowledge will be relied upon as anticipation of the respective patents in suit and showing the state of the art pertinent thereto:

As to U. S. Design Letters Patent No. 171,963;

U. S. Letters Patent No. 1,864,160
Issued June 21, 1932 to R. G. Williams

Architectural Record
April 1933, Page 269

Architectural Record
July 1934, Page 19

Architectural Forum
March 1937, Pages 219 and 222

Architectural Record
October 1938, Page 46

Architectural Record
March 1940, Page 143

Architectural Record
August 1940, Page 68

Architectural Record
September 1941, Page 45

Architectural Forum
October 1942, Page 43

Architectural Record
November 1945, Page 60

Sweet's Catalogue Service, 1950

Architectural Sec. $\frac{6e}{5}$, Page 3

Items No. 373 and 379

Architectural Forum
July 1950, Page 75

Sweet's Catalogue Service, 1952 Architectural Sec. 6c, Page 14

Architectural Record
July 1952, Page 163

Railing in Main Staircase of Home Federal Savings & Loan Building, (now known as 202 S. State St. Building) Chicago, Illinois. William Sevic, 1718 S. Loomis St., Chicago, Illinois and Floyd A. Bolin, 1525 N. Kilpatrick Ave., Chicago, Illinois, have knowledge and information relating to this railing.

As to U. S. Letters Patent No. 2,905,445;

U. S. Letters Patent No. 163,996
Issued June 1, 1875 to P. J. Hardy

U. S. Letters Patent No. 837,769
Issued December 4, 1906 to H. Allen

U. S. Letters Patent No. 1,165,195
Issued December 21, 1915 to J. E. McNeil

U. S. Letters Patent No. 1,569,060
Issued January 12, 1926 to W. F. Wright

U. S. Letters Patent No. Reissue 17,629
Issued March 25, 1930 from an original Patent No. 1,658,956, issued February 14, 1928, to W. G. Wehr

U. S. Letters Patent No. 2,056,842
Issued October 6, 1936 to B. Edgecomb

U. S. Letters Patent No. 2,427,723
Issued September 23, 1947 to F. L. Hawkins and W. D. Phillips

U. S. Letters Patent No. 2,654,579
Issued October 6, 1953, to L. W. Cremens

U. S. Design Letters Patent No. 171,963
Issued April 20, 1954

Architectural Record
July 1934, Page 19

Architectural Forum
March 1937, Pages 219 and 222

Architectural Record
March 1940, Page 143

Architectural Record
September 1941, Page 45

Architectural Forum
October 1942, Page 43

Architectural Record
November 1945, Page 60

Sweet's Catalogue Service, 1950

Architectural Sec. $\frac{6e}{5}$, Page 3

Items No. 373 and 379

Blumcraft of Pittsburgh
Catalogues for years 1953, 1954 and 1955

Railing in Main Staircase of Home Federal Savings & Loan Building (now known as 202 S. State St. Building) Chicago, Illinois. William Sevic, 1718 S. Loomis St., Chicago, Illinois and Floyd A. Bolin, 1525 N. Kilpatrick Ave., Chicago, Illinois have knowledge and information relating to this railing.

HAYNSWORTH, PERRY, BRYANT,
MARION & JOHNSTONE,
By DONALD L. FERGUSON,
409 East North Street,
Greenville, South Carolina,
Tel. No. CEdar 3-3630,
Attorneys for Defendants.

Of Counsel:
WARREN N. WILLIAMS,
DONALD E. JOHNSON,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1816 Federal Reserve Bank Bldg.
Kansas City 6, Missouri
Tel. No. VIctor 2-2459

SUPPLEMENTAL NOTICE UNDER TITLE 35, UNITED STATES CODE, SECTION 282.

Now Come the Defendants, and in accordance with the provisions of Title 35, United States Code, Section 282, give notice that, at the trial of this action, the following patents, publications, and prior use and knowledge will be relied upon as anticipation of one or more of the patents in suit and showing the state of the art pertinent thereto, in addition to those previously noted:

U. S. Design Letters Patent No. 157,592
Issued March 7, 1950 to Peter R. Hollaender

U. S. Design Letters Patent No. 157,593
Issued March 7, 1950 to Peter R. Hollaender

U. S. Design Letters Patent No. 157,594
Issued March 7, 1950 to Peter R. Hollaender

Railing in Main Staircase of the building at 1010-1020 Broadway, Cincinnati, Ohio. Clarence Caeser, 5647 Lawndale Place, Cincinnati, Ohio; Peter R. Hollaender, 2206 Raeburn Drive, Cincinnati, Ohio; and Robert P. Hollaender, 5579 Meryton Lane, Cincinnati, Ohio, have knowledge and information relating to this railing.

Catalog of The Hollaender Manufacturing Company, 3841 Spring Grove Avenue, Cincinnati, Ohio, entitled "Nu-Rail Slip On Fittings" and bearing a copyright notice dated 1948, and including all pages thereof.

A brochure of The Hollaender Manufacturing Company, 3841 Spring Grove Avenue, Cincinnati, Ohio, having a first page comprising the letterhead of said company, and a second page referring to Nu-Rail Slip On Fittings, and bearing a printing identification date of October, 1949.

Catalog of The Hollaender Manufacturing Company, 3841 Spring Grove Avenue, Cincinnati, Ohio, entitled "Nu-Rail Slip On Fittings" and bearing a copyright notice dated 1952, and including all pages thereof.

HAYNSWORTH, PERRY, BRYANT,
MARION & JOHNSTONE,
By DONALD L. FERGUSON,
409 East North Street,
Greenville, South Carolina,
Tel. No. CEdar 3-3630,
Attorneys for Defendants.

Of Counsel:
WARREN N. WILLIAMS,
DONALD E. JOHNSON,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1816 Federal Reserve Bank Bldg.,
Kansas City, Missouri 64106,
Tel. No. VIctor 2-2459

ACKNOWLEDGMENT OF SERVICE.

Duplicate copies of the foregoing Supplemental Notice Under Title 35, United States Code, Section 282, acknowledged as served upon the undersigned, attorney for plaintiff, on this 17th day of December, 1964.

/s/ RALPH E. BAILEY, JR.,
Ralph E. Bailey, Jr.,
Broadus Avenue,
Greenville, South Carolina,
Attorney for Plaintiff.

SUPPLEMENTAL NOTICE UNDER TITLE 35, UNITED STATES CODE, SECTION 282.

NOW COME THE DEFENDANTS, and in accordance with the provisions of Title 35, United States Code, Section 282, give notice that the following publication will be relied upon in the defense of this suit as showing anticipation of the patents in suit and as showing the state of the art prior to the date of alleged invention of the structures of the respective patents:

Architectural Detailing, Caleb Hornbostel and Elmer A. Bennett, Reinhold Publishing Co., 1952 copyright, Pages 165 and 166 .

HAYNSWORTH, PERRY, BRYANT, MARION & JOHNSTONE,
By DONALD L. FERGUSON,
409 East North Street,
Greenville, South Carolina,
Tel. No. CEdar 3-3630,
Attorneys for Defendants.

Of Counsel:
WARREN N. WILLIAMS,
GORDON D. SCHMIDT,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1816 Federal Reserve Bank Bldg.,
Kansas City, Missouri 64106,
Tel. No. VIctor 2-2459.

UNITED STATES DEPARTMENT OF JUSTICE

WASHINGTON, D. C. 20530

Address Reply to the Division Indicated and Refer to Initials and Number

JWD:MTP:kld
154-38-63

January 26, 1965

James C. McConnon, Esquire
1815 Land Title Building
Broad Street
Philadelphia, Pennsylvania 19110

Re: Blumcraft v. United States
Court of Claims No. 38-63

Dear Mr. McConnon:

In response to your letter of January 21, 1965 in which you set forth a list of facts which you propose we agree to, we have the following to offer.

We can agree to the statements in paragraphs 1 and 2. However, paragraphs 3, 4 and 5 do not meet with our approval.

We propose that the following statement be added to the list of agreed facts:

6. Plaintiff Blumcraft has manufactured, commencing at least as early as January, 1958, and continues to manufacture railing components which plaintiff considers to be covered by the claim of Design Patent No. 171,963 here in suit.

We propose to enter the following documents in evidence on the issue of liability in addition to the prior art references cited in our answer:

1. U. S. Letters Patent No. 1,864,160
   Issued June 21, 1932 to R. G. Williams

2. Architectural Record
   April 1933, Page 269

3. Architectural Record
   July 1934, Page 19

4. Architectural Forum
March 1937, Pages 219 and 222

5. Architectural Record
October 1938, Page 46

6. Architectural Record
March 1940, Page 143

7. Architectural Record
August 1940, Page 68

8. Architectural Record
September 1941, Page 45

9. Architectural Forum
October 1942, Page 45

10. Architectural Record
November 1945, Page 60

11. Sweet's Catalogue Service, 1950
Architectural Sec. 6e/5 Page 3
Items No. 373 and 379

12. Architectural Forum
July 1950, Page 75

13. Sweet's Catalogue Service, 1952
Architectural Sec. 6c, Page 14

14. Architectural Record
July 1952, Page 163

We further plan to rely on the railing in the main staircase of the Home Federal Savings and Loan Building (now known as 202 South State Street Building), Chicago, Illinois as constituting prior use and knowledge.

We plan to oppose your Motion for Call and will file our response thereto in due course.

Yours very truly,

JOHN W. DOUGLAS
Assistant Attorney General
Civil Division

By: [signature]

T. Hayward Brown
Chief, Patent Section

Cc: Hon. Donald E. Lane
Commissioner
U. S. Court of Claims
Washington, D. C. 20005

UNITED STATES DEPARTMENT OF JUSTICE

WASHINGTON, D.C. 20530

Address Reply to the Division Indicated and Refer to Initials and Number

JWD:MTP:kw
154-38-63

August 6, 1965

James C. McConnon, Esquire
Paul & Paul
1815 Land Title Building
Philadelphia 10, Pennsylvania

Re: Blumcraft v. United States
Court of Claims No. 38-63

Dear Mr. McConnon:

Please take notice that in addition to the prior art set forth in our answer and that noted in the memorandum of pretrial conference filed January 27, 1965, we plan to rely on the following prior art at the trial of this case:

1. Publication of the Hollaender Manufacturing Co. entitled "Nu-Rail Slip-On Fittings" copyright 1952, 8 pages.

2. "Architectural Forum", October 1942, Page 43.

3. "Architectural Forum", March 1950, Page 100.

4. "Architectural Forum", June 1950, Page 127.

5. "Sweet's Catalogue Service", 1951, Architectural Section 6a/A, Page 21.

6. Aluminum in Architectural Work, London, Aluminum Union Limited 1940, 77 pages.

7. Architectural Detailing, Caleb Hornbostel and Elmer A. Bennett, Reinhold Publishing Co. 1952 copyright, Page 165 and Page 166.

8. Architect's Working Details, edited by D.A.C.A. Boyne, The Architectural Press 1953 in Great Britain, Page 60 and Page 61.

9. "New Pencil Points", January 1943, Page 24.

10. "Progressive Architecture", September 1948, Page 68 and Page 69, September 1948, Page 95.

11. "Progressive Architecture", November 1951, Page 26.

We plan to call as our expert witness James E. Francis of the General Services Administration, Washington, D. C.

Would you kindly forward at your earliest convenience copies of the drawing which you have stated represents the first conception of the patented railing in September of 1952. As we understand it from information which you have provided us, there is no documentary proof of the first alleged reduction to practice.

We are enclosing herewith the original reprint of what appears to be an excerpt from the 1952 Blumcraft Catalogue which you provided us. It is noted that although this publication bears a 1952 copyright notice it was never registered in the United States Copyright Office. Would you kindly inform us as to the first date on which this document was published.

Yours very truly,

JOHN W. DOUGLAS
Assistant Attorney General
Civil Division

By: T. Hayward Brown

T. Hayward Brown
Chief, Patent Section

Enclosure

Cc: Hon. Donald E. Lane
Commissioner
U. S. Court of Claims

IN THE

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF SOUTH CAROLINA.

CIVIL ACTION NO. 4168.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

Plaintiff,

v.

CITIZENS & SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, AND DANIEL CONSTRUCTION COMPANY, INC.,

Defendants.

DEFENDANTS' SUPPLEMENTAL ANSWERS TO PLAINTIFF'S INTERROGATORIES NOS. 29 AND 31.

COME NOW THE DEFENDANTS, Citizens & Southern National Bank of South Carolina and Daniel Construction Company, Inc., through their attorneys, and as a supplement to their answers to the above identified interrogatories of plaintiff, state as follows:

Interrogatory No. 29—The attendance of Warren N. Williams at the trial of Civil Action No. 38-63 in the United States Court of Claims was not on the behalf of anyone. Architectural Art Mfg., Inc. paid for the time and expenses of such attendance.

Interrogatory No. 31—Defendants are not presently advised as to whether or not the subject item was published.

WARREN N. WILLIAMS,
Warren N. Williams,
HOVEY, SCHMIDT, JOHNSON & HOVEY,
1800 Federal Reserve Bank Bldg.,
Kansas City, Missouri 64106,
Tel. No. VIctor 2-2459.

Counsel for Defendants:
HAYNSWORTH, PERRY, BRYANT, MARION
& JOHNSTONE,
409 East North Street,
Greenville, South Carolina,
Tel. No. CEdar 3-3630.

ANALYSIS OF FINDINGS OF FACT.

The following are examples of findings of fact made by the District Court which were ignored or dismissed by the Court of Appeals for the Fourth Circuit:

Finding of Fact in District Court Opinion (Appendix page)	Treatment in Court of Appeals Opinion (Appendix page)
1. Definition of Blum design (9a): "a. A plurality of spaced parallel posts generally rectangular in cross section and arranged so as to present a series of spaced parallel vertical surfaces; "b. A plurality of spaced parallel hand rails generally flat or rectangular in cross section and arranged in the same vertical plane so as to present a series of parallel horizontal surfaces; "c. Connecting brackets attaching the underside of each handrail to the adjacent edge of each post, each bracket comprising a rod-like member extending at right angles to the post and a substantially flat triangu-	(47a): "The railing consists of multiple parallel rails offset from vertical posts. The handrails are generally flat with slightly curved gripping surfaces. The posts are rectangular. Inconspicuous L-shaped brackets attach the undersides of the rails to the posts, leaving the gripping surfaces of the rails unobstructed. The multiple, offset, and parallel handrails set up a horizontal plane in opposition to the vertical plane formed by the parallel posts. The result, with the connections between the two planes minimized, is the visual illusion that the handrails are floating free."

lar member extending upward from the rod-like member to the center of the underside of each rail leaving the rail unobstructed throughout the hand-gripping portion thereof;

"d. The aforesaid elements so designed and arranged as to cause the handrails to appear to float in space away from the posts."

2. Difficulty of producing design from prior art (12a):

"In fact considerable thought and a substantial redesign of the cited exhibits by the defendants would be necessary to achieve the design having the distinctive features of the Blum design."

(49a):

"It is apparent from the sophistication of the prior art that designers of ornamental railings, including manufacturers and architects, were highly skilled. Therefore, the fact, which the district court emphasized, that prior art would have to be redesigned to achieve Blum's railing is not decisive. The joining of known components usually requires skill, but this does not necessarily negate obviousness."

3. Hindsight (13a):

"But only through hindsight does the design ap-

No Mention.

pear obvious, which of course is not the test.''	
4. No reason to produce design (13a): ''There being no reason for the lower railings to be offset the design becomes more unobvious.	No Mention.
5. Design contrary to normal expectation and unusual (13a): Defendants' expert witness, ''Mr. Fishleigh, testified that plaintiff's design was contrary to the normal design in railings. He said 'it is contrary to what I would want any way. In other words, if I want a railing, I don't want one which is floating loose, kicking around; I want one which in my instance would give some degree of or indication of rigidity, that if I thought I got ahold of it, it would hold me.' The plaintiff's design is even more unusual in view of the normal expectation that a rail would and should appear very stable. Plaintiff's design is quite con-	No Mention.

trary to this in that it produces a floating effect, as opposed to an appearance giving stability."

6. Futile attempt by Respondents expert to duplicate Blum mechanical invention from prior art (23a-25a):

No Mention.

"The principal art relied upon by the defendants to invalidate Claim 1 of the mechanical patent is the Hardy Patent No. 163,996 and the 1954 Blumcraft Catalog reference. Defendants' witness Fishleigh through the use of these two references attempted to create a structure as defined by the plaintiff's claim . . . He developed an entirely new member to combine them, and then it was apparently through hindsight. His attempt to produce the structure vividly demonstrates the unlikelihood that anyone skilled in the ornamental railing art would attempt to do so."

7. Railroad track clamp not relevant to obviousness (25a):	(53a-54a):
"As to the McNeil Patent No. 1,165,193, heavily relied on by defendants, it cannot be used to invalidate plaintiff's patent. Although certain elements are the same McNeil was used as anti-creeping device for railroad tracks, something far removed from the art in which the present invention resides."	"The fact that McNeil's mechanism was designed to hold railroad rails and not handrails does not make his patent irrelevant. Both his mechanism and Blum's perform the same function: they stabilize a rail without interfering with the use of its upper surface. Because both are simple devices employing the same universally known principles of mechanics, McNeil's patent is pertinent prior art and supports our conclusion that Blum's device was obvious."
8. Spacing means integrated in clamping connection as new function (26a):	No Mention.
"It is significant that the spacing connector in the Blum patent also serves as the clamping means, and this a new function.	
9. Adjustability and rigidity (28a):	(53a):
"Although it was not new in the art to have a rail offset from the post,	"In addition, the unpatented device Blum originally used in railings manufactured

it was novel to have the Blum type of connector for attaching the rail so as to give adjustability to the particular need and rigidity as is required for railings.

"One of the most important features of the mechanical patent is the flexibility allowed in combination with rigidity. The rail portion can be adjusted when the clamping members are loose and may be moved, whereas when tightened they are completely rigid. Although the defendants attack the validity of the patent with numerous exhibits, particularly the Hardy and McNeil Patents, the court finds that none of the prior art shows this type of mechanical arrangement."

from his design patent disclosed the flexibility plus rigidity that the district court found unique to Blum's later mechanism."

IN THE

UNITED STATES COURT OF CLAIMS.

No. 38-63.

BLUMCRAFT OF PITTSBURGH,

Plaintiff,

v.

THE UNITED STATES,

Defendant.

SUPPLEMENT TO MOTION TO QUASH SUBPOENA DUCES TECUM.

COMES NOW WENZEL W. THOM, President of Architectural Art Mfg., Inc., Wichita, Kansas, and through his attorney, now moves the Commissioner under the provisions of Rule 51(c) of the Rules of the United States Court of Claims for a Final Order quashing the subpoena including the duces tecum part thereof, dated January 27, 1969 and served on Wenzel W. Thom February 6, 1969. This supplement to the original motion is made on the grounds that it is unreasonable and oppressive to permit plaintiff to continue its efforts to search through all of the records of Architectural Art Mfg., Inc. for the period specified in the subpoena, especially in light of the facts developed during the preliminary inspection made by counsel for plaintiff in the presence of the Commissioner on February 18, 1969, and in view of the decision of the United States Court of Appeals for the Fourth Circuit on February 19, 1969, holding Design Patent No. D-171,963 invalid and unenforceable against Architectural Art Mfg., Inc.

Wenzel W. Thom appeared before the Commissioner at 10:00 A. M. on February 18, 1969, pursuant to the subpoena of January 27, 1969, but counsel for plaintiff elected not to take his testimony at the scheduled time and instead decided to make a preliminary inspection of the records of Architectural Art Mfg., Inc. under an oral protective order by the Commissioner. No testimony was taken of Wenzel W. Thom on February 18, 1969, notwithstanding his availability throughout the entire day.

The preliminary inspection by counsel for plaintiff of the records of Architectural Art Mfg., Inc., including those referred to in the motion to quash mailed on February 11, 1969, tended to establish that Architectural Art Mfg., Inc. had not in fact sold significant quantities of railings to the Government if at all within the period of January 1, 1960 to December 31, 1966. In addition, it was clear that if any sales of railings accused to infringe Patent No. D-171,963 had in fact occurred, damages on the dollar amount thereof would obviously be *de minimis* in comparison with the cost of making a conclusive search through all of the records and files of Architectural Art Mfg., Inc. to confirm whether or not even small quantities of such railings had in fact been sold to the United States in the specified period. Plaintiff resolutely refuses to compensate Architectural Art Mfg., Inc. and its officers for the time that would necessarily be spent in either making the inspection of records sought by plaintiff, or assisting counsel for plaintiff with his inspection thereof, and it is clearly unreasonable and oppressive to require Architectural Art Mfg., Inc. to make its records available under the mandate of the subpoena. Noteworthy in this connection is the plaintiff's failure to cite even one instance of a Government sale or acknowledgment by the United States that it purchased quantities of the accused railing structure during the period of January 1, 1960 to December 31, 1966.

The reasons initially advanced in support of an Order to quash are reaffirmed and incorporated herein by reference.

Additionally, in a decision dated February 19, 1969, the United States Court of Appeals for the Fourth Circuit held Patent No. D-171,963 invalid in an action where Blumcraft alleged the patent to be of a scope to cover the products of Architectural Art Mfg., Inc. and still define patentably over the prior art. (A copy of the decision is annexed hereto.) Accordingly, it is submitted that no railing structures manufactured and sold by Architectural Art Mfg., Inc. to the Government or anyone else can validly be considered to come within the Design Patent.

For the foregoing reasons, it is asked that the Commissioner's preliminary ruling on the motion by Wenzel W. Thom to quash the subpoena, wherein it was Ordered that the subpoena was squashed subject to an agreement between counsel as to the procedures to be carried out for effecting the inspection of the records of Architectural Art Mfg., Inc., be supplanted by a Final Order quashing the subpoena in its entirety.

Respectfully submitted,

WM. F. PIELSTICKER,
Wm. F. Pielsticker,
1400 Wichita Plaza Building,
Wichita, Kansas 67202
Tele.: (316) AM 7-0235,
Attorney for Wenzel W. Thom.

CERTIFICATE OF SERVICE.

I hereby certify that on this 27th day of February, 1969, I sent two (2) copies of the foregoing Supplement To Motion To Quash Subpoena Duces Tecum to Commissioner Lane, United States Court of Claims, Washington, D. C., one (1) copy to Nick Kalokahlis, United States Department of Justice, Civil Division, Patent Section, Washington, D. C., and one (1) copy to James C. McConnon, Paul & Paul, 1815 Land Title Building, Philadelphia, Pennsylvania 19110, by first class mail, postage prepaid.

WM. F. PIELSTICKER.
Wm. F. Pielsticker.

EXHIBIT G TO ANSWER TO INTERROGATORY 26.

August 13, 1965
AIR MAIL—REGISTERED LETTER

United States Department of Justice
Washington, D. C. 20530
Attention: Michael Platt
Patent Section
Re: *Blum Depositions*

Dear Mike:

Enclosed are copies of the Blum depositions which you requested. It is understood that these copies will be returned as soon as you have concluded your review thereof.

Also, I understand that you plan to obtain certified copies of all depositions which you plan to introduce, from the court in South Carolina. This will avoid any necessity of your referring to direct collaboration with us in this suit and which we prefer.

Yours very truly,

HOVEY, SCHMIDT, JOHNSON & HOVEY,
By

WNW:ef
Encls.

SUPREME COURT, U. S.

FILED

JUL 10 1969

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1968.

No. 1355.

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioner,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA,
DANIEL CONSTRUCTION COMPANY, INC.
and COLONIAL IRON WORKS, INC.,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit.

PETITION FOR REHEARING.

JAMES C. MCCONNON,
HENRY N. PAUL, JR.,
PAUL & PAUL,
1815 Land Title Building,
Philadelphia, Pa. 19110,
RALPH BAILEY, JR.,
BAILEY & DORITY,
125 Broadus Avenue,
Greenville, S. C. 29601,
Attorneys for Petitioner.

International, 741 So. 50th St., Phila., Pa. 19143—Tel. SA 7-8711 Area Code 215

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968.

No. 1355.

BLUMCRAFT OF PITTSBURGH, A PARTNERSHIP CONSISTING OF HYMAN BLUM, MAX BLUM, LOUIS BLUM AND HARRY P. BLUM,

Petitioners,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. AND COLONIAL IRON WORKS, INC.,

Respondents.

PETITION FOR REHEARING.

Petitioner, Blumcraft of Pittsburgh, hereby prays that this Court grant rehearing of its order of June 16, 1969, denying the petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Fourth Circuit in the above-captioned case, as prayed for in the Petition filed by Blumcraft of Pittsburgh on May 3, 1969.

REASONS FOR GRANTING REHEARING AND ISSUING THE WRIT.

New Infringement Suits Involving the Design Patent and the Copying of the Design by Manufacturers in Virtually Every Federal Circuit Emphasize the Widespread Public Interest in the Blum Design and the Need to Settle the Question of Patent Validity Produced by the Conflicting Decisions of the United States Court of Claims and the Court of Appeals For the Fourth Circuit.

On June 16, 1969 the Court denied the Petition for Certiorari seeking review of the decision of the Court of Appeals for the Fourth Circuit reversing the judgment of the District Court for the District of South Carolina and holding United States Patents Nos. D-171,963 and 2,905,445 invalid. The petition was based upon the following facts:

1. The decision of the Court of Appeals holding the design patent invalid is in direct conflict with the decision of the Court of Claims holding the patent valid. *Blumcraft of Pittsburgh v. United States,* 372 F. 2d 1014 (1967).

2. The decision of the Court of Appeals for the Fourth Circuit is also in conflict with the principles of the decision rendered by a different panel of the Court of Appeals for the Fourth Circuit in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.,* certiorari granted No. 1014, October Term, 1968.

Since the denial of the petition for certiorari, the design patent has become the subject of the following two infringement suits in the Fifth Circuit:

Blumcraft of Pittsburgh v. Metallic Engineering Co., Inc., Civil Action No. 69-797, District Court for the District of Florida.

Blumcraft of Pittsburgh v. Kawneer Co., Inc. et al., Civil Action No. 12847, District Court for the Northern District of Georgia, Atlanta Division.

The denial of certiorari means only that there were not four members of the Court who thought that the case should be heard, and carries with it no implication whatever regarding the merits of the case. See *Brown v. Allen*, 344 U. S. 443, 492 (1953); *House v. Mayo*, 324 U. S. 42, 48 (1945); *United States v. Carver*, 260 U. S. 482, 490 (1923). The denial of certiorari in the present case, as in all patent cases, not only fails to settle the question of validity of patents which have been litigated but specifically and without any possible implication one way or the other leaves that question open for further litigation.

The design patent has been litigated to judgment in the United States Court of Claims and in the District Court for the District of South Carolina. Both Courts held the patent valid and infringed. The decision of the Court of Appeals for the Fourth Circuit reversing the judgment of the South Carolina court produced the conflict set forth in the petition for certiorari. The denial of the petition for certiorari means that this conflict will remain unresolved. The Court of Appeals for the Fifth Circuit clearly recognized this principle in *Poster Exchange, Inc. v. National Screen Service Corp.*, 362 F. 2d 571 (1966), wherein it held that the Supreme Court's denial of certiorari is in no sense a legal determination, citing *Brown v. Allen*. See also *Texas Construction Co. v. United States of America*, 236 F. 2d 138 (5th Cir., 1956). The District Court for the District of Florida and the District Court for the District of Northern Georgia are thus free to hold the design patent either valid

or invalid on precisely the same prior art as was presented to the Court of Claims and the District Court for the District of South Carolina.

There continues to be every reason to believe that in addition to the two suits filed in the Fifth Circuit there will be other litigation involving infringement of Louis Blum's design patent. Although, as the testimony in this case established, it has long been evident that there has been widespread copying of Louis Blum's design by a number of railing manufacturers who have advertised such railings in their catalogs, actual proof of infringement involving manufacture, use or sale of railings bearing the design has not yet been established in all cases. In the present case Architectural Art's catalog advertising the infringing design was discovered in early 1959 but after Architectural Art's refusal to admit manufacture and sale of the railings it advertised it was not until 1961 that the actual railing in suit was found in South Carolina and this suit was begun. As the evidence has established, Blumcraft of Pittsburgh is a relatively small firm with no nationwide sales service. In order to locate infringing railings it is necessary for Blumcraft to initiate efforts specifically directed to that end from its office in Pittsburgh, Pennsylvania. It was pointed out in Petitioner's Reply Brief that railings of other manufacturers have been under investigation. Infringements in Florida and Georgia have been established as the result of such investigations.

It is manifest that, in the present posture of the litigation, Petitioner has no choice but to continue to bring suits for infringement in the different Circuits where infringement has been or may be found. It must be recognized that in such additional litigation the patent may be found valid or invalid, depending upon whether the particular court agrees with the decision of the Court of Claims and the District Court of South Carolina or that of the

Court of Appeals for the Fourth Circuit. The denial of certiorari leaves the question open for further litigation.

This Court has repeatedly held that it is in the public interest that a judicial determination be reached as to the validity or invalidity of disputed patents. Most recently, on June 16, 1969, this Court, by its decision in *Lear, Incorporated v. John S. Adkins,* No. 56, October Term, 1968, reversed its own prior decision in *Automatic Radio Co. v. Hazeltine,* 339 U. S. 827, 836 (1950) and removed from the law the doctrine of licensee estoppel which had existed for more than one hundred years. This was done for the express purpose of insuring that there be no limitation on the right to raise an issue of patent validity or invalidity. The Court reaffirmed the principal of *Pope Manufacturing Co. v. Gormully,* 144 U. S. 224, 234 (1892):

> "It is as important to the public that competition should not be repressed by worthless patents, as that the patentee of a really valuable invention should be protected in his monopoly . . ."

On the same day, June 16, 1969, this Court, by denying certiorari in the present case, effectively announced that it would not determine whether Louis Blum had procured a "worthless patent" or made a "really valuable invention". It is not for a moment to be supposed that the Supreme Court should decide the validity of every patent that is litigated but it is the inescapable fact that when courts of coordinate jurisdiction such as the United States Court of Claims and the Court of Appeals for the Fourth Circuit disagree as to the validity of a patent in clear cut and irreconcilable terms, only the Supreme Court can settle the question.

The patents in suit are not paper patents of limited public interest. The United States Government, Architectural Art and Blumcraft have gone through two complete law suits testing the validity and infringement of the design

patent. Additional suits are now pending. In the accounting proceedings in the Court of Claims it has been established that the railing designs advertised by the following manufacturers would, if actually manufactured and sold to the Government, infringe Louis Blum's design patent:

Railing Manufacturer	*Location*	*Federal Circuit*
Architectural Aluminum Co.	Cedar Rapids, Iowa	8th
Architectural Art Mfg. Co.	Wichita, Kansas	10th
Armco Steel Corporation	Middletown, Ohio	6th
Best Metal Kraft, Inc.	Pitcairn, Pennsylvania	3rd
Guildcraft Metals, Inc.	Oklahoma City, Oklahoma	10th
Hankins and Johann, Inc.	Richmond, Virginia	4th
Julius Blum & Co., Inc.	Carlstadt, New Jersey	3rd
Kawneer Company	Niles, Michigan	6th
Livers Bronze Company	Kansas City, Missouri	8th
Newman Brothers, Inc.	Cincinnati, Ohio	6th
Railcraft Corporation	San Francisco, California	9th
Reliance Art Metal Company	Cincinnati, Ohio	6th
Reynolds Metal Company	Richmond, Virginia	4th

Other courts have found copying of the work of Blumcraft with respect to the same subject matter. Specifically, Newman Brothers, Inc. was adjudged to have copied the art work of Blumcraft catalogs illustrating its railing design. *Blumcraft of Pittsburgh v. Newman Brothers, Inc.*, 159 U. S. P. Q. 166 (1968). See also *Blumcraft of Pittsburgh v. Newman Brothers, Inc.*, 6 Cir., 373 F. 2d 905 (1967). In another case, *Blumcraft of Pittsburgh v. Best Metal Kraft, Inc.*, Civil Action No. 17,767 (W. D. Pa.), a consent decree was entered enjoining copyright infringement by another manufacturer who had copied the art work of the Blumcraft catalog illustrating Louis Blum's railing design. Copying of Louis Blum's railing design or Blumcraft art work illustrating the design by other railing manufacturers has been established in the Third, Fourth and Sixth Circuits and in the United States Court of Claims. Additional litigation involving the design patent is now pending in the Fifth and Tenth Circuits. As evidenced by the list of manufacturers advertising similar railings there is a prospect of further litigation in the Seventh, Eighth and Ninth Circuits.

If, as the Court of Appeals for the Fourth Circuit has determined, Louis Blum's patents are worthless, then the denial of certiorari by this Court imposes upon the public an insupportable repression of competition. If on the other hand the United States Court of Claims and the District Court for the District of South Carolina are correct, then the constitutional purpose carried out in our patent laws is thwarted and rendered meaningless.

The question of patent validity under § 103 of the Patent Act will be heard by the Supreme Court in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., supra.* It would be the most efficient use of judicial time and effort to hear argument in the present case at the same time.

For the reasons set forth above and in the petition for a writ of certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the United States Court of Appeals for the Fourth Circuit.

Respectfully submitted,

JAMES C. MCCONNON,
HENRY N. PAUL, JR.,
PAUL & PAUL,
RALPH BAILEY, JR.,
BAILEY & DORITY,
Attorneys for Petitioner.

CERTIFICATE OF COUNSEL.

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to the grounds specified in Rule 58(2) of the Rules of this Court.

JAMES C. MCCONNON,
Counsel for Petitioner.

MOTION FILED NOV 1969
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SUPREME COURT, U. S.

IN THE

Supreme Court of the United States

October Term, 1968.

No. 1355.

BLUMCRAFT OF PITTSBURGH, a Partnership Consisting of Hyman Blum, Max Blum, Louis Blum and Harry P. Blum,
Petitioner,

v.

CITIZENS AND SOUTHERN NATIONAL BANK OF SOUTH CAROLINA, DANIEL CONSTRUCTION COMPANY, INC. and COLONIAL IRON WORKS, INC.,
Respondents.

MOTION FOR LEAVE TO FILE SECOND PETITION FOR REHEARING AND SECOND PETITION FOR REHEARING.

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MOTION FOR LEAVE TO FILE SECOND PETITION FOR REHEARING.

Petitioner, Blumcraft of Pittsburgh, hereby moves the Court for leave to file a second petition for rehearing of the order of the Court of June 16, 1969 denying the petition for a Writ of Certiorari to review the judgment of the United States Court of Appeals for the Fourth Circuit in the above captioned case as prayed for in the petition filed by Blumcraft of Pittsburgh on May 3, 1969.

SECOND PETITION FOR REHEARING.

Petitioner, Blumcraft of Pittsburgh, hereby prays that this Court grant rehearing of its order of June 16, 1969 denying the petition for Writ of Certiorari to review the judgment of the United States Court of Appeals for the Fourth Circuit in the above captioned case as prayed for in the petition filed by Blumcraft of Pittsburgh on May 3, 1969.

BRIEF IN SUPPORT OF THE MOTION AND SECOND PETITION FOR REHEARING.

Since the Ruling by the Court Denying Petitioner's Petition for Rehearing the Real Defendant, Architectural Art Mfg., Inc. Has Broadcast Through the Trade a News Release So Phrased as to Mislead One to Believe That the Court Had Ruled Against Petitioner on the Merits of the Present Patent Infringement Suit.

On October 13, 1969 the Court denied the Petition for Rehearing of the Court's denial of the Petition for Certiorari seeking review of the decision of the Court of Appeals for the Fourth Circuit reversing the judgment of the District Court for the District of South Carolina and holding United States Patents Nos. D-171,963 and 2,905,445 therefore invalid.

On or about October 15, 1969 Architectural Art. Mfg., Inc., the real party defendant in the present case, through its president Wenzel W. Thom, procured the issuance of the news release attached hereto as Exhibit A. The news release, issued by the National Association of Architectural Metal Manufacturers to its members, effectively reached the entire trade interested in the merits of the present patent infringement suit.

In its press release no reference is made to the specific ruling of the Court which was the denial of the Petition for Rehearing or of the prior ruling of the Court which was the denial of the Petition for Certiorari. The news release only states that the Court "has ruled in favor" of the defendants "in a patent infringement suit brought by Blumcraft of Pittsburgh". The clear implication and natural inference to be drawn by any person reading the news release is that the Court has ruled on the subject matter of the patent infringement suit and held the patents invalid. This is contrary to fact and law. *Brown v. Allen,* 344 U. S. 443,

492 (1953); *House v. Mayo,* 324 U. S. 42, 48 (1945); *United States v. Carver,* 260 U. S. 482, 490 (1923).

As set forth in the Petition for Rehearing the design patent in suit has become the subject matter of two additional infringement suits in the Fifth Circuit. There is the prospect of further litigation in the Seventh, Eighth and Ninth Circuits.

The effect of the news release broadcast by Architectural Art will be to persuade others that the patents in suit have been finally held invalid by the Court. In fact, the design patent in suit has been held valid by the Court of Claims and invalid by the Court of Appeals for the Fourth Circuit.

It is proper for the Court to grant leave to file a second petition for rehearing where entirely new grounds not previously available to the petitioner are presented. *Schriber Co. v. Cleveland Trust Co.,* 305 U. S. 47 (1938), Certiorari denied 303 U. S. 639, Petition for Rehearing denied 303 U. S. 667, Second Petition for Rehearing granted 304 U. S. 587.

For the reasons set forth above and in the Petition for a Writ of Certiorari and the Petition for Rehearing, it is respectfully urged that the Motion for Leave to File a Second Petition for Rehearing be granted, that the rehearing be granted and that, upon such rehearing, a Writ of Certiorari issue to the United States Court of Appeals for the Fourth Circuit.

Respectfully submitted,

JAMES C. MCCONNON,
HENRY N. PAUL, JR.,
PAUL & PAUL,

RALPH BAILEY, JR.,
BAILEY & DORITY,
Attorneys for Petitioner.

EXHIBIT A.

NEWS RELEASE

FROM NATIONAL ASSOCIATION OF ARCHITECTURAL METAL MANUFACTURERS

IMPORTANT

The United States Supreme Court has ruled in favor of Citizens and Southern National Bank and the Colonial Iron Works of South Carolina and Daniel Construction Co. in a patent infringement suit brought by Blumcraft of Pittsburgh in 1962. For more information please write to Wenzel W. Thom, President, Architectural Art Mfg., Inc., P. O. Box 8106, Munger Station, Wichita, Kansas 67208.

CERTIFICATE OF COUNSEL.

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to the grounds specified in Rule 58(2) of the Rules of this Court.

JAMES C. MCCONNON,
Counsel for Petitioner.